Supreme Court, U.S.
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No.

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IN THE

Supreme Court of the United States

TODD MCFARLANE, *et al.*
Petitioners,

v.

ANTHONY R. "TONY" TWIST,
Respondent.

On Petition for a Writ of Certiorari
To The Supreme Court of Missouri

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

In a right-of-publicity case, does a work of expression that uses the name of a public figure in a non-defamatory manner lose its First Amendment protection if the money-making purpose of that expressive use outweighs what the court deems to be its "artistic value"?

PARTIES TO THE PROCEEDINGS BELOW

Petitioners are Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc., Todd McFarlane Entertainment, Inc., and Image Comics, Inc. They were defendants at the trial in the Circuit Court of the City of St. Louis, Missouri, and respondents in the Missouri Supreme Court.

Respondent is Anthony R. "Tony" Twist. He was the plaintiff in the trial court and the petitioner in the Missouri Supreme Court.

RULE 29.6 STATEMENT

The corporate petitioners have no parent corporations and no publicly held company owns 10% or more of their stock.

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PETITION FOR A WRIT OF CERTIORARI

Petitioners Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc., Todd McFarlane Entertainment, Inc., and Image Comics, Inc. respectfully petition for a writ of certiorari to review the judgment of the Missouri Supreme Court in this case.

OPINIONS BELOW

The opinion of the Missouri Supreme Court (App. 1a-22a)[1] is reported at 110 S.W.3d 363, 67 U.S.P.Q.2d 1604, 31 Media L. Rep. 2025 (Mo. 2003) (*en banc*). The opinion of the Missouri Court of Appeals (App. 23a-61a) is reported at 30 Media L. Rep. 2409 (Mo. App. 2002). The opinion of the St. Louis Circuit Court granting petitioner's motion for judgment notwithstanding the verdict (App. 62a-80a) is unreported.

JURISDICTION

The Missouri Supreme Court entered its judgment on July 29, 2003. This Court has jurisdiction under 28 U.S.C. § 1257(a).

RELEVANT CONSTITUTIONAL PROVISIONS INVOLVED

The First Amendment to the U.S. Constitution, made applicable to the states by the Fourteenth Amendment, provides in relevant part: "Congress shall make no law... abridging the freedom of speech, or of the press."

STATEMENT OF THE CASE

This case involves the scope of First Amendment protection for works of artistic expression that use the name of a public figure in a non-defamatory way. The

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[1] All references to the Appendix to this Petition shall use the abbreviation "App." followed by the page number, *e.g.*, "App. 1a."

Supreme Court of Missouri crafted what it acknowledged was a new test that conflicts with the existing ones and makes an expressive work's First Amendment protection depend upon a court's weighing the "artistic value" of the use against the publisher's "commercial" benefit from that use. In a market where publications are distributed nationwide, this uncertain and subjective test must chill the First Amendment rights of speakers everywhere.

The public figure is Respondent, a former National Hockey League player. The works at issue are a comic book series entitled *Spawn* and a Home Box Office ("HBO") animated show based on those comics. The Petitioners include the creators and publisher of those works.

Respondent sued Petitioners for violating his right of publicity on the ground that his nickname was used as the nickname of a fictional mobster in the comic book and HBO show. Petitioners argued at every stage of the case that the First Amendment barred Respondent's claim. The jury found in Respondent's favor and awarded him $24.5 million, which was greater than the net worth of all of the Petitioners.

The trial court granted Petitioners' post-trial motion and entered judgment in their favor notwithstanding the verdict. The Missouri Supreme Court reversed, holding that the works of expression receive no First Amendment protection.

Spawn

Spawn is the tale of a government assassin who is murdered just as he starts to question the morality of his job. Desperate to see his beloved wife one last time, he makes a deal to return to Earth, not knowing that the devil will send him back after his wife has remar-

ried and that he will be endowed with superpowers as a Hellspawn (a soldier in Hell's army).

One minor character who occasionally appears in the comic books is Antonio Carlo Twistelli. The fictional Twistelli was born in Sicily, joined the mob as an enforcer, and now lives in New York City, where he heads a crime syndicate. His nicknames are Don Dracula and Tony Twist.

Respondent was born in Canada, now lives in St. Louis, and once played professional hockey, where he gained some notoriety as an "enforcer" or "goon" (*i.e.*, a fighter). His nickname is Tony Twist.

It is undisputed that Respondent and Twistelli look nothing alike and share nothing in common except their nicknames and their roles as "enforcers" in their respective professions. They appear, side by side, below:

Respondent



Antonio "Tony Twist" Twistelli



(Trial Ex. MCF-FF.)

The Lawsuit

In 1997, Respondent filed suit in the Circuit Court of St. Louis against Petitioners and several other defendants, including HBO, a local comic book store, Blockbuster Video, and TCI Cablevision. (These other defendants settled or were dismissed pursuant to pre-trial motions.) The lawsuit alleged various claims, including defamation and right of publicity, arising out use of the name Tony Twist as the nickname of the fictional Twistelli character.

A year before trial, the court dismissed the defamation claim, holding that "a person of ordinary intelligence" would not understand the comic books "to convey factual assertions 'of and concerning' [Respondent]." (Mo. Sup. Ct. Legal File at 1006.)

No Petitioner ever published Respondent's likeness or otherwise used his likeness to promote any comic book or other product. Nor did any Petitioner publish any advertisement suggesting a connection between the fictional mob boss and Respondent. The only references to Respondent appear in the letters-to-the-editor section of the following two issues of the comic book published in 1994:

- In *Spawn* Issue 20, a letter noted that there were several "Quebec Nordiques in your stories." In his response, Todd McFarlane stated that the fan was "absolutely correct in noticing hockey players' names in my book," proclaimed that "I love hockey!" and provided "a list of some of the names I've used so far: Burke, Williams, Sakic, Twist, Linden, Roenick, and a few others I can't think of right now." (Trial Ex. 16, Issue 20.)

- Four issues later, in response to a fan's letter observing that some of the characters were named after real people, Mr. McFarlane explained that he was a big hockey fan and stated that "a lot of my characters have been named after current NHL players. For example, Antonio Twistelli a.k.a. Tony Twist is actually the name of a hockey player for the Quebec Nordiques." (*Id.*, Issue 24.)

The only other reference to Respondent was in an independent comic-book fan magazine entitled *Wizard*, which devoted a special issue to *Spawn*. For that issue, a reporter for *Wizard* wrote a feature on the origins of the names of various comic book characters. He testified that the information in his article came from his interview of Mr. McFarlane. In a paragraph in the article on the Twistelli character, the reporter identifies Respondent as "the real life persona" of the fictional character and states that Twistelli was named "for former Quebec Nordiques hockey player Tony Twist, now a renowned enforcer (*i.e.*, 'Goon') for the St. Louis Blues of the National Hockey League." (Trial Ex. 1.)[2]

Respondent tried the case solely on the right of publicity claim and solely on the use of his name. At the conclusion of a four-week trial, the jury returned a single verdict against all Petitioners for $24.5 million. The damage award was $24,482,000 more than Respondent had ever earned in annual endorsement income and was greater than the net worth of all the Petitioners. For example, Image Comics—a small publisher—was jointly and severally liable for an amount fifty times greater than the total net revenues it received from publishing all issues of *Spawn* and nearly

[2] The publisher of *Wizard* magazine was also a defendant but settled before trial.

five-hundred times greater than its annual net income for all of its publishing activities. (Trial Tr. at 562, 752-3; Trial Ex. F.)

Post-Trial Rulings and the Missouri Court of Appeals Decision

On post-trial motions, the trial court entered judgment notwithstanding the verdict ("JNOV") on various grounds. In the alternative, it granted a new trial if the JNOV were reversed on appeal. (App. 79a.)

The Missouri Court of Appeals affirmed the JNOV on First Amendment grounds:

> "To extend the right of publicity to allow a celebrity to control the use of his or her identity in a work of fiction would grant them power to suppress ideas associated with that identity, placing off-limits a useful and expressive tool. This, in turn, would effectively revoke the poetic license of those engaged in the creative process. To proscribe their right to use certain names, words, thoughts and ideas would ultimately apply to the rest of us, impeding our ability to express ourselves."

(App. 49a.)

The Missouri Supreme Court Decision

The decision below began its First Amendment analysis by looking to this Court's sole right-of-publicity decision, *Zacchini v. Scripps Howard Broadcasting Co.*, 433 U.S. 562 (1977). Although the Missouri court concluded that *Zacchini* did "not control the case at hand" because this Court had limited its holding to the unusual facts of that case (which involved the unauthorized television broadcast of Mr. Zacchini's entire 15-second "human cannonball" performance), it nevertheless read *Zacchini* to mean that media defendants in

right of publicity cases are not entitled to the same level of First Amendment protection afforded such defendants in libel, "false light," and other publication torts under *New York Times v. Sullivan*, 376 U.S. 254 (1964) and its progeny. (App. 14a-15a.)

The Missouri court acknowledged that right of publicity claims present a threshold First Amendment issue. In other jurisdictions, as the court explained, the issue is whether the accused speech is "expressive" or "commercial." If expressive, the First Amendment provides certain protections for the use of a celebrity's identity; if the speech is commercial, the use is not protected.

Conceding that the speech at issue here was expressive, the court examined what it characterized as the two principal tests used in other jurisdictions to distinguish between protected and unprotected speech, namely, the "relatedness" test under Section 47 of the Restatement (Third) of Unfair Competition and the "transformative use" test adopted by the California Supreme Court. (App. 17a-18a.)[3] Suggesting that Petitioners would prevail under either of those tests, the Missouri court rejected them both on the ground that "they give too little consideration to the fact that many uses of a person's name and identity have both expressive and commercial components." (App. 18a.) In the court's view, the problem under the existing tests was that "once the use is determined to be expressive, it is protected." (App. 18a.)

Instead, the Missouri Supreme Court announced a new First Amendment test, which it labeled the "predominant use" test. That test requires the court to

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[3] Actually, there is a third First Amendment test—"actual malice"—that governs right of publicity claims in the Ninth Circuit and elsewhere. *(See* pp. 16-18, *infra.)*

examine the nature and the artistic merit of the expressive speech to determine whether the use of the public figure's name is predominantly for a commercial gain or for an expressive purpose.

In applying its new constitutional test to the comic books at issue, the Missouri court weighed the literary value of the use of Respondent's name against its commercial value. The court acknowledged that Mr. McFarlane testified that he liked the name Tony Twist because he thought it was "a pretty cool name," that it was "easy to remember," and that with that particular character "you always have a Twist ending." (App. 21a.) Moreover, given that Respondent and the fictional Twistelli had been "enforcers" in their respective professions, the court conceded that there was "an expressive component in the use of [Respondent's] name and identity as a metaphorical reference to tough-guy 'enforcers.'" Nevertheless, the court concluded, "the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value." (App. 19a.) Having rendered its artistic opinion, the Missouri Supreme Court concluded that "the use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity." (App. 19a.)

The court then turned to the state law issues and examined the jury instructions for compliance with the three elements of a Missouri right of publicity claim, which are (1) use of Respondent's name as a symbol of his identity, (2) without his consent, and (3) "with the intent to obtain a commercial advantage." (App. 20a.) The court concluded that there was a "fatal flaw" in the verdict director because of its "failure to properly in-

struct the jury on the commercial advantage element of the tort." (App. 20a-21a.) Specifically, the instruction did not include the intent requirement. "Because the verdict director allowed the jury to render a verdict for [Respondent] without a finding that [Petitioners] *intended* to obtain a commercial advantage, and because the jury may well have determined that [Petitioners] obtained a commercial advantage even though they did not intend to do so, the verdict must be set aside." (App. 21a; emphasis in original.)

Having stripped Petitioners of their First Amendment defense, the court reversed the JNOV and remanded the case for a new trial on the tort claim.

REASONS FOR GRANTING THE PETITION

The right of publicity was first recognized a half century ago in a decision upholding the rights of baseball players to prevent unauthorized use of their likenesses on baseball cards, *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953). The tort is now recognized—by statute or common law—in most States. J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1.3 (2d ed. 2003).

During the quarter of a century since *Zacchini v. Scripps Howard Broadcasting Co.*, 433 U.S. 562 (1977), the right of publicity has become the kudzu of publishing torts. Celebrities who are foreclosed by the "actual malice" standard from asserting other claims against publishers have turned to the right of publicity. As lawsuits have multiplied, the nation's state and federal courts have struggled to define the constitutional limits on a State's power to award damages to a public figure who sues the creator of a work of artistic expression.

Unfortunately, the unusual facts of *Zacchini* have

hindered the lower courts' abilities to seek guidance from it. As one leading scholar notes, "while the *Zacchini* majority and dissenting opinions have been picked apart word by word by the commentators, no clear message emerges and no general rule is discernible by which to predict the result of conflicts between the right of publicity and the First Amendment." McCarthy, *supra*, § 8.27. Meanwhile, the number of inconsistent reported decisions continues to increase. Indeed, during the two months preceding the decision below, the California Supreme Court and two separate panels of the Sixth Circuit handed down significant but inconsistent First Amendment decisions in this area, one of which is the subject of a pending petition for a writ of certiorari. *LaFace Records v. Parks*, No. 03-504 (U.S. Sept. 30, 2003 filed). (*See* § I, *infra*.)

Until the present case, the tension between the expressive rights embodied in the First Amendment and the property rights embodied in a celebrity's right of publicity had produced three tests for determining whether the speech at issue is protected. The decision below deepens that conflict by rejecting those tests and adopting a new and far less protective test that allows a court to exercise artistic judgment to convert an expressive work into an unprotected work of commercial speech. In turning judges into art critics, the Missouri Supreme Court cast off a crucial premise not only of the other three tests but also of this Court's First Amendment jurisprudence.

Creators of expressive works protected by the First Amendment in forty-nine states are now exposed to the risk of crippling liability in Missouri, whose watered-down version of the First Amendment sets the national standard for works of expression that evoke the identity of a public figure. The chilling impact of this is clear.

Books, movies, songs, comics, and television shows are distributed to a national audience. Scribners cannot publish a special Missouri edition of Stephen King's *The Girl Who Loved Tom Gordon* in which it substitutes an imaginary Boston Red Sox relief pitcher for the real one in the novel's title. Nor can there be a Missouri-only version of Simon & Garfunkel's "Mrs. Robinson" in which the recording studio bleeps out Joe Dimaggio's name or dubs in a generic "you great baseball star." As a result, protected expression will be self-censored as creators and publishers try to steer clear of a close encounter with one of Missouri's black-robed art critics.

This case offers the Court the occasion to clarify the confusion and conflicts in the post-*Zacchini* case law. But more urgently we submit that this Court should consider the anomalous decision of the Supreme Court of Missouri, which is more threatening to First Amendment values than any of the tests now in common use.

I. The Decision Below Directly Conflicts With First Amendment Decisions By At Least Three Circuit Courts And The California and Kentucky Supreme Courts.

Review is warranted because, as even the Missouri Supreme Court concedes, its "predominant use" test conflicts with the First Amendment tests adopted by other courts and by the RESTATEMENT (THIRD) OF UNFAIR COMPETITION. Specifically, the decision below conflicts with the more speech-protective tests adopted by the California and Kentucky Supreme Courts and at least the Second, Sixth and Ninth Circuits. *Comedy III Productions, Inc. v. Saderup*, 21 P.3d 797, 808 (Cal. 2001), *cert. denied*, 534 U.S. 1078 (2002); *Winter v. DC Comics*, 69 P.3d 473, 477-78 (Cal. 2003); *Montgomery v. Montgomery*, 60 S.W.3d 524, 535-36 (Ky. 2001); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); *Parks v.*

LaFace Records, 329 F.3d 437, 461 (6th Cir.), *petition for cert. filed*, No. 03-504 (U.S. Sept. 30, 2003); and *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1186-87 (9th Cir. 2001).

A. The "Transformative Use" Test in California and Elsewhere.

In seeking to balance the tension between First Amendment values and a celebrity's right of publicity, the California Supreme Court in *Comedy III* turned to the "transformative use" standard this Court articulated in the context of copyright "fair use" in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). In the copyright context, the test asks "whether the new work merely 'supersede[s] the objects' of the original creation or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is 'transformative.'" *Campbell*, 510 U.S. at 579 (citations omitted). As applied by the California court to the right of publicity, the standard becomes "a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation." *Comedy III*, *supra*, 21 P.3d at 799. In making that determination, the *Comedy III* emphasized that "courts are not to be concerned with the quality of the artistic contribution—vulgar forms of expression fully qualify for First Amendment protection." *Id.* at 809.

Earlier this summer in *Winter*, the California Supreme Court applied that test in what the Missouri Supreme Court admitted was "a case with a remarkably similar fact situation." (App. 17a) In *Winter*, two long-haired albino rock musicians, Johnny and Edgar

Winter, sued DC Comics over two long-haired albino comic book characters, Johnny and Edgar Autumn, who resembled the musicians and were advertised as such. The California Supreme Court dismissed the claim, holding that the comic books at issue "contain significant creative elements that transform them into something more than mere celebrity likenesses." *Winter*, 69 P.3d at 475.

As here, the plaintiffs in *Winter* contended that the comic books did not qualify as parodies. The California court dismissed the argument: "It does not matter which precise literary category the work falls into. What matters is whether the work is transformative, not whether it is parody or satire or caricature or serious social commentary or any other specific form of expression." *Id.* at 479.[4]

As even the Missouri Supreme Court concedes, the works at issue here would have First Amendment protection under the "transformative use" test. Petitioners' use of the Tony Twist nickname for a fictional New York mob boss is about as far from a "mere celebrity likeness" as one could imagine.

Moreover, the manner in which the Missouri court applied its test to the facts—namely, weighing artistic value against commercial value—directly conflicts with the California test, under which "courts are not to be concerned with the quality of the artistic contribution." *Comedy III*, *supra*, 21 P.3d at 809. Finally, the Missouri court's focus on what it characterized as efforts to market the work—*e.g.*, truthful responses to two letters to the editor, distribution of *Spawn* comic books at a

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[4] The decision below erroneously states that Petitioners "agree" that their use of the Twist name "was not a parody." (App. 19a.) In fact, Petitioners contended that their use *was* a parody.

minor league hockey game—is forbidden under the California Supreme Court's test: "If the challenged work is transformative, the way it is advertised cannot somehow make it nontransformative." *Winter*, *supra*, 69 P.3d at 479.[5]

B. The "Relatedness" Test in the Second Circuit, Sixth Circuit and Kentucky Supreme Court.

As the Missouri Supreme Court explained, the "relatedness" test under Section 47 of the RESTATEMENT (THIRD) OF UNFAIR COMPETITION protects the use of a public figure's identity in a work that is "related to" that person. Specifically, Section 47—which defines what constitutes the use of a person's identity "for purposes of trade"—states that "use 'for purposes of trade' does not ordinarily include use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses." Comment c to Section 47 elaborates on the scope and limits of such usage:

> The right of publicity . . . is fundamentally constrained by the public and constitutional interest in freedom of expression. The use of a person's identity primarily for the purpose of communicating information or expressing ideas is not gener-

[5] Versions of the "transformative use" test also apply in the Sixth Circuit and the Tenth Circuit. The Sixth Circuit relied upon it dismissing the golfer Tiger Woods' right-of-publicity claim against the artist and distributors of unauthorized lithographs featuring Mr. Woods. *ETW Corp. v. Jireh Publ'n, Inc.*, 332 F.3d 915 (6th Cir. 2003). As discussed below at § I.B., earlier this year the Sixth Circuit also adopted the "relatedness" test. The Tenth Circuit applied the parody component of the test to affirm dismissal of right of publicity claims brought by Major League baseball players against a company that created parody baseball trading cards using caricatures of their names and likenesses. *Cardtoons v. Major League Players Ass'n*, 95 F.3d 959 (10th Cir. 1996).

> ally actionable as a violation of the person's right of publicity. The scope of activities embraced within this limitation on the right of publicity has been broadly construed . . . . Use of another's identity in a novel, play, or motion picture is also not ordinarily an infringement. The fact that the publisher or other user seeks or is successful in obtaining a commercial advantage from an otherwise permitted use of another's identity does not render the appropriation actionable. However, if the name or likeness is used solely to attract attention to a work that is not related to the identified person, the user may be subject to liability for a use of the other's identity in advertising.

RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995).

In *Rogers*, the Second Circuit adopted the "relatedness" test to determine whether the First Amendment barred a right-of-publicity claim by actress-dancer Ginger Rogers against the creators of the film "Ginger and Fred." The film was not about Ginger Rogers and Fred Astaire but about two fictional Italian cabaret performers who imitated the famous dancing duo and become known in Italy as "Ginger and Fred." *Rogers*, 875 F.2d at 996-97. In applying the "relatedness" test, *Rogers* held that the title of the movie was protected by the First Amendment because it was not "wholly unrelated" to the movie and was not "simply a disguised commercial advertisement for the sale of goods and services." *Id.* at 1005. Under this test, an expressive work is protected unless either the use of the celebrity's name "has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, . . . the title explicitly misleads as to the source or content of the work." *Id.* at 999.

Earlier this year, the Sixth Circuit adopted the same test in a lawsuit by civil rights icon Rosa Parks over the use of her name as the title of a rap song. *Parks*, 329 F.3d at 451-52 (6th Cir. 2003). Quoting the "relatedness" test set forth in *Rogers* and Section 47 of the Restatement, the court defined the issue as whether the title of the song—"Rosa Parks"—"is or is not 'wholly unrelated' to the content of the song." *Id.* at 461. So, too, the Kentucky Supreme Court applied the test in a right of publicity lawsuit over the unauthorized use of a musician's name and likeness in a music video. *Montgomery*, 60 S.W.3d at 529-30 (citing *Rogers* and finding use of name and likeness to be "intimately related to the underlying work" and "not a disguised commercial advertisement").

Under the "relatedness" test, the *Spawn* comics have full First Amendment protection. The nickname Tony Twist is "related" and "artistically relevant" to the underlying work on several levels, ranging from the "enforcer" and "goon" metaphors to the allusion to "twist" endings. Moreover, the use of Tony Twist as a nickname of a minor character in the comics—as opposed to, say, the title of a rap song or a motion picture—can in no way be deemed to "explicitly mislead[ ] as to the source or content of the work." *Rogers*, 875 F.2d at 999. Nevertheless, the Missouri Supreme Court rejected this First Amendment test. (App. 18a.)

C. The "Actual Malice" Test in the Ninth Circuit and Elsewhere.

In *Hoffman*, actor Dustin Hoffman sued *Los Angeles Magazine*, claiming that an article on Spring fashions violated his right of publicity. The article featured stills from famous movies that had been altered to make it appear that the actors were wearing that season's fashions. One such still was of Mr. Hoffman in drag

from the movie *Tootsie.* In the altered version, Mr. Hoffman's head remained but his body had been replaced by the body of a male model in the same pose but wearing a silk evening gown and high-heeled sandals. The text read, "Dustin Hoffman isn't a drag in a butter-colored silk gown by Richard Tyler and Ralph Lauren heels." *Hoffman*, 255 F.3d at 1183. Although there were undeniably commercial aspects to the article, the Ninth Circuit determined that the publisher was "entitled to the full First Amendment protection accorded non-commercial speech" because the commercial aspects were " 'inextricably entwined' with the expressive elements, and . . . cannot be separated out 'from the fully protected whole.' " *Id.* at 1185-86.

The Ninth Circuit then turned to the issue of how to balance the right of publicity and the First Amendment in the context of an expressive work. It held that the appropriate test is the "actual malice" standard originally articulated by this Court in *New York Times v. Sullivan*, 376 U.S. 254 (1964). *Hoffman*, 255 F.3d at 1186. As applied to the facts before it, the court determined that Mr. Hoffman failed to prove that the publisher intended to create the false impression in the minds of its readers that "Hoffman himself posed for the altered photograph." *Id.* at 1187.

Significantly, the Ninth Circuit rejected Mr. Hoffman's contention that the existence of commercial elements in the article converted it into commercial speech. " '[T]here are commonsense differences between speech that does no more than propose a commercial transaction and other varieties,' *Va. St. Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 n.24 (1976), and common sense tell us this is not a simple advertisement." *Hoffman*, 255 F.3d at 1185-86.

Under the "actual malice" standard, the *Spawn* comics and HBO series have full First Amendment protection. There was no evidence that any Petitioner intended "to create the false impression in the mind of its readers" that Respondent was actually a mob enforcer or otherwise connected with organized crime in New York or elsewhere. However, the Missouri Supreme Court deemed that test inapplicable to a right-of-publicity claim. (App. 16a.) Moreover, it rejected the Ninth Circuit's expressive/commercial speech divide by holding that a court could isolate a single element in the expressive work and apply its literary judgment to determine whether the use of the public figure was predominantly commercial.[6]

II. The Decision Below Presents A First Amendment Issue Of National Importance In That It Chills Protected Speech Far Beyond Missouri's Borders.

A celebrity seeking to file a right-of-publicity suit against a national publication or motion picture studio has the choice of many forums. While the elements of the cause of action vary little from State to State, the scope of First Amendment protection now varies greatly. The existence of conflicting First Amendment standards has a chilling impact on artistic expression, as

[6] The Ninth Circuit is not alone in holding that the "actual malice" standard governs *all* publishing torts. In a case involving the Dick Tracy comic strip, the Illinois Appellate Court held that under *New York Times v. Sullivan*, its dismissal of the defamation claim required dismissal of the related claims for invasion of privacy and intentional infliction of emotional distress because "the same first amendment considerations must be applied." *Flip Side, Inc. v. Chicago Tribune Co.*, 564 N.E.2d 1244, 1254 (Ill. App. Ct. 1991). *Accord Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 194 F.3d 505, 522-24 (4th Cir. 1999)(First Amendment precludes award of publication damages for non-reputational tort claims unless plaintiff satisfies the proof standard of *New York Times*).

this case amply demonstrates. The *Spawn* comics and HBO series at issue here have no First Amendment protection in Missouri but full protection in California, Kentucky, and in the Second, Sixth and Ninth Circuits. By contrast, the First Amendment protects the comics at issue in the *Winter* case everywhere but in Missouri. This is an intolerable situation that deprives the freedoms of expression of the very "breathing space" this Court deems essential to their survival. *N.Y. Times*, 376 U.S. at 272.

Beginning with defamation, this Court has stepped into the realm of publication torts on several occasions to insure that the same version of the First Amendment applies throughout the nation. In *New York Times v. Sullivan*, the court surveyed various libel standards and held that "[t]he constitutional guarantees require . . . a federal rule that prohibits a public official from recovering damages for a defamatory falsehood relating to his official conduct unless he proves that the statement was made with 'actual malice' — that is, with knowledge that it was false or with reckless disregard of whether it was false or not." *N.Y. Times*, 376 U.S. at 279-80.

The Court extended that rule to the "false light" tort in *Time, Inc. v. Hill*, 385 U.S. 374, 390-91 (1967), and more recently to the tort of intentional infliction of emotional distress in *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988) (rejecting Virginia's "outrageousness" standard). The Court reiterated "that such a standard is necessary to give adequate 'breathing space' to the freedoms protected by the First Amendment." *Id.* at 56 (quoting *N.Y. Times*, 376 U.S. at 279-80).

The split in the courts underscores the need for a uniform First Amendment rule. Missouri is now the lowest common denominator of free speech in the area

of right of publicity. Its watered-down and inherently unpredictable test sets the *national* standard for works of expression that evoke the identity of a public figure. No prudent record producer could take the risk that a Missouri judge in, say, Grundy County, might decide that the commercial value derived by singer Kim Carnes from use of the name Bette Davis in the title and lyrics of her 1991 Grammy award-winning song "Bette Davis Eyes" outweighed the artistic value of that use. So, too, the makers of the motion picture "Searching for Bobby Fischer" would risk financial ruin in Missouri if they didn't change the title to "Searching for a Champion Chess Player." Indeed, if the name of a journeyman hockey player is worth $24.5 million, imagine the Missouri price tag on the most famous soccer player in the world, whose name is in the title of the current motion picture "Bend It Like Beckham." Many popular songs—including Madonna's "Vogue" and Billy Joel's "We Didn't Start the Fire"—use enough public figure names to populate a Missouri class action.[7]

Artists need assurance that what is protected in one State is protected in all States. As Judge Kozinski pointed out in his oft-quoted dissent from the order rejecting rehearing *en banc* in *White v. Samsung Electronics America, Inc.*, 989 F.2d 1512 (9th Cir. 1993),

> The First Amendment isn't just about religion or politics—it's also about protecting the free development of our national culture... The last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep

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[7] The lyrics to "Vogue" include the stanza: "Greta Garbo, and Monroe/ Deitrich and DiMaggio/ Marlon Brando, Jimmy Dean/ On the cover of a magazine." The Billy Joel song lists the names of scores of public figures, including politicians, authors, singers, astronauts and actors.

people from mocking them, or from 'evoking' their images in the mind of the public.

Id. at 1519.

III. Certiorari Is Warranted Because The Decision Below Allows Missouri Judges To Strip Core Speech Of First Amendment Protection If A Judge Decides That The Commercial Value Of The Expression Outweighs Its Literary Value.

In *New York Times v. Sullivan*, 376 U.S. 254 (1964), this Court rejected the argument that the First Amendment did not protect false statements in a newspaper advertisement by civil rights activists seeking contributions to their cause. Pointing out that the advertisement also communicated information and expressed opinions on matters of public concern, the Court held "that if the allegedly libelous statements would otherwise be constitutionally protected from the present judgment, they do not forfeit that protection because they were published in the form of a paid advertisement." *Id.* at 266.

Four decades later, the Missouri Supreme Court has turned that holding on its head, ruling that works of artistic expression that would otherwise be constitutionally protected could forfeit that protection if a judge determines that the artistic value of an isolated excerpt from the work is outweighed by its commercial value. As Justice Holmes observed one hundred years ago, "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

Even putting aside the chilling effect of turning judges into art critics, the "predominant use" test violates two basic principles of this Court's First Amendment jurisprudence, namely, that the scope of protection does not depend upon the quality of the expression or the commercial intent of the speaker.

The Missouri Supreme Court's decision to make First Amendment protection depend upon a judge's opinion about the literary value of the expression violates a line of decisions running back at least to *Winter v. New York*, 333 U.S. 507 (1948), where the Court, in refusing to draw a First Amendment distinction between serious political advocacy and allegedly frivolous entertainment, warned: "What is one man's amusement, teaches another's doctrine. Though we can see nothing of any possible value to society in these magazines, they are as much entitled to the protection of free speech as the best of literature." *Id.* at 510. *See also Cohen v. California*, 403 U.S. 15, 25 (1971) ("it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual"); *Hustler Magazine v. Falwell*, 485 U.S. 46, 55 (1988) (extending First Amendment protection to caricature of nationally known minister portrayed as engaging in a drunken incestuous affair with his mother, despite fact that the work "is at best a distant cousin of the political cartoons described above, and a rather poor relation at that").

As for the irrelevance of the artist's commercial motives, this Court held that "[i]f a profit motive could somehow strip communications of the otherwise available constitutional protection, our cases from *New York Times* to *Hustler Magazine* would be little more than empty vessels." *Harte-Hanks Communications, Inc. v. Connaughton*, 491 U.S. 657, 667 (1989). Yet that is

precisely what the Missouri Supreme Court did here by sifting the evidence for a profit motive and using it to strip the comic books "of the otherwise available constitutional protection."

IV. The Decision Below Satisfies The "Finality" Requirement And Chills Protected Speech In A Manner That Requires This Court's Prompt Attention.

The Missouri court has announced a new First Amendment standard, applied it to the expressive works at issue, and declared that "free speech must give way to the right of publicity." (App. 19a.) There is no reason to defer review for the years (and the expense) it will take to complete the proceedings on remand.

Although this Court's jurisdiction is limited by 28 U.S.C. § 1257 to "final judgments or decrees" of the state courts, the Court has adopted a "pragmatic," rather than "mechanical," approach to determining whether a judgment is "final." *See Cox Broad. Corp. v. Cohn*, 420 U.S. 469, 477, 486 (1975); ROBERT L. STERN, et al., SUPREME COURT PRACTICE, § 3.5 (8th ed. 2002). This case satisfies all necessary elements of a final judgment under the *Cox Broadcasting* standard.

Cox Broadcasting, as here, involved a clash between First Amendment values and State tort law in the media context. The plaintiff had sued for violation of his right of privacy based upon defendants' publication of his daughter's name. *Cox Broad. Corp.*, 420 U.S. at 474. Rejecting the defendants' free speech defense, the state supreme court reversed summary judgment and remanded for a trial to determine whether defendants' conduct was willful or negligent. *Id.* at 474-75. This Court took jurisdiction and held that the First Amendment barred the plaintiff's claim. *Id.* at 496-97.

In accepting jurisdiction, *Cox Broadcasting* articulated the standards for determining when a federal question has been finally determined for jurisdictional purposes despite a remand for further proceedings. *Id.* at 477. Pertinent here is what the Court identified as the fourth category of "non-final" final judgments:

> [W]here the federal issue has been finally decided in the state courts with further proceedings pending in which the party seeking review here might prevail on the merits on nonfederal grounds, thus rendering unnecessary review of the federal issue by this Court, and where reversal of the state court on the federal issue would be preclusive of any further litigation on the relevant cause of action... [in] the state court proceedings still to come. In these circumstances, if a refusal immediately to review the state-court decision might seriously erode federal policy, the Court has entertained and decided the federal issue, which itself has been finally determined by the state courts for the purposes of the state litigation.

Id. at 482-83.

The decision below falls squarely within this analysis and stands in stark contrast to the decision last term to dismiss the writ of certiorari as improvidently granted in *Nike, Inc. v. Kasky*, 123 S. Ct. 2554, 2555 (2003) (*per curiam*). Indeed, the finality factors here are even more compelling than those in *Cox Broadcasting* itself. *Nike* came before this Court after a dismissal at the initial pleading stage. None of the allegations in that case had been tested in discovery, and the scope and nature of the speech at issue had not been completely defined or determined. *Cox Broadcasting* came before this Court after the state supreme court reversed a grant of summary judgment and remanded for trial on the merits.

By contrast, here there has been a full trial on the merits. Claims, evidence and issues have been examined and narrowed through years of discovery and extensive pretrial motion practice. Respondent has fine-tuned his claims in pleadings that he amended more than once. The record below was established in a several week jury trial. The parties thereafter refined and tested their theories in post-trial motions and appeals.

The existence of both a full record and a large body of appellate decisions on the constitutional issue combine to eliminate the other jurisdictional concern Justice Stevens expressed in his concurring opinion in *Nike,* namely the Court's reluctance to "anticipate" novel and important constitutional questions. Although Justice Stevens agreed that questions concerning the scope of protection for the speech at issue in *Nike* "are questions that may have to be decided in this litigation," he stressed that "[t]he correct answer to such questions, however, is more likely to result from the study of a full factual record than from a review of mere unproven allegations in a pleading." *Nike, supra, 123* S.Ct. at 2559. Here, that full record already exists. Moreover, as the myriad appellate decisions around the nation attest, the constitutional issue is no longer novel.

In short, the federal question in this case has been fully aired and finally adjudicated by the state courts. Specifically, the Missouri Supreme Court (a) examined the trial evidence, (b) rejected the prevailing First Amendment standards that would have prohibited Respondent's claim, (c) articulated the standard to govern all right of publicity cases in Missouri, (d) applied that standard to the facts established by the trial record, and (e) held that "free speech must give way to the right of publicity." (App. 19a.)

Having stripped Petitioners of their First Amendment defense, the Missouri court left no federal issue to be resolved on remand. Accordingly, if Petitioners prevail on the remaining nonfederal grounds, that would render unnecessary any review by this Court of the First Amendment concerns raised by the Missouri Supreme Court's decision. The "predominate use" test would thus remain the law in Missouri and chill protected expression far beyond its borders.

If this Court were to reverse the decision below on First Amendment grounds, the case would end. But a refusal to review the decision below will seriously erode federal constitutional policy favoring free speech. The extent to which the First Amendment limits the ability of the States to impose liability for nondefamatory uses of a public figure's name in a work of expression should not remain in doubt. "Whichever way [this Court] were to decide on the merits, it would be intolerable to leave unanswered, under these circumstances, an important question of freedom of the press under the First Amendment; an uneasy and unsettled constitutional posture of [the right of publicity] could only further harm the operation of a free press." *Miami Herald Publ'n Co. v. Tornillo*, 418 U.S. 241, 247, n.6 (1974).

So long as the decision below stands while the rest of the case slowly wends its way through the Missouri trial and appellate courts, the "predominant use" test will function as the de facto national standard for works of expression that evoke the name of a public figure. Creators and national distributors of motion pictures, novels, songs, comics and other works of artistic expression who ignore the Missouri test do so at their peril, and those who misconstrue the artistic tastes of a Missouri judge will pay a heavy price. Accordingly, many in the publishing and entertainment communities—out of reasonable caution or even excess cau-

tion—will censor their expression far beyond what the First Amendment requires.

For these reasons, exercise of jurisdiction in this case is not only "consistent with the pragmatic approach that [this Court has] followed in the past in determining finality," but essential to safeguard key First Amendment freedoms. *Cox Broad. Corp.*, 420 U.S. at 486.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

Appendix A

Supreme Court of Missouri
en banc.

JOHN DOE, a/k/a TONY TWIST, Appellant,

V.

TCI CABLEVISION, et al.,
Respondents.

No. SC84856.

APPEAL FROM THE CIRCUIT COURT
OF THE CITY OF ST. LOUIS

Appellant Anthony Twist, also known as Tony Twist, is a former professional hockey player in the National Hockey League. After learning of the existence of a comic book, titled *Spawn,* that contained a villainous character sharing his name, Twist brought misappropriation of name and defamation claims against respondents, the creators, publishers and marketers of *Spawn* and related promotional products. Respondents defended on First Amendment grounds. The circuit court dismissed the defamation count, but allowed the misappropriation of name count to go to trial, which resulted in a jury verdict in favor of Twist in the amount of $24,500,000. The circuit court, however, granted respondents' motion for judgment notwithstanding the verdict and, in the alternative, ordered a new trial in the event that its judgment notwithstanding the verdict was overturned on appeal. A request for injunctive relief was also denied. After appeal to the Court of

Appeals, Eastern District, this Court granted transfer. Mo. Const. art. V, sec. 10.

I.

Tony Twist began his NHL career in 1988 playing for the St. Louis Blues, later to be transferred to the Quebec Nordiques, only to return to St. Louis where he finished his career in 1999, due to injuries suffered in a motorcycle accident. During his hockey career, Twist became the League's preeminent "enforcer," a player whose chief responsibility was to protect goal scorers from physical assaults by opponents. In that role, Twist was notorious for his violent tactics on the ice. Describing Twist, a *Sports Illustrated* writer said: "It takes a special talent to stand on skates and beat someone senseless, and no one does it better than the St. Louis Blues left winger." Austin Murphy, *Fighting For A Living: St. Louis Blues Enforcer Tony Twist, Whose Pugilistic Talents Appear To Run In The Family, Doesn't Pull Any Punches On The Job,* SPORTS ILLUSTRATED, Mar. 16, 1998, at 42. The article goes on to quote Twist as saying, "I want to hurt them. I want to end the fight as soon as possible and I want the guy to remember it." *Id.*

Despite his well-deserved reputation as a tough-guy "enforcer," or perhaps because of that reputation, Twist was immensely popular with the hometown fans. He endorsed products, appeared on radio and television, hosted the "Tony Twist" television talk show for two years, and became actively involved with several children's charities. It is undisputed that Twist engaged in these activities to foster a positive image of himself in the community and to prepare for a career after hockey as a sports commentator and product endorser.

Respondent Todd McFarlane, an avowed hockey fan

and president of Todd McFarlane Productions, Inc. (TMP), created *Spawn* in 1992. TMP employs the writers, artists and creative staff responsible for production of the comic book. *Spawn* is marketed and distributed monthly by Image Comics, Inc., which was formed by McFarlane and others.

Spawn is "a dark and surreal fantasy" centered on a character named Al Simmons, a CIA assassin who was killed by the Mafia and descended to hell upon death. Simmons, having made a deal with the devil, was transformed into the creature Spawn and returned to earth to commit various violent and sexual acts on the devil's behalf. In 1993, a fictional character named "Anthony 'Tony Twist' Twistelli" was added to the *Spawn* storyline. The fictional "Tony Twist" is a Mafia don whose list of evil deeds includes multiple murders, abduction of children and sex with prostitutes. The fictional and real Tony Twist bear no physical resemblance to each other and, aside from the common nickname, are similar only in that each can be characterized as having an "enforcer" or tough-guy persona.

Each issue of the *Spawn* comic book contains a section entitled "Spawning Ground" in which fan letters are published and McFarlane responds to fan questions. In the September 1994 issue, McFarlane admitted that some of the *Spawn* characters were named after professional hockey players, including the "Tony Twist" character: "Antonio Twistelli, a/k/a Tony Twist, is actually the name of a hockey player of the Quebec Nordiques." And, again, in the November 1994 issue, McFarlane stated that the name of the fictional character was based on Twist, a real hockey player, and further promised the readers that they "will continue to see current and past hockey players' names in my books."

In April 1996, *Wizard,* a trade magazine for the comic book industry, interviewed McFarlane. In the published article, "Spawning Ground: A Look at the Real Life People Spawn Characters Are Based Upon," McFarlane is quoted as saying that he uses the names of real-life people to create the identities of the characters. Brief biographies and drawings of the *Spawn* characters follow the McFarlane interview. The paragraph devoted to the "Tony Twist" character contained a drawing of the character accompanied by the following description:

> First Appearance: Spawn # 6
>
> Real-Life Persona: Tony Twist.
>
> Relation: NHL St. Louis Blues right winger.
>
> The Mafia don that has made life exceedingly rough for Al Simmons and his loved ones, in addition to putting out an ill-advised contract on the Violator, is named for former Quebec Nordiques hockey player Tony Twist, now a renowned enforcer (i.e."Goon") for the St. Louis Blues of the National Hockey League.

Below the character description was a photo of a Tony Twist hockey trading card, in which Twist was pictured in his St. Louis Blues hockey jersey.

In 1997, Twist became aware of the existence of *Spawn* and of the comic book's use of his name for that of the villainous character. On one occasion, several young hockey fans approached Twist's mother with Spawn trading cards depicting the Mafia character "Tony Twist." Subsequently, at an autograph session Twist was asked to sign a copy of the *Wizard* article in which McFarlane was interviewed and Twist's hockey trading card was pictured.

In October 1997, Twist filed suit against McFarlane and various companies associated with the *Spawn* comic book (collectively "respondents"), seeking an injunction and damages for, *inter alia,* misappropriation of name and defamation, the latter claim being later dismissed. McFarlane and the other defendants filed motions for summary judgment asserting First Amendment protection from a prosecution of the misappropriation of name claim, but the motions were overruled.

At trial, McFarlane denied that the comic book character was "about" the real-life Tony Twist despite the fact that the names were the same. McFarlane also denied that he or the other defendants had attained any benefit by using Twist's name. Twist, however, presented evidence that McFarlane and the other defendants had indeed benefited by using his name. For example, Twist introduced evidence suggesting that in marketing Spawn products, McFarlane directly targeted hockey fans--Twist's primary fan base--by producing and licensing Spawn logo hockey pucks, hockey jerseys and toy zambonis. On crossexamination, McFarlane admitted that on one occasion defendants sponsored "Spawn Night" at a minor league hockey game, where McFarlane personally appeared and distributed Spawn products, including products containing the "Tony Twist" character. Another "Spawn Night" was planned to take place at a subsequent NHL game, but the event never occurred. On the issue of damages, Twist, through purported expert testimony, offered a formula for determining the fair market value that McFarlane and the other defendants should have paid Twist to use his name. In addition, Twist introduced evidence that his association with the *Spawn* character resulted in a diminution in the commercial value of his name as an endorser of products. To that end, Sean Philips, a former executive of a sports nutrition com-

pany, testified that his company withdrew a $100,000 offer to Twist to serve as the company's product endorser after Philips learned that Twist's name was associated with the evil Mafia don in the *Spawn* comic book.

As noted, at the conclusion of the trial, the jury returned a verdict in favor of Twist and against the defendants jointly in the amount of $24,500,000. On motions for a judgment notwithstanding the verdict or in the alternative a new trial, the circuit court overturned the verdict finding that Twist had failed to make a submissible case on the misappropriation of name count. The court further held that in the event the judgment notwithstanding the verdict was reversed on appeal, the motion for new trial was granted for evidentiary and instructional errors. Finally, the circuit court denied Twist's request for injunctive relief.

II.

The tort of misappropriation of name is one of four recognized torts falling under the general heading of invasion of privacy. *Sullivan v. Pulitzer Broadcasting Co.*, 709 S.W.2d 475, 477 (Mo. banc 1986). The interest protected by the misappropriation of name tort "is the interest of the individual in the exclusive use of his own identity, in so far as it is represented by his name or likeness, and in so far as the use may be of benefit to him or others." RESTATEMENT (SECOND) OF TORTS sec. 652C cmt. a (1977). Recently, development of the misappropriation of name tort has given rise to a separate yet similar tort termed the "right of publicity," which is said to "protect a person from losing the benefit of their [sic] work in creating a publicly recognizable persona." *Bear Foot, Inc. v. Chandler,* 965 S.W.2d 386, 389 (Mo.App.1998). Though facially similar, the protections afforded by each tort are slightly different: "the

[misappropriation of name tort] protects against intrusion upon an individual's private self-esteem and dignity, while the right of publicity protects against commercial loss caused by appropriation of an individual's [identity] for commercial exploitation." 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION sec. 28.6 (4th ed. 2003); *see also Bear Foot,* 965 S.W.2d at 389 ("In contrast to the [misappropriation of name tort], the right of publicity is not intended to protect the person's feelings....")

Because the two torts differ in the type of protection that each seeks to provide, there are corresponding differences between the types of damages that may be recovered. In a misappropriation of name action, a plaintiff may recover damages not only for pecuniary loss, but also for mental or emotional distress and suffering. *See Haith v. Model Cities Health Corp. of Kansas City,* 704 S.W.2d 684, 688 (Mo.App.1986); RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 49 cmt. b (1995); MCCARTHY, TRADEMARKS sec. 28.6 (explaining that in misappropriation of name actions, damages are "measured by 'mental distress'--some bruising of the human psyche.") By contrast, in a right of publicity action, "the measure of damages properly focuses on the pecuniary loss to the plaintiff or the unjust pecuniary gain to the defendant." RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 49 cmt. b; *see also Bear Foot,* 965 S.W.2d at 389; *Haith,* 704 S.W.2d at 688.

In this case, Twist seeks to recover the amount of the fair market value that respondents should have paid to use his name in connection with Spawn products and for damage done to the commercial--value in effect the endorsement value--of his name. Therefore, Twist's case, though brought as a misappropriation of name action, is more precisely labeled a right of publicity

action--a point that both parties appear to concede in their briefs.

Despite the differences in the types of damages that may be recovered, the elements of the two torts are essentially the same. To establish the misappropriation tort, the plaintiff must prove that the defendant used the plaintiff's name without consent to obtain some advantage. *Nemani v. St. Louis Univ.*, 33 S.W.3d 184, 185 (Mo. banc 2000); *Haith,* 704 S.W.2d at 687. In a right of publicity action, the plaintiff must prove the same elements as in a misappropriation suit, with the minor exception that the plaintiff must prove that the defendant used the name to obtain a *commercial* advantage. RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 46; *see also* RESTATEMENT (SECOND) OF TORTS sec. 652C cmt. b (explaining that, in contrast, the misappropriation of name tort applies when plaintiff's name is used for commercial *or* non-commercial advantage). Given the similarity of elements of the two actions, Missouri cases analyzing the tort of misappropriation of name are pertinent to our recognition of a right of publicity claim.

In *Nemani,* the plaintiff, a research professor, brought suit against St. Louis University after the university used plaintiff's name in support of a federal grant application. This Court, reviewing the claim as a misappropriation of name tort, held that a defendant is liable under the tort when it uses a plaintiff's name without consent to obtain an advantage. 33 S.W.3d at 185. However, this Court was careful to point out that "[n]ot all uses of another's name are tortious":

> It is the plaintiff's name *as a symbol of [his] identity* that is involved here, and not [his name] as a mere name. Name appropriation occurs where a defendant makes use of the name to pirate the plaintiff's

identity for some advantage.

Id. (Citations omitted.) (Emphasis added.) *See also Haith,* 704 S.W.2d 684; *Munden v. Harris,* 153 Mo.App. 652,134 S.W. 1076 (1911).

In addition, though *Nemani* did not expressly so hold, an element of intent is implicit in the requirement that the identity be used to obtain an advantage. In a right of publicity case, plaintiff must prove that defendant intended to obtain a commercial advantage, and it is not enough to show that defendant incidentally obtained a commercial advantage by using plaintiff's name or that defendant had some other purpose in using plaintiff's name other than to obtain a commercial advantage. *Wendt v. Host Int'l, Inc.,* 125 F.3d 806, 811 (9th Cir.1997); *Benavidez v. Anheuser Busch, Inc.,* 873 F.2d 102, 104 (5th Cir.1989); *Henley v. Dillard Dept. Stores,* 46 F.Supp.2d 587, 596 (N.D.Tex.1999); *see generally* RESTATEMENT (SECOND) OF TORTS sec. 652C cmt. d (explaining that a misappropriation of name or likeness claim stands only if the name or likeness was used "for the purpose of appropriating to the defendant's benefit the commercial or other values associated with the name of likeness").

To summarize, in view of *Nemani* and the earlier precedent of *Bear Foot,* and consistent with the RESTATEMENT (THIRD) OF UNFAIR COMPETITION, the elements of a right of publicity action include: (1) That defendant used plaintiff's name as a symbol of his identity (2) without consent (3) and with the intent to obtain a commercial advantage.

In this case, the circuit court's entry of JNOV was based on a finding that Twist failed to make a submissible case on the commercial advantage element. In addition, and though the court implicitly held

otherwise, respondents claim that the grant of JNOV also was justified because Twist failed to prove that his name was used as "symbol of his identity."

"Generally, in determining whether a plaintiff made a submissible case, the evidence is considered in the light most favorable to the plaintiff, giving him all reasonable beneficial inferences." *Emery v. Wal-Mart Stores, Inc.*, 976 S.W.2d 439, 443 (Mo. banc 1998). It is "only where there is a complete absence of probative fact to support the jury's conclusion" that this Court will decide that a submissible case was not made. *Giddens v. Kansas City Southern Ry.* Co., 29 S.W.3d 813, 818 (Mo. banc 2000).

A.

Respondents' initial contention that Twist did not prove that his name was used as a "symbol of his identity" is spurious. To establish that a defendant used a plaintiff's name as a symbol of his identity, "the name used by the defendant must be understood by the audience as referring to the plaintiff." RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 46 cmt. d; *see also* J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY sec. 4.48 (2d ed.2000) (quoting *Geisler v. Petrocelli,* 616 F.2d 636, 639 (2d Cir.1980)) (stating that the defendant's use of the name must be " 'something more than [an] amusing coincidence' "). In resolving this issue, the fact-finder may consider evidence including "the nature and extent of the identifying characteristics used by the defendant, the defendant's intent, the fame of the plaintiff, evidence of actual identification made by third persons, and surveys or other evidence indicating the perceptions of the audience." RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 46 cmt. d.

Here, all parties agree that the "Tony Twist" charac-

ter is not "about" him, in that the character does not physically resemble Twist nor does the *Spawn* story line attempt to track Twist's real life. Instead, Twist maintains that the sharing of the same (and most unusual) name and the common persona of a tough-guy "enforcer" create an unmistakable correlation between Twist the hockey player and Twist the Mafia don that, when coupled with Twist's fame as a NHL star, conclusively establishes that respondents used his name and identity. This Court agrees. Indeed, respondent McFarlane appears to have conceded the point by informing his readers in separate issues of *Spawn* and in the *Wizard* article that the hockey player Tony Twist was the basis for the comic book character's name.

Arguably, without these concessions, some *Spawn* readers may not have made the connection between Twist and his fictional counterpart. However, other evidence at trial clearly demonstrated that, at some point, *Spawn's* readers did in fact make the connection, for both Twist and his mother were approached by young hockey fans under the belief that appellant was somehow affiliated with the *Spawn* character. On this record, respondents cannot seriously maintain that a good many purchasers of *Spawn* did not readily understand that respondents' use of the name referred to appellant. Accordingly, this Court holds that Twist presented sufficient evidence to prove that his name was used as a symbol of his identity.

B.

As noted, the grant of JNOV was based on the commercial advantage element of the cause of action. Specifically, the court held that the record was devoid of credible evidence that respondents intended (1) "to injure Twist's marketability," (2) "to capitalize on the market recognition of the name," or (3) "derived any

pecuniary benefit whatsoever from the use of that name."

At the outset, two of the premises for the circuit court's rationale are incorrect: Twist was under no obligation to prove that respondents intended to injure Twist's marketability or that respondents actually derived a pecuniary benefit from the use of his name. As explained, the commercial advantage element of the right of publicity focuses on the defendant's intent or purpose to obtain a commercial benefit from use of the plaintiff's identity. But in meeting the commercial advantage element, it is irrelevant whether defendant intended to injure the plaintiff, McCarthy, Rights of Publicity sec. 3.28, or actually succeeded in obtaining a commercial advantage from using plaintiff's name, *see Brown v. Ames,* 201 F.3d 654, 661- 62 (5th Cir.2000); *Henley,* 46 F.Supp.2d at 597; McCarthy, Rights of Publicity sec. 3.2. That said, it still was incumbent upon Twist to prove that respondents used his name intending to obtain a commercial advantage.

Twist contends, and this Court again agrees, that the evidence admitted at trial was sufficient to establish respondents' intent to gain a commercial advantage by using Twist's name to attract consumer attention to *Spawn* comic books and related products. As the Ninth Circuit noted in *Abdul-Jabbar v. General Motors Corp.,* 85 F.3d 407, 416 (9th Cir.1996), "The first step toward selling a product or service is to attract the consumers' attention." (Citation omitted.) *See also id.* at 415 (holding that to the extent that defendant's use of plaintiff's name attracted consumers' attention to its product, defendant gained a commercial advantage); *Henley,* 46 F.Supp.2d at 597 (holding that the commercial advantage or benefit element is shown if by using plaintiff's name or likeness in the product defendant sought "to

catch the eye of the consumer and make the [product] more interesting"); RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 47 cmt. c. At a minimum, respondents' statements and actions reveal their intent to create the impression that Twist was somehow associated with the *Spawn* comic book, and this alone is sufficient to establish the commercial advantage element in a right of publicity action. *See Abdul-Jabbar,* 85 F.3d at 414-16; *Carson v. Here's Johnny Portable Toilets, Inc.,* 698 F.2d 831, 835-36 (6th Cir.1983) (holding that defendants violated plaintiff Johnny Carson's right of publicity when it used the phrase, "Here's Johnny," in its advertisement); *Henley,* 46 F.Supp.2d at 592-93 (holding in right of publicity case that defendant's use of the words, "Don's Henley," in advertisement was intended to elicit an association with plaintiff Don Henley).

But this is not all. At trial, Twist introduced evidence that respondents marketed their products directly to hockey fans. For example, respondents produced and distributed Spawn hockey jerseys and pucks and sponsored a "Spawn Night" at a minor league hockey game where other Spawn products were distributed, including products featuring the character "Tony Twist." Additionally, Twist points to McFarlane's statement in the November 1994 issue of *Spawn,* in which he promised readers that "they will continue to see current and past hockey players' names in [his] books." This statement, Twist correctly contends, amounts to an inducement to *Spawn* readers, especially those who are also hockey fans, to continue to purchase the comic book in order to see the name Tony Twist and other hockey players. This is evidence from which the jury could infer that respondents used his name to obtain a commercial advantage.

In support of the court's ruling that the evidence

presented was insufficient to show that Twist's name was used to obtain a commercial advantage, respondents cite *Nemani, Haith, and Munden* to demonstrate the kind of commercial advantage that must be shown and to highlight that Twist's evidence was dissimilar. In *Nemani* and *Haith,* the defendants used the plaintiffs' names in grant applications for money; in *Munden,* the defendant used a picture of the plaintiff in an advertisement. Though it is true that respondents' intent to obtain a commercial advantage is not as obvious as that found in *Nemani, Haith,* and *Munden,* the fact remains that to the extent that the evidence suggests that respondents used Twist's name to attract attention to their product, they did so to obtain a commercial advantage. Therefore, this Court holds that Twist presented sufficient evidence to establish that respondents used his name for a commercial advantage.

III.

Having determined that Twist made a submissible case at trial, we next address whether the right of publicity claim is nevertheless prohibited by the First Amendment. Courts throughout the country have struggled with this issue. Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface,* 23 LOY. L.A. ENT. L.REV. 471, 488-98 (2003). Of course, not all speech is protected under the First Amendment, and in cases like this, courts often will weigh the state's interest in protecting a plaintiff's property right to the commercial value of his or her name and identity against the defendant's right to free speech.

Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977) is the first and only right of publicity case decided by the

Supreme Court. The case involved the unauthorized broadcast of a videotape of the plaintiff's 15-second "human cannonball" act during a nightly news program. The plaintiff brought suit under the state-recognized tort of right of publicity, alleging that the unauthorized broadcast amounted to an "unlawful appropriation" of his "professional property," and the defendant broadcasting company defended on First Amendment grounds. In balancing the respective parties' interests, the Court held, "Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent." *Zacchini,* 433 U.S. at 574-75, 97 S.Ct. 2849. Because the *Zacchini* Court limited its holding to the particular facts of the case--the appropriation of plaintiff's "entire act"--it does not control the case at hand. Nonetheless, there are larger lessons that are certainly applicable.

First, the Court acknowledged, as had many lower courts previously, that the right of publicity is not always trumped by the right of free speech. Explaining the competing right of publicity interests, the Court observed that "[t]he rationale for protecting the right of publicity is the straightforward one of preventing unjust enrichment by the theft of goodwill. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay." *Id.* at 576, 97 S.Ct. 2849.

Second, the Court distinguished claims for right of publicity or name appropriateness from claims for defamation like those adjudicated in *New York Times v. Sullivan,* 376 U.S. 254, 84 S.Ct. 710, 11 L.Ed.2d 686

(1964), and *Hustler Magazine v. Falwell,* 485 U.S. 46, 108 S.Ct. 876, 99 L.Ed.2d 41 (1988), and claims for "publicity that places plaintiff in a 'false light' "like that adjudicated in *Time, Inc. v. Hill,* 385 U.S. 374, 87 S.Ct. 534, 17 L.Ed.2d 456 (1967). Because property interests are involved in the former categories but not the latter, *Zacchini,* 433 U.S. at 573, 97 S.Ct. 2849, the Court refused to apply the *New York Times v. Sullivan* "actual malice" standard that speech is privileged unless it was "knowingly false or was published with reckless disregard for the truth." *Id.* at 571, 97 S.Ct. 2849, *et seq.* As the Court later made clear in *Hustler, Zacchini* stands for the proposition that "the 'actual malice' standard does not apply to the tort of appropriation of a right of publicity... ." 485 U.S. at 52, 108 S.Ct. 876.

Right to publicity cases, both before and after *Zacchini,* focus instead on the threshold legal question of whether the use of a person's name and identity is "expressive," in which case it is fully protected, or "commercial," in which case it is generally not protected. For instance, the use of a person's identity in news, entertainment, and creative works for the purpose of communicating information or expressive ideas about that person is protected "expressive" speech. *See, e.g., Hoffman v. Capital Cities/ABC, Inc.,* 255 F.3d 1180, 1185 (9th Cir.2001); *Cardtoons v. Major League Baseball Players Ass'n,* 95 F.3d 959, 969-70 (10th Cir.1996); *Rogers v. Grimaldi, MGM/UA,* 875 F.2d 994, 1003-05 (2nd Cir.1989). On the other hand, the use of a person's identity for purely commercial purposes, like advertising goods or services or the use of a person's name or likeness on merchandise, is rarely protected. *See, e.g., Downing v. Abercrombie & Fitch,* 265 F.3d 994, 1002 (9th Cir.2001); *White v. Samsung Elec. Am., Inc.,* 971 F.2d 1395, 1397-99 (9th Cir.1992); *Midler v. Ford Motor* Co., 849 F.2d 460,462-64 (9th Cir.1988).

Several approaches have been offered to distinguish between expressive speech and commercial speech. The RESTATEMENT, for example, employs a "relatedness" test that protects the use of another person's name or identity in a work that is "related to" that person. The catalogue of "related" uses includes "the use of a person's name or likeness in news reporting, whether in newspapers, magazines, or broadcast news... use in entertainment and other creative works, including both fiction and nonfiction... use as part of an article published in a fan magazine or in a feature story broadcast on an entertainment program... dissemination of an unauthorized print or broadcast biography, [and use] of another's identity in a novel, play, or motion picture... ." RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 47 cmt. c at 549. The proviso to that list, however, is that "if the name or likeness is used solely to attract attention to a work that is *not related* to the identified person, the user may be subject to liability for a use of the other's identity in advertising... ." *Id.* (Emphasis added.)

California courts use a different approach, called the "transformative test," that was most recently invoked in *Winter v. D.C. Comics,* 30 Cal.4th 881, 134 Cal.Rptr.2d 634, 69 P.3d 473 (2003), a case with a remarkably similar fact situation. In that case, Johnny and Edgar Winters, well-known musicians with albino complexions and long white hair, brought a right of publicity action against defendant D.C. Comics for its publication of a comic book featuring the characters "Johnny and Edgar Autumn," half-worm, half-human creatures with pale faces and long white hair. On appeal, the California Supreme Court considered whether the action was barred by the First Amendment and employed " 'what is essentially a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements

so as to be transformed into something more than a mere celebrity likeness or imitation.'" *Id.* at 475 (citing *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797, 799 (2001)). Concluding that the comic book characters "Johnny and Edgar Autumn" "are not just conventional depictions of plaintiffs but contain significant expressive content other than plaintiffs' mere likenesses," *id.* at 479, the Court held that the characters were sufficiently transformed so as to entitle the comic book to full First Amendment protection.

The weakness of the RESTATEMENT'S "relatedness" test and California's "transformative" test is that they give too little consideration to the fact that many uses of a person's name and identity have both expressive and commercial components. These tests operate to preclude a cause of action whenever the use of the name and identity is in any way expressive, regardless of its commercial exploitation. Under the relatedness test, use of a person's name and identity is actionable only when the use is solely commercial and is otherwise unrelated to that person. Under the transformative test, the transformation or fictionalized characterization of a person's celebrity status is not actionable even if its sole purpose is the commercial use of that person's name and identity. Though these tests purport to balance the prospective interests involved, there is no balancing at all--once the use is determined to be expressive, it is protected. At least one commentator, however, has advocated the use of a more balanced balancing test--a sort of predominant use test--that better addresses the cases where speech is both expressive and commercial:

> If a product is being sold that predominantly exploits the commercial value of an individual's iden-

> tity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some "expressive" content in it that might qualify as "speech" in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.

Lee, *supra,* at 500.

The relative merit of these several tests can be seen when applied to the unusual circumstances of the case at hand. As discussed, Twist made a submissible case that respondents' use of his name and identity was for a commercial advantage. Nonetheless, there is still an expressive component in the use of his name and identity as a metaphorical reference to tough-guy "enforcers." And yet, respondents agree (perhaps to avoid a defamation claim) that the use was not a parody or other expressive comment or a fictionalized account of the real Twist. As such, the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value. On the record here, the use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.

IV.

The circuit court held that in the event that its grant of JNOV was determined to be in error on appeal, as previously held, respondents' alternative motion for a new trial was granted on several grounds. One such dispositive ground is instructional error in the verdict director given for the misappropriation of name count.

The verdict director for this claim, which was the same for each defendant, read:

> Your verdict must be for plaintiff and against defendant Todd McFarlane if you believe:
>
> First, defendant Todd McFarlane intentionally used or published plaintiff's name, and
>
> Second, defendant Todd McFarlane derived advantage from the use or publication of plaintiffs name, or plaintiff suffered harm as a result of defendant Todd McFarlane's use of publication of plaintiffs name, and
>
> Third, plaintiff did not consent to the use of publication, and
>
> Fourth, as a direct result thereof, plaintiff sustained damage.

In deciding whether the given verdict director was erroneous, it is helpful to again list the elements of the tort of right of publicity: (1) The defendant used plaintiff's name as a symbol of his identity (2) without consent (3) and with the intent to obtain a commercial advantage. Notably, the verdict director omitted any requirement that the jury find that defendant used plaintiff's identity rather than merely his name. This omission, however, did not prejudice respondents, as the evidence at trial so clearly established that appellant Tony Twist was the basis for the *Spawn* character's name.

However, a second and ultimately fatal flaw lies in the verdict director's failure to properly instruct the jury on the commercial advantage element of the tort. By requiring that the jury find only that respondents "derived advantage from the use or publication of plaintiffs name," as opposed to a finding that respondents used plaintiff's name "with the intent to derive" or "for

the purpose of deriving" an advantage, the jury was allowed to render a verdict that could have been based on the mere incidental result of the use rather than the intentional result. Here, this seemingly fine distinction could well have borne different results. Although the evidence supported a finding that respondents used Twist's name and identity "with the intent to obtain a commercial advantage," alternatively, the jury could have found that respondents had no intent to obtain a commercial advantage--that there was a different purpose for using the name--and to the extent that some advantage was obtained, it was merely incidental. In fact, respondent McFarlane so testified in his defense, adding that the real reasons he used Twist's name were

> one, it's a pretty cool name, and, two, it's easy to remember, it's an easy thing--cause I create a lot of characters, you need sort of easy ways to remember names... . And again, ...[with] Twist, you always sort of have a Twist ending. You just sort of come up with stuff that sort of, you know, semi- clever, if you will.

Because the verdict director allowed the jury to render a verdict for plaintiff without a finding that respondents *intended* to obtain a commercial advantage, and because the jury may well have determined that respondents obtained a commercial advantage even though they did not intend to do so, the verdict must be set aside.

V.

In addition to the misappropriation of name claim, Twist sought equitable relief from the circuit court in the form of a permanent injunction prohibiting respondents from using his "name, commercial image, persona, autograph and/or likeness *for any purpose* with-

out his consent." (Emphasis added.) The court denied equitable relief concluding, *inter alia,* that the injunction sought was overbroad because it could "interfere with legitimate and proper action by the defendants in the future." This Court holds that the circuit court was correct in doing so, because, as respondents state in their brief, the requested injunction attempted to prohibit respondents "from engaging in a variety of expressive activities unrelated to the subject matter of this lawsuit and undoubtedly protected by the First Amendment--*e.g.,* a parody of plaintiff, a commentary on his fighting style, a factual report on this lawsuit."

VI.

For the foregoing reasons, the circuit court's judgment notwithstanding the verdict is reversed, the judgment granting a new trial is affirmed, the judgment denying injunctive relief is affirmed, and the case is remanded.

s/_____
Stephen N. Limbaugh, Jr., Judge

All concur.

Appendix B

In the Missouri Court of Appeals
Eastern District
Division Five

JOHN DOE, a.k.a. TONY TWIST,
Appellant,

V.

TCI CABLEVISION, ET. AL.
Respondent.

No. ED78785

Appeal from the Circuit Court of the City of St. Louis

Hon. Robert H. Dierker

FILED: July 23, 2002

The plaintiff, Anthony R. Twist, also known as Tony Twist, is a retired professional hockey player. He complains that the defendants[1] misappropriated his name by using it for a comic book villain without his consent and identifying him as the source of the name for the character. He also complains that the defendants "cross-marketed" action figure toys derived from other comic book characters by packaging the comic books with the toys and holding a promotional "*Spawn* Night" at a

[1] The remaining defendants, Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc. Todd McFarlane Entertainment, Inc. and Image Comics will be referred to throughout this opinion as the McFarlane defendants.

minor league hockey game. Twist brought suit, seeking damages for the past use of his name and an injunction barring further use. From their first responsive pleading the McFarlane defendants claimed the protection of the First Amendment of the United States Constitution. The trial court, applying the First Amendment of the United States Constitution. The trial court, applying the First Amendment, dismissed the defamation count, but found the First Amendment not applicable to the misappropriation of name claim and submitted that claim to the jury. The jury returned a verdict for the plaintiff in the amount of $24,500,000. The trial court then granted the defendants' motion for judgment notwithstanding the verdict, finding that the plaintiff failed to present evidence that defendants possessed a specific intent to use Twist's name for their benefit or to his detriment. In the alternative, the trial court granted defendants' motion for a new trial because of numerous instructional and evidentiary errors. The request for injunctive relief was denied. We find the First Amendment defense applicable to the misappropriation claim. Accordingly, that claim is not submissible because it does not comply with the "of and concerning" requirement of the First Amendment. We affirm.

FACTS

During his playing years, Tony Twist was regarded as one of the most violent "enforcers" in hockey and attained a national reputation for violence on the ice hockey rink.[2] Like many professional athletes, he hoped to exploit his sports star status to become a broadcaster

[2] The role of an "enforcer" in hockey is to protect goal scorers from physical assaults by opponents. Describing Twist, a *Sports Illustrated* article said: "It takes a special talent to stand on skates and

Continued on Next Page

and a celebrity promoter of products. To this end, he received coaching, appeared on television and radio programs and for two years hosted "The Tony Twist Show" on a local television station. He also presented evidence that he had a good reputation off the ice for his work with children's charities.

Todd McFarlane is a comic book writer. In 1992, McFarlane, with others, formed Image Comics, Inc. to solicit, market, print and distribute comics. He also created his own comic book, *Spawn,* and formed Todd McFarlane Productions, Inc., to oversee the writers, artists and creative staff involved in its production.

Spawn is a dark and surreal fantasy revolving around a character named Al Simmons, a CIA assassin murdered by his corrupt partners at the CIA. Simmons' soul goes to Hell, makes a deal with the Devil and returns to earth as "Spawn," a creature with superhuman powers. Spawn struggles to break his pact with the devil, but is placed under the influence of a guardian demon who uses Spawn's weaknesses to get him to do the Devil's bidding.

Spawn became a successful comic book from its first issue. McFarlane parlayed this success into comic book spin-offs: an animated series, a feature-length movie, a line of toys based on *Spawn* characters, a line of clothes bearing the *Spawn* logo and various other items.

Footnote 2 Continued

beat someone senseless, and no one does it better than the St. Louis Blues left winger." The article goes on to quote Twist to say "I want to hurt them. I want to end the fight as soon as possible and I want the guy to remember it." Austin Murphy, *Fighting For A Living: St. Louis Blues Enforcer Tony Twist, Whose Pugilistic Talents Appear To Run In The Family, Doesn't Pull Any Punches On The Job*, SPORTS ILLUSTRATED, Mar. 16, 1998, at 42, available at 1998 WL 8979450.

In November of 1993, McFarlane unveiled a fictional Mafioso character named "Tony Twist" who, as the monthly episodes develop, becomes an antagonist of the Spawn character. This fictional Tony Twist commits and orders murders, child abductions and a variety of other illegal and immoral deeds. Besides bearing the same name as the plaintiff, the only resemblance the plaintiff claims between the fictional Tony Twist and himself is metaphorical in that both are "enforcers," one in the world of professional hockey and the other in the fictional world of *Spawn.* [3]

In September and November of 1994, responding to fan letters in the back of the comic book, McFarlane identified the plaintiff as the source of the name for the fictional mafia character. The September letter, in relevant part, says:

> The great thing about writing and drawing your own book is you get to have as much fun with it as you want. ...Whenever I choose a name I try to have a little bit of play on it... I am a big hockey fan, and a lot of my characters have been named after current NHL hockey players. For example, Antonio Twistelli, a/k/a Tony Twist, is actually the name of a hockey player of the Quebec Nordiques.

In April 1996, *Wizard,* a trade magazine for the comic book industry, highlighted McFarlane's method of naming characters and published an article titled: *"Spawning Ground: A Look At The Real Life People Spawn Characters Are Based Upon."*[4] In that article the author says:

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[3]The Twist character appears 166 times in 31,000 panels, approximately one-half of one percent of the total panels.

[4]*Wizard* settled with the plaintiff prior to verdict and is not a party to this appeal.

Having trouble coming up with character names? Use the Todd McFarlane Method.

McFarlane uses the names of his family and friends when it comes to the character identities inside his comic book *Spawn*.

"It's easier to come up with the names of people sitting next to you," the writer/artist explains. "And for the most part, if I don't put my friends and family in my books, I guarantee that nobody at Marvel is going to do it for me. I do it just because I can. I've got that freedom. It's one of the great things about controlling your own book."

Named for loved ones, friends, colleagues and employees at Todd McFarlane Productions, a few of the characters appearing in *Spawn* feature similarities to their real-life counterparts. Many others appropriate only the name, sometimes being introduced and dispatched in the same issue.

This is followed by brief biographies and drawings of the characters, along with photos of the real persons they are named after. The section devoted to the Tony Twist character shows a picture of the fictional comic book character and a photo of a Tony Twist hockey trading card. It is captioned "ANTHONY 'TONY TWIST' TWISTELLI," and states:

First Appearance: *Spawn #6*

Real-Life Persona: Tony Twist.

Relation: NHL St. Louis Blues right winger.

The Mafia don that has made life exceedingly rough for Al Simmons and his loved ones, in addition to putting out an ill-advised contract on the Violator, is named for former Quebec Nordiques hockey player Tony Twist, now a renowned en-

forcer (i.e. "Goon") for the St. Louis Blues of the National Hockey League."

On October 31, 1997, Twist filed suit against the McFarlane defendants and many others[5] seeking damages and an injunction for, among other things, defamation and misappropriation of name. The McFarlane defendants filed their answer containing a number of denials and defenses, among them their fourth affirmative defense, which reads: none of the contents, characters, story lines or descriptions contained in the Spawn comic books... is identifiable with plaintiff or purport to be *"of and concerning"* the plaintiff but are purely fictional fantasies and no reasonable person could confuse the Plaintiff with the fictional fantasies and characters portrayed therein. (emphasis ours)

This fourth affirmative defense, carried forward into the McFarlane defendants' motion to dismiss resulted in the trial court's dismissal of the defamation claim because no "person of ordinary intelligence would understand Defendants' publication to convey factual assertions 'of and concerning' Plaintiff." But the court, without reference to the "of and concerning" require-

[5]Plaintiff's second amended petition listed the following defendants: TCI Cablevision of Missouri, Inc., Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc. (d/b/a/ McFarlane Toys, TMP Apparel, Todd Toys, TMP Entertainment, TMP Cards, TMP Toys, McFarlane Design Group, McFarlane Entertainment, TMP Ventures, and McFarlane Toys Collector's Club), Image Comics, Inc., Gareb Shamus Enterprises, Inc. (d/b/a/ Wizard Press, Inc.), Titan Books & Comics, Inc., Grupo Editorial, Inc., Time Warner Entertainment Company, L.P., Home Box Office, Inc., Blockbuster Entertainment, Inc., Hollywood Entertainment Corp. (d/b/a/ Hollywood Video), Video Update, Inc., Diamond Comic Distributors, Inc., Legends, Comics & Cards, Inc., and any and all unknown persons, corporations, limited liability companies, partnerships, or other entities of any other named defendant.

ment of the First Amendment, denied the motion to dismiss the misappropriation action, finding only that "Plaintiff's petition explicitly pleads the elements of a wrongful appropriation claim."[6]

McFarlane and related entities then filed their motions for summary judgment, arguing, among other things, that the First Amendment protected them from Twist's claim for misappropriation of name. Twist's response to the motion did not dispute that *Spawn* is a work of fiction and that he is a public figure. The trial court nevertheless denied the motions, finding that the First Amendment did not protect McFarlane from a misappropriation of name action. In its order denying the defendants' motion for summary judgment, the court declared what evidence was necessary to make the case and that the First Amendment was not a bar. That order reads:

> If Plaintiff can demonstrate, as a matter of fact, both that Defendants knowingly utilized his name and likeness for the purpose of advancing their economic interests, and also that in fact Defendants derived economic benefit (in the form of increased sales of their products) from that use, or in fact caused Plaintiff direct pecuniary loss (by damaging his ability to market his name or image), then Defendants may be liable notwithstanding the First Amendment.

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[6]The trial court dismissed Twist's claims against the following defendants because they were mere "passive distributors" of the comic books and related items: TCI Cablevision of Missouri, Inc., Titan Books & Comics, Inc., Grupo Editorial, Inc., Home Box Office, Inc., Blockbuster Entertainment, Inc., Hollywood Entertainment Corp., Video Update, Inc., Legends, Comics & Cards, Inc.,

At trial there was no dispute that McFarlane used Twist's name. The evidence viewed in a light most favorable to the verdict establishes that the plaintiff did serve as an inspiration for the comic book character. McFarlane denies, however, that the comic book character "appropriates the identity" of or makes statements that a reasonable reader would conclude are "about" Twist, the hockey player. He also denies any benefit came to him from the use of Twist's name.

To prove that the association with the Tony Twist character diminished his value as an endorser of products, Twist emphasized the violent and sexual nature of the comic book character. Twist also offered testimony from a former executive of a sports nutrition company that in 1999 he was going to offer Twist a $100,000 contract to endorse sports nutrition products, but changed his mind after he learned of Twist's association with the comic book.

To prove that the McFarlane defendants benefited, Twist called two experts who gave their opinion as to the fair market value of the Twist name. Brian Till opined that the fair market value of the use of Twist's name in the comics was equal to 15% of the combined gross revenues of all *Spawn*-related products in which the Twist character appears, plus 9% of the gross revenues of all other *Spawn*-related products. Rocky Arcenaux opined that the use of Twist's name was worth 20% of the combined gross revenues of all *Spawn*-related products, 15% for the use of the name plus an additional 5% because of the expected negative impact on Twist's future endorsements caused by his association with *Spawn*. Finally, Twist offered testimony from financial expert Jay Barrington that the gross revenues from *Spawn*-related sales for all defendants combined was $122,708,261.

The case went to the jury on the misappropriation of name count. The instruction submitting that count required the jury to find only that the defendants intentionally used or published Twist's name, without his consent, and that either the defendants benefited or Twist was damaged by that use. The verdict director read:

> Your verdict must be for plaintiff and against defendant Todd McFarlane if you believe:
>
> First, defendant Todd McFarlane intentionally used or published plaintiff's name, and
>
> Second, defendant Todd McFarlane derived advantage from the use or publication of plaintiff's name, or plaintiff suffered harm as a result of defendant Todd McFarlane's use of publication of plaintiff's name, and
>
> Third, plaintiff did not consent to the use of publication, and
>
> Fourth, as a direct result thereof, plaintiff sustained damage.[7]

The jury returned a verdict for Twist and jointly against all remaining defendants in the amount of $24,500,000, slightly under 20% of the defendants' combined gross revenues from the time *Spawn* was first published.

The defendants then moved for judgment notwithstanding the verdict or in the alternative for a new trial. In its order sustaining that motion the trial court found it had improperly submitted the misappropriation of name count to the jury. In particular, it found error in its failure to require the jury to find that the defendants possessed a "specific intent" to injure Twist or benefit

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[7]The verdict directors were the same for every defendant; only the name of the defendant changed.

themselves from the use of his name. Accordingly, the court granted the motion for judgment notwithstanding the verdict, ruling that Twist failed to make a submissible case on his claim for misappropriation of name because there was no "substantial evidence of a specific intent by defendants to use his name for their benefit or to [Twist's] detriment." The trial court further ruled in the alternative that if the judgment notwithstanding the verdict is reversed on appeal, the motion for new trial would be granted because of instructional errors and the erroneous admission of Twist's expert testimony. Finally, the request for injunctive relief was denied.

Twist raises three points on appeal. First, he argues that the trial court erred by changing the elements of the misappropriation of name claim after trial to include a requirement of specific intent to harm or benefit. Twist maintains that there is no such requirement for a misappropriation of name and, alternatively, if there is such a requirement, that he presented substantial evidence of the McFarlane defendants' intent to benefit from the use of his name. Second, he claims that the testimony submitted through his experts was admissible and that the verdict director and damage instruction properly submitted the elements of Twist's damages.[8] Finally, Twist argues that, absent his consent, the further use of his name by the defendants should be enjoined.

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[8]Instruction No. 16, the damage instruction, submitted to the jury read as follows: "If you find in favor of plaintiff, then you must award plaintiff such sum as you believe will fairly and justly compensate plaintiff for any damages you believe he sustained and is reasonably certain to sustain in the future as a direct result of the defendants' use or publication of his name."

STANDARD OF REVIEW

When reviewing the grant of a motion for judgment notwithstanding the verdict we must determine if the plaintiff made a submissible case. *Jungerman v. City of Raytown,* 925 S.W.2d 202, 204 (Mo. banc 1996). We must affirm a trial court's ruling, though the reason given for it may be erroneous, if it is sustainable for any reason. *Graue v. Missouri Property Ins. Placement Facility,* 847 S.W.2d 779, 782 (Mo. banc 1993).

Generally, we view the evidence in a light most favorable to the plaintiff, giving him the benefit of all reasonable inferences and disregarding all unfavorable evidence and inferences. *Id.* However, cases raising First Amendment issues reqüire an independent examination of the whole record to insure that the judgment does not constitute a forbidden intrusion upon the field of free expression. *Bose Corp. v. Consumers Union of United States, Inc.,* 466 U.S. 485, 499-501 (1984). A properly preserved First Amendment defense "raising questions of constitutional fact compel[s] this court's *de novo* review." *Id.* In that pursuit, we strictly scrutinize state imposed content-based restrictions on speech to insure that they promote a compelling government interest and are narrowly tailored to further that interest. *Sable Communications of Cal., Inc. v. FCC,* 492 U.S. 115,126 (1989).

TWIST'S CAUSE OF ACTION

The law has protected a person's interest in his good name for more than a thousand years L. ELDRIDGE, THE LAW OF DEFAMATION § 53, at 293-294 (1978). A cause of action for defamation, whether by libel or slander, serves to insulate the individual from false and unwarranted statements harmful to that person's reputation. RESTATEMENT (SECOND) TORTS §§ 580A, 580B (1977).

Over the last century the law has expanded the protection a person's name and identity is entitled to receive against unauthorized commercial exploitation.

In 1946 Congress passed the Lanham Act, providing a federal cause of action and remedy for the unauthorized use of a person's identity that "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities. ..." 15 U.S.C. § 1125(a)(1)(A) (2002).

Law review articles creating the foundation for the misappropriation of name and right of publicity torts date as far back as 1890.[9] But the first case to formally distinguish these claims from those that protect the right of privacy was written in 1953. *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), cert. denied 346 U.S. 816 (1953). That case and its antecedents make clear that the torts of "misappropriation of name" and "right of publicity" protect persons against the unauthorized commercial use of their identity.

The elements of these torts are essentially the same. *See* RESTATEMENT (SECOND) TORTS § 652C (describing the misappropriation tort); RESTATEMENT (THIRD) UNFAIR COMPETITION § 46 (1995)(describing the right of publicity). Both require the use of the plaintiff's identity for some commercial purpose without the plaintiff's consent. They differ only in their justifications and the type of damages awarded. *See* MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 5:61 (2d ed. 2000). In a misappropriation of name case the damages are based on the

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[9]*See* Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 196 (1890).

mental distress caused by an invasion of personal privacy. *Id.* In a right of publicity case, damages are measured by the fair market value the advertiser would have had to pay to use that person's identity in a commercial and any dilution of the commercial value of the identity caused by excessive or harmful uses. *See* RESTATEMENT (THIRD) UNFAIR COMPETITION § 49 cmt. d.

Twist brings his case under the banner of "misappropriation of name," but we find his tort more properly labeled a "right of publicity" claim because he seeks to recover the damage to his endorsement value and a proportionate share of the revenue generated by the use of his identity. His theory throughout the trial was that he has exclusive control over the use of his name. Twist cites three Missouri cases for the proposition that taking a person's identity for a purely commercial purpose is prohibited by Missouri law. In *Munden v. Harris*, 134 S.W. 1076 (Mo. App. 1911), a jeweler published an advertisement containing the picture of a five-year-old next to a caption that invites the reader to buy jewelry. *Id.* at 1077. The child's parents sued the advertiser for invasion of privacy for publishing his picture in an advertisement without his consent. *Id.* The Court of Appeals held that "one has an exclusive right to his picture, on the score of its being a property right of material profit." *Id.* at 1079. The court then allowed the plaintiff to go forward to show both damages to his reputation and feelings, as well as for any value that the defendant derived from the unauthorized use of the child's identity in advertising its goods. *Id.* at 1079, 1081.

Twist also cites *Haith v. Model Cities Health Corp. of Kansas City,* 704 S.W.2d 684 (Mo.App. W.D. 1986) and *Nemani v. St. Louis University,* 33 S.W.3d 184 (Mo. banc 2000). In both of these cases medical research

facilities were accused of using the plaintiffs' names without consent on applications for federal grants. 704 S.W.2d at 687; 33 S.W.3d at 185. In *Haith,* the Western District concluded that proof of these allegations was sufficient to submit the case to a jury because the plaintiff's name was taken in pursuit of an economic benefit for the defendant without plaintiff's permission. 704 S.W.2d at 687-88. *Nemani* embraces the same general principles, but the Missouri Supreme Court resolved the case on the facts, concluding that the plaintiff consented to the use of his name. 33 S.W.3d at 186.

Contrary to Twist's argument, *Munden, Haith,* and *Nemani* do not stand for the proposition that a public figure possesses an exclusive right to control the use of their name. *Munden* involved only the use of the plaintiff's picture, not his name. *Munden,* 134 SW. at 1077. *Haith* and *Nemani* involve the use of the plaintiffs' names, but both cases make clear that liability cannot rest on *mere* use of a person's name. In *Haith,* the court said: "it is the plaintiff's name as a symbol of... identity that is involved here, and not... as a mere name." 704 S.W.2d at 687. The *Nemani* court held similarly, saying: "Name appropriation occurs where a defendant makes use of the name *to pirate the plaintiff's identity* for some advantage." 33 S.W.3d at 185 (emphasis added)(internal quotation omitted). The plaintiff correctly identifies these cases as standing for the bare proposition that a publisher cannot use a person's identity to advance a purely commercial purpose.

Munden, Haith and *Nemani* are distinguishable from the present case, however, because they involve neither a public figure nor a work of fiction. Twist cites no case that allows a public figure, celebrity or sports figure to recover on a "misappropriation of name" or "right of

publicity" theory simply because a fiction writer names a character after them. Every court to address this issue has concluded that name-sameness alone does not give rise to a claim under either of these torts.[10] The same reasoning underlies the law's refusal to allow a person to copyright his name. *See* 17 U.S.C. § 102; *Downing v. Abercrombie & Fitch,* 265 F.3d 994, 1003-1004 (9th Cir. 2001).

Twist's theory is, however, more subtle. He argues that the use of his name for a fictional "enforcer," coupled with the identification of him as the inspiration for the character, effectively appropriated his identity. Cases in other jurisdictions make clear that even subtle appropriations of aspects of a celebrity's identity may be actionable if taken for a purely commercial purpose.

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[10] *See, e.g., Nebb v. Bell Syndicate*, 41 F. Supp 929 (DC NY 1941)(Privacy claim under New York statute dismissed where the only similarity between the plaintiffs and the defendant's syndicated comic strip characters "Mr. and Mrs. Rudy Nebb" was the name); *Costanza v. Seinfeld*, 279 A.D.2d 255 (NY App. 2001)(court properly dismissed misappropriation case brought by Costanza against comedian Jerry Seinfeld based upon use of same last name); *T. J. Hooker v. Columbia Pictures Indus.*, 551 F. Supp. 1060 (ND Ill. 1982)(no right of publicity or Lanham Act violation for coincidental use of the name of woodcarver T. J. Hooker as the name of a character and title of TV series "T. J. Hooker"); *DeClemente v. Columbia Pictures Indus., Inc.*, 860 F. Supp. 30 (E.D.N.Y. 1994)(plaintiff karate teacher known locally as the "Karate Kid" could not prove violation of right of publicity claim for use of the name of "Karate Kid" for a character and a title of movie); *Newton v. Thomason*, 22 F.3d 1455 (9th Cir. 1994)(affirming summary judgment where singer Wood Newton alleged that his name was appropriated for a character in the television show "Evening Shade"); *Allen v. Gordon*, 446 N.Y.S.2d 48 (N.Y. App. Div. 1982)(Dr. Allen could not prove misappropriation based on name-sameness of fictional psychiatrist because name-sameness is insufficient to prove the book was "of and concerning" the plaintiff).

In "commercial speech" the message is "buy." MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 8:17. The Supreme Court has defined commercial speech as "speech that *proposes* a commercial transaction." *Board of Trustees of the State Univ. of N.Y. v. Fox,* 492 U.S. 469, 482 (1989)(emphasis in original).

In *Carson v. Here's Johnny Portable Toilets, Inc.,* the defendant used only the expression "Here's Johnny" to market its toilets. 698 F.2d 831, 837 (6thCir. 1983). "Here's Johnny" was Carson's signature introduction at the beginning of his popular television show and was widely recognized as a reference to the plaintiff Johnny Carson. *Id.* at 832-33. Finding that Carson stated a claim upon which relief could be granted, the court held, "a celebrity's legal right of publicity is invaded whenever his identity is intentionally appropriated for a commercial purpose." *Id.* at 837. In *Midler v. Ford Motor Co.,* Ford Motor Company used a "sound alike" to record a popular Bette Midler song for a commercial. 849 F.2d 460, 461 (9th Cir. 1988). The Ninth Circuit held that "when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort . . .." *Id.* at 463. These cases teach that using identity markers to falsely suggest a relationship between a person and product may constitute a violation of the plaintiff's right of publicity.

Munden, Haith, and *Nemani* correctly illustrate the mechanics of a private citizen's cause of action for misappropriation of name. *Carson* and *Midler,* on the other hand, illustrate the protection the law affords celebrities seeking to protect their property interest in their identity. In all of these cases aspects of the plaintiffs' identities were used in an effort to bring

economic gain to the defendants without the consent or economic participation of the plaintiff.

Twist understandably seeks to bring his claim within this stream of cases. But the factual distinctions between Twist's case and these cases are glaring. In both the misappropriation of name and the right of publicity cases, the defendants used the plaintiffs' identities to aid a purely commercial transaction. *Haith* and *Nemani* were applications to win federal grants for their institutions. *Munden, Carson* and *Midler* were advertisements for jewelry, toilets and cars.

Here, the alleged use of Twist's identity appears in a comic book with significant republication of the stories in the television and video mediums. Twist does not contest that a plain reading of the comic book confirms it as a work of fiction. Because he seeks to restrict the ability of the McFarlane defendants to use his identity and name in a work of fiction, he implicates the First Amendment, requiring us to strictly scrutinize his efforts to control the product of the defendants' creative processes. We must, therefore, apply First Amendment principles to determine if *Spawn,* in any medium, is protected speech.

APPLICATION OF THE FIRST AMENDMENT TO THE RIGHT OF PUBLICITY AND MISAPPROPRIATION OF NAME TORTS

The First Amendment to the United States Constitution says: "Congress shall make no law... abridging the freedom of speech, or of the press..." While originally applicable only to the federal government, the Equal Protection Clause of the Fourteenth Amendment protects freedom of speech and the press against abridgement by state action. *Gitlow v. New York,* 268 U.S. 652, 666 (1925). A state violates Fourteenth Amendment

rights when it creates a rule of law authorizing a judgment against a person for exercising his First Amendment rights. *New York Times v. Sullivan,* 376 U.S. 254 (1964).

When a celebrity such as Twist invokes the courts to seek payment for certain speech he characterizes as "unauthorized" and to enjoin further speech, there is clearly "state action" triggering First Amendment scrutiny. Twist asks the state to compel payment for the alleged misappropriation of his identity and an injunction banning all speech using his identity in fiction, except on terms he alone dictates. This is a content-based restriction on speech.

Content-based restrictions limit speech based on the message conveyed. They offend the First Amendment on several grounds. First, content-based restrictions distort public debate by preventing messages from being expressed and heard, impeding the search for truth. *See Abrams v. United States,* 250 U.S. 616, 630 (1919) (Holmes, J., dissenting) (in the long run, the best test of truth is "the power of the thought to get itself accepted in the competition of the market"). Second, content-based restrictions obstruct meaningful participation in self-government. *See First National Bank of Boston v. Bellotti,* 435 U.S. 765, 791 (1978) (in a self-governing nation, the people, not the government, "are entrusted with the responsibility for judging and evaluating the relative merits of conflicting arguments"). Third, content-based restrictions frustrate individual self-fulfillment. *See Whitney v. California,* 274 U.S. 357, 375 (1927) (Brandeis, J., concurring) (in our constitutional system, the protection of free expression is designed to enhance personal growth, self-realization, and the development of individual autonomy). Content-based restrictions on speech are disfavored be-

cause they are in essence a manifestation of government's distrust of the individual's ability to decide for themselves the type of information or entertainment they wish to view or hear.

Content-based restrictions can, therefore, stand only if they pass strict scrutiny. *Sable Communications of Cal., Inc. v. FCC,* 492 U.S. 115, 126 (1989). In applying strict scrutiny to any state action that proposes to restrict the content of speech, we must determine if the state action protects a compelling government interest. If so, we then determine if the restriction is narrowly tailored to further that interest. *Id.*

The "compelling government interest" that Twist seeks to advance is the state's interest in protecting his property right in his persona and its endorsement value. Citing *Zacchini v. Scripps-Howard Broadcasting Co.,* 433 U.S. 562 (1977), Twist argues that the First Amendment does not apply to a property-based tort such as the right of publicity. In *Zacchini* a local television station aired a performer's 15-second "human cannonball" act on the evening news without his consent. *Id.* at 564. The Supreme Court held that the First Amendment did not protect the television station from Zacchini's right of publicity claim because the television station aired Zacchini's *"entire act." Id.* at 578-79. The *Zacchini* court said:

> the State's interest in permitting a "right of publicity" is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment. As we later note, the State's interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation.

Id. at 574-75 (citations omitted).

Twist would have us conclude from this that the First Amendment never applies to a right of publicity claim. But the Supreme Court drew a clear distinction between what was appropriated from Zacchini and what is taken in the usual "right of publicity" or "misappropriation of name" case, saying:

> the broadcast of petitioner's entire performance, *unlike the unauthorized use of another's name for purposes of trade or the incidental use of a name or picture by the press,* goes to the heart of petitioner's ability to earn a living as an entertainer.

Id. at 576 (emphasis added). The *Zacchini* Court was not concerned with the use of another's name or identity, but "the appropriation of the very activity by which the entertainer acquired his reputation in the first place." *Id.* The Tenth Circuit has more accurately, we think, described *Zacchini* as a "red herring," reading it not as a right of publicity case at all, but rather a "right of performance" case. *Cardtoons, L.C. v. Major League Baseball Players Association,* 95 F. 3d 959, 973 (10th Cir. 1996). We believe, like the Tenth Circuit, that *Zacchini* was written with the express purpose of allowing a performer to derive a benefit from his own performance without interference from the First Amendment. *Id.*

Subsequent Supreme Court treatment of *Zacchini* confirms the very specific nature of its holding. *See San Francisco Arts & Athletics, Inc. v. United States Olympic Committee,* 483 U.S 522, 532-33 (1987)(reading *Zacchini* to provide protection only when the very expression being complained of is the product of the plaintiff's "own talents and energy, the end result of much time, effort, and expense"); *Harper & Row, Pub-*

lishers, Inc. v. Nation Enterprises, 471 U.S. 539, 556-57 (1985)(interpreting *Zacchini as* a protection of copyright and citing it for the proposition that "copyright assures those who write and publish factual narratives... may at least enjoy the right to market *the original expression* contained therein as just compensation for their investment." (emphasis added)); *Cohen v. Cowles Media Co.,* 501 U.S. 663, 669 (1991)(citing *Zacchini* for the proposition that "[t]he press, like others interested in publishing, may not publish copyrighted material without obeying the copyright laws.").

Zacchini does not carve out a wholesale exception to the First Amendment for right of publicity or misappropriation of name claims. It simply stands as an affirmative protection designed to vindicate the right of a performer to derive a benefit from his own performance. *See* MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 8:27. Because we disagree with Twist's reading of *Zacchini,* we conclude that the First Amendment must be applied to his claim that *Spawn,* an undisputed work of fiction, violates his right of publicity.

THE FIRST AMENDMENT AND WORKS OF FICTION

Twist insists that *Spawn* is a product and nothing more and, as such, is not entitled to First Amendment protection. Twist does not allege that his performance was taken, but that his name was misappropriated in pursuit of commercial gain. We must therefore determine if a public figure's property interest in his identity as represented by his name can survive a First Amendment defense raised by a publisher who names a character in a work of fiction after that public figure. To make such a determination we must balance the competing interests. *Konigsberg v. State Bar of California,* 366 U.S. 36, 49-51 (1961). When balancing a state's

interest in protecting reputation and property against the First Amendment the scales are heavily weighted in favor of freedom of speech. This is because, as Justice Cardozo has said, the First Amendment represents "a different plane of social and moral values" without which "neither liberty nor justice would exist...." *Palko v. Connecticut,* 302 U.S. 319, 326-27 (1937) (finding that freedom of thought and speech are "the matrix, the indispensable condition, of nearly every other form of freedom.").

Speech need not be "political" to be protected by the First Amendment. *United Mine Workers v. Illinois Slate Bar Ass'n*, 389 U.S. 217, 223 (1967). "The First Amendment was fashioned to assure unfettered interchange of ideas for the bringing about of political *and social changes* desired by the people." *Connick v. Myers,* 461 U.S. 138, 145 (1983) (emphasis added). In the words of Justice Thurgood Marshall:

> The First Amendment serves not only the needs of the polity but also those of the human spirit - a spirit that demands self-expression. Such expression is an integral part of the development of ideas and a sense of human identity. To suppress expression is to reject the basic human desire for recognition and affront the individual's worth and dignity.

Procunier v. Martinez, 416 U.S. 396, 427 (1974).

In defense of this free, open and creative self-expression, the First Amendment protects speech in any medium that either informs or entertains. *Winters v. New York,* 333 U.S. 507, 510 (1948). This includes books, motion pictures, radio, television programs, live entertainment, poetry, painting, music, dramatic works, comics and commercials. *See National Endowment for the Arts v. Finley* 524 U.S. 569, 602 (1998); *Hustler*

Magazine v. Falwell, 485 U.S. 46 (1988); *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N. Y.*, 447 U.S. 557 (1980). Even obscenity is protected if it has "serious literary, artistic, political, or scientific value." *Miller v. California*, 413 U.S. 15, 26 (1973).

People have been describing, defining and commenting on the world around them through two-dimensional art since the beginning of human civilization. Comic books are a recent extension of this form of self-expression. Often controversial, they have been described as "the mass-market, pulp-paper bad boys of publishing." John M. McGuire, *Laughing Matters?*, ST. LOUIS POST-DISPATCH at 1E, January 18, 1990. First appearing in 1911, by the end of the 1930's comic books were a popular form of entertainment.[11] But with their popularity, came virulent criticism. *Id.* Described as violent, "injected with sex," and even an avenue of communistic ideas, by the late 1940's they were being banned all across America and even publicly burned. TIME MAGAZINE, Dec. 20,1948; Bill Smith, *Comic book code dying a slow death*, ST. LOUIS POST-DISPATCH , July 16, 1993.

In the 1955 Senate Subcommittee Report, *Comic Books and Juvenile Delinquency*, the crime and horror comic books of the era were described as "short courses in murder, mayhem, robbery, rape, cannibalism, carnage, necrophilia, sex, sadism, masochism, and virtually every other form of crime, degeneracy, bestiality, and horror." *Comic Books and Juvenile Delinquency, Interim Report of the Committee on the Judiciary*, 84th Congress, 1st Session, S. Rep. No. 62 at 9 (1955). Despite this, the Subcommittee rejected any resort to governmental censorship as "totally out of keeping with

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[11] Kevin W. Saunders, *Media Self-Regulation of Depictions of Violence: A Last Opportunity*, 47 OKLA. L. Rev. 445, 448 (1994).

our basic American concepts of a free press operating in a free land for a free people." *Id.* at 23.

Comic books continue to be a legitimate and important part of the American artistic and literary landscape. Their combination of pictures and words often help young readers to learn. Their characters and imagery form a powerful subtext to American culture and imagination and for that reason are the bases of many Hollywood movies. Though often criticized as "low brow" or "literature for the illiterate," nothing prevents this art form from rising to the most sublime levels, as in Art Spiegelman's *Maus*, a stunning comic book version of the Holocaust, which won the Pulitzer Prize in 1992.

We therefore conclude that the comic book is an important expressive medium entitled to the full protections of the First Amendment.

Another, and even less likely, medium of expression that has also found First Amendment protection is the parody baseball card. In *Cardtoons* the Tenth Circuit held that they too are protected because they entertain and provide social commentary on the wealth of professional athletes, an issue of contemporary interest. 95 F.3d at 962 & 976.

We are informed by the *Cardtoons* court's balancing of the interests that protect both the right of publicity and the First Amendment. Identifying several justifications for protecting a celebrity's proprietary interest in their identity that court observed:

> The right is thought to further economic goals such as stimulating athletic and artistic achievement, promoting the efficient allocation of resources, and protecting consumers. In addition, the right of publicity is said to protect various noneconomic

> interests, such as safeguarding natural rights, securing the fruits of celebrity labors, preventing unjust enrichment, and averting emotional harm.

Id. at 973. The *Cardtoons* court did not find these interests compelling, however, when balanced against First Amendment principles. The court rejected the argument that the right of publicity provides athletes an incentive to perform because, unlike a performer such as Zacchini, the commercial value of a sports star's identity is a by-product of their performance, not their performance itself. *Id.* The court also rejected the unjust enrichment argument, concluding that it has little application when the use of the celebrity's identity is not in an advertisement. *Id.* at 975.

An interesting distinction between *Cardtoons* and the present case is that in the former the subject of parody was fully developed by the parties. Here, McFarlane does not claim in his testimony or argument that the Twist character in *Spawn* is a parody or any other kind of literary comment on Twist or violence in sports.[12] Nor does Twist claim the character is a parody of himself. Still, the cases are similar in that they involve the use of sports stars' names, and the products invoke or "call up" the identities of those stars in the minds of those who purchase them. Insofar as readers might view the use of Twist's name for the Mafia "enforcer" as a comment on Twist, the cases are on a par.

The ability to use Twist's name for a Mafioso character in *Spawn*, like the ability to make parody baseball cards, is important in a society such as ours, where so

[12] McFarlane does, however, attribute a motive to Twist for avoiding the issue of parody, claiming that he does so to avoid the holdings in *Falwell v. Hustler* and *N.Y. Times v. Sullivan,* discussed infra.

much of social life and discourse revolves around celebrities. One commentator has described celebrities as "common points of reference for millions of individuals who may never interact with one another, but who share, by virtue of their participation in a mediated culture, a common experience and a collective memory."[13] Another says that celebrities are "the chief agents of moral change in the United States."[14] The California Supreme Court, expounding on this in their recent decision in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, emphasized that the importance of being able to speak freely about and creatively use celebrities' identities:

> Entertainment and sports celebrities are the leading players in our Public Drama. We tell tales, both tall and cautionary, about them. We monitor their comings and goings, their missteps and heartbreaks. We copy their mannerisms, their styles and their modes of conversation and consumption. Whether or not celebrities are 'the chief agents of moral change in the United States' they certainly are widely used -- far more than are institutionally anchored elites -- to symbolize individual aspirations, group identities, and cultural values. Their images are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation.

21 P.3d 797, 803 (Cal. 2001).

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[13] JOHN B. THOMPSON, IDEOLOGY AND MODERN CULTURE: CRITICAL SOCIAL THEORY IN THE ERA OF MASS COMMUNICATION 163 (1990).

[14] RICHARD SCHICKEL, INTIMATE STRANGERS: THE CULTURE OF CELEBRITY 29 (1985).

To extend the right of publicity to allow a celebrity to control the use of his or her identity in a work of fiction would grant them power to suppress ideas associated with that identity, placing off-limits a useful and expressive tool. This, in turn, would effectively revoke the poetic license of those engaged in the creative process. To proscribe their right to use certain names, words, thoughts and ideas would ultimately apply to the rest of us, impeding our ability to express ourselves.[15]

In a line of cases, from *New York Times v. Sullivan,* 376 U.S. 254 (1964) to *Hustler Magazine v. Falwell,* 485 U.S. 46 (1988), the Supreme Court held that speech about "public officials" and "public figures" is so important that it is protected unless the plaintiff can prove by "clear and convincing evidence" that the defendant published the statements with "actual malice," knowledge that the statements are false or in reckless disregard of their truth. 376 U.S. at 279-280; 388 U.S. at 155. This protection has been found regardless of the name the public official or public figure gives to his cause of action.

In *New York Times* and *Curtis Publishing Co. v. Butts*, 388 U.S. 130 (1967), the plaintiffs alleged libel. In *Time, Inc. v. Hill,* 385 U.S. 374, 388 (1967) the plaintiff filed suit under the New York "privacy" or "misappropriation of name" statute. In *Hustler* the plaintiff sued for intentional infliction of emotional distress. In each case the Court unequivocally ruled that the plaintiff must prove by "clear and convincing evidence" that the defendant published statements "of and concerning" the plaintiff with knowledge that the statements are false or in reckless disregard of their truth. *New York Times,* 376 U.S. at 279-280; *Curtis*

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[15] *See* Madow. *Private Ownership of Public Image: Popular Culture and Publicity Rights,* 81 CAL. L. Rev. 125, 138 (1993).

Publishing Co, 388 U.S. at 155; *Time,* 385 U.S. at 388; *Hustler,* 485 U.S. at 56.

Hustler is particularly instructive because, as in this case, it involved a cartoon. There, *Hustler Magazine,* which features glossy nude photos of women in compromising positions, featured a cartoon about Jerry Falwell, an evangelical minister and the leader of a political-religious group known as the Moral Majority. In his opinion for a unanimous Court, Chief Justice Rehnquist recited the facts in that case as follows:

> The inside front cover of the November 1983 issue of Hustler Magazine featured a "parody" of an advertisement for Campari Liqueur that contained the name and picture of respondent and was entitled "Jerry Falwell talks about his first time." This parody was modeled after actual Campari ads that included interviews with various celebrities about their "first times." Although it was apparent by the end of each interview that this meant the first time they sampled Campari, the ads clearly played on the sexual double entendre of the general subject of "first times." Copying the form and layout of these Campari ads, Hustler's editors chose respondent as the featured celebrity and drafted an alleged "interview" with him in which he states that his "first time" was during a drunken incestuous rendezvous with his mother in an outhouse. The Hustler parody portrays respondent and his mother as drunk and immoral, and suggests that respondent is a hypocrite who preaches only when he is drunk. *Hustler*, 485 U.S. at 48.

Falwell filed suit for invasion of privacy, defamation and intentional infliction of emotional distress. *Id.* at 47-48. The trial court directed a verdict on the invasion of privacy count on the ground that Falwell was a public

figure, but submitted the other two claims to a jury. *Id.* at 48. Though the jury found in favor of the defendants on the defamation count, it awarded Falwell $100,000 in compensatory and $100,000 in punitive damages on the emotional distress claim. *Id.* at 49. The Fourth Circuit Court of Appeals affirmed. *Id.* The Supreme Court reversed.

Characterizing the *Hustler* cartoon as a mere "distant cousin" of the honored political cartoons of the past, the court found that it was nonetheless fully protected by the First Amendment because there is no "principled standard to separate the one from the other... ." *Id.* at 55. The Court held:

> We conclude that public figures and public officials may not recover for the tort of intentional infliction of emotional distress by reason of publications such as the one here at issue without showing in addition that the publication contains a false statement of fact which was made with "actual malice," i.e., with knowledge that the statement was false or with reckless disregard as to whether or not it was true.

Id. at 56. Because the jury found the *Hustler* cartoon could not be understood as describing actual facts about Falwell, the Supreme Court reversed, holding the judgment entered against Hustler inconsistent with the First Amendment. *Id.*

Twist points out that *Hustler* was an emotional distress claim, not a "right of publicity" or "misappropriation of name" claim. But the difference in the torts does not affect the protection afforded by the Constitution. A person cannot be defamed by or suffer emotional distress from a publication unless his identity is appropriated. In every case where a public figure raises a

defamation or emotional distress claim against a publisher he can also bring a "misappropriation of name" or "right of publicity" claim. If Falwell, Twist or other public figures were permitted to prevail on a "right of publicity" or "misappropriation of name" without satisfying the *New York Times* test, our First Amendment protections would be an illusion. Every public figure, under the guise of "misappropriation" or "right of publicity," could circumvent the First Amendment and prevent all speech about them that they do not like. This is clearly not the law. [16]

As a work of fiction, *Spawn* is fully protected by the First Amendment. It does not lose that protection because it is published for profit. *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council,* 425 U.S. 748, 762 (1976). Before Twist can recover on his right of publicity claim he must, therefore, satisfy the *New York Times* "actual malice" standard, knowledge that the statements are false or in reckless disregard of their truth. Prerequisite to satisfying this "actual malice" standard is that the publication be "of and concerning" the plaintiff. *See, e.g.,* McCarthy, *supra* at 8-108; *Hicks v. Casablanca Records,* 464 F. Supp. 426, 432 (U.S. Dist. N.Y. 1978). It is not enough that the publication invokes the plaintiff's identity or is in some sense "about" the plaintiff. A reader must reasonably

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[16] It is true that in *Hustler* the Supreme Court said that *Zacchini* stands for the proposition that "the 'actual malice' standard does not apply to the tort of appropriation of a right of publicity..." *Hustler*, 485 U.S. at 52. But that statement must be read in context. The "right of publicity" the *Zacchini* court addressed was the appropriation of a performer's "entire act," not the use of his name or persona in a work of fiction. The *New York Times* test cannot be applied when what is appropriated is a person's "entire act" because it is logically impossible for an accurate rebroadcast of an entire performance to be false.

believe that the depiction is meant to portray, "in actual fact, the plaintiff *acting as described.*" *Bindrim* V. *Mitchell,* 92 Cal. App. 3d 61, 78, cert. denied, 444 U.S. 984 (1979) (emphasis added).

The application of the "of and concerning" requirement to a fictional publication is a threshold question. Here, the trial court applied that requirement when dismissing the plaintiff's defamation claim, finding no reasonable person could believe that the events portrayed in *Spawn* are "of and concerning" the plaintiff. But the court refused to apply the First Amendment, including that requirement, when addressing the misappropriation claim, finding only that "Plaintiff's petition explicitly pleads the elements of a wrongful appropriation claim."

The court again reached the "of and concerning" issue when the McFarlane defendants sought summary judgment on the misappropriation claim. But, when addressing the misappropriation claim, it found the degree of similarity between the plaintiff and defendant's comic book character to be a question of fact and, for that reason, denied the motion for summary judgment on that claim. Finding the First Amendment inapplicable, the court essentially adopted Twist's reading of *Zacchini.* It is this ruling that made necessary a trial on the "merits" on the misappropriation claim.

After trial, the court granted the judgment notwithstanding the verdict, continuing to ignore the "of and concerning" requirement and the applicability of the First Amendment. The court reasoned instead that the Missouri misappropriation tort requires a specific intent to benefit the defendant or to harm the plaintiff and because no such proof was offered the motion for judgment notwithstanding the verdict must be granted. While we reject the trial court's reasoning for granting

the motion for JNOV, we will affirm it if it is sustainable for any reason.

We therefore treat the "of and concerning" requirement of the First Amendment before treatment of any alleged defects in the submission of a state tort claim. Accordingly, we must determine if a reasonable reading of *Spawn* can lead to the conclusion that the Twist comic book character is meant to portray, in actual fact, Twist the hockey player acting as described.

Twist's entire argument focuses on avoiding such an application because of his familiarity with the depiction of the Tony Twist character in *Spawn*. Even the most cursory examination of the comic book reveals that no intelligent person could believe that the fictional Tony Twist's actions are those of the plaintiff. First, *Spawn* is a comic book about a man who has come back from the dead with superhuman powers. The character bearing the plaintiff's name has an entirely different history and bears no physical resemblance to the plaintiff. Even the plaintiff admits that no one could believe that the actions of the fictional Tony Twist are his actions. We conclude that a reader could not reasonably believe that the Twist comic book character is meant to portray, in actual fact, Twist the hockey player, acting as described. Accordingly, and consistent with the decisions reached in similar cases in other jurisdictions,[17] we find that *Spawn* is not "of and con-

[17] *See e.g., Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 194 F.3d 505, 522-24 (4th Cir. 1999)(First Amendment precludes award of publication damages for non-reputational tort claims unless plaintiff satisfies the proof standard of *New York Times*); *Meeropol Nizer*, 560 F.2d 1061, 1066 (2nd Cir. 1977)("The same standards of constitutional protection apply to an invasion of privacy as to libel claims"); *Matthews v. Wozencraft*, 15 F.3d 432, 439 (5th Cir. 1994)("Courts long ago recognized that a celebrity's right of

Continued on Next Page

cerning" the plaintiff, and he cannot therefore maintain his claim for either misappropriation of name or violation of his right of publicity.[18]

The First Amendment Protects McFarlane's Truthful Identification Of Twist As The Inspiration For A Fictional Character

Having held the use of Twist's identity in a work of fiction is protected by the First Amendment, we next treat Twist's theory that he can recover because McFarlane identified him as the inspiration for the fictional character. He is identified as that inspiration

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Footnote 17 Continued

publicity does not preclude others from incorporating a person's name, features or biography in a literary work, motion picture, news or entertainment story."); *Ruffin-Steinback v. Depasse,* 82 F. Supp. 2d 723 (E.D. Mich. 2000) (appropriation of names and likenesses of singing group in TV "docu-drama" non-actionable); *Seale v. Gramercy Pictures,* 949 F. Supp. 331, 335 (E.D. Pa. 1996) later proceedings at 964 F. Supp. 918, 923 (E.D. Pa. 1997) *aff'd* 156 F.3d 1225 (3rd Cir. 1998) (dismissing right of publicity, privacy and false endorsement claims of former Black Panther leader Bobby Seale for use of his name and image in a movie, accompanying book, home video and sound track CD); *Polydoros v. Twentieth Century Fox Film Corp.,* 67 Cal.Rptr. 2d 305, 307-08 (Cal.App. 1997)(fictionalized motion picture which used the plaintiff's name and childhood identity was privileged under the First Amendment); *Rosemont Enterprises, Inc. v. McGraw-Hill Book Co.,* 380 N.Y.S.2d 839, 844 (1975) ("it should go without saying that a person need not get the consent of a celebrity to write a fictional piece about that person, so long as it is made clear that the creative work is fictional.").

[18] *See Milkovich v. Lorain Journal Co.,* 497 U.S. 1, 20 (1990)("the *Bresler-Letter Carriers-Falwell* line of cases provides protection for statements that cannot 'reasonably [be] interpreted as stating actual facts' about an individual. This provides assurance that public debate will not suffer for lack of 'imaginative expression' or the 'rhetorical hyperbole' which has traditionally added much to the discourse of our Nation.")

both in the back of the comic book and in McFarlane's interview in the *Wizard* publication. Twist alleges that this identification constitutes a commercial exploitation of his fame to sell more comic books.

Twist correctly concludes that, if his name and identity are used in an advertisement to encourage a reader to buy the comic book, he is entitled to his share of profits from that sale. We must therefore determine if Twist's name as a symbol of his identity was used to persuade readers to buy a copy of the comic book. In that pursuit we must determine if the content of McFarlane's responses to the fan letters and his interview with *Wizard* invoke Tony Twist's identity and propose a commercial transaction.

In his September letter McFarlane says:

> The great thing about writing and drawing your own book is you get to have as much fun with it as you want... Whenever I choose a name I try to have a little bit of play on it... I am a big hockey fan, and a lot of my characters have been named after current NHL hockey players. For example, Antonio Twistelli, a/k/a Tony Twist, is actually the name of a hockey player of the Quebec Nordiques.

In his interview with *Wizard* he is reported to have said:

> It's easier to come up with the names of people sitting next to you.... And for the most part, if I don't put my friends and family in my books, I guarantee that nobody at Marvel is going to do it for me. I do it just because I can. I've got that freedom. It's one of the great things about controlling your own book.

As can be seen, neither in McFarlane's responses to the fan mail nor in his *Wizard* interview does he request that the readers purchase anything or propose any other commercial transaction. In order to characterize them as "advertising," we would have to adopt the view that all speech that contributes to sales is, in the end, merely commercial speech. But under such a standard even core political speech in newspapers would be commercial because the paper's reporting and commentary contribute to sales. No reasonable reading of the fan mail responses could lead to a conclusion that McFarlane is proposing a commercial transaction. He is simply expressing his opinion and relating information that a reader of his comic books might find interesting.

The fan mail section of the comic book is "news" to *Spawn's* readers. While some may not find that type of news to be very important in the scheme of things, it is not for them to judge, but for you and every individual reader. First Amendment principles require us to be extremely cautious of declaring any information unnewsworthy and outside the protections of the First Amendment. *Harper & Row Publishers,* 471 U.S. at 561.

That caution has led courts to find the following "newsworthy" and protected from assertions of privacy and publicity rights: the latest fashions, tips on grooming, the latest romantic exploits of celebrities, places to find nude beaches, who is the favorite member of a rock group, what movies are being shown, who is in them, and more. *See* McCarthy, *supra,* § 8:52 (citing cases).

McFarlane's statements, both in the back of *Spawn* and in his interview with the writer from *Wizard,* were truthful statements about a matter of legitimate public interest; namely, how a comic book writer names his

characters. It would be strange indeed were the law to allow McFarlane to name his characters after celebrities, and then prevent him from admitting this. *See Smith v. Daily Mail Publishing Co.*, 443 U.S. 97, 103 (1979) (State officials may not constitutionally punish publication of protected information absent a need to further a state interest of the highest order.). McFarlane's public admission that Twist was the inspiration for his fictional mafia character Tony Twist is, therefore, protected by the First Amendment.

The First Amendment And Cross-Marketing Protected Works Of Fiction With Other Purely Commercial Enterprises

Twist's final complaint is that McFarlane cross-marketed the comic book by packaging it with action figures and holding a "*Spawn* Night" at a minor league hockey game, arguing that this proves that McFarlane targeted hockey fans and thus used Twist's popularity to boost sales.

The trial record reveals, however, that McFarlane packaged two *Spawn* action figures (Overt-Kill and Tremor) with a shortened version of a *Spawn* comic book. No toy resembling the Twist comic book character or the plaintiff was ever made. In both comics contained in the promotional packages the Tony Twist character appeared on only one page inside each comic book. Neither the Twist character nor the name "Tony Twist" appeared on the package.

Twist fails to direct us to any evidence that his name or identity was used either in marketing the toys or at the promotional *Spawn* night. Even if the appearance of the fictional Twist character inside the comics would qualify as an "incidental use" of Twist's name, it is nonetheless protected by the First Amendment. *See*

Ruffin-Steinback v. Depasse, 267 F.3d 457, 462 (6th Cir. 2001) (holding that "the use of plaintiffs' fictionalized likenesses in a work protected by the First Amendment and the advertising [sic] incidental to such uses did not give rise to a claim for relief under the plaintiffs' rights of publicity"); *Guglielmi,* 603 P.2d at 462, (Bird, C.J., concurring) ("Since the use of [Rudolph] Valentino's name and likeness in the film was not an actionable infringement of Valentino's right of publicity, the use of his identity in advertisements for the film is similarly not actionable."). Because Twist presented no evidence of marketing that involves his identity or his name he cannot prevail on this point.

CONCLUSION

Finding that the Tony Twist character in *Spawn is* not a depiction "of and concerning" Tony Twist the retired hockey player, we conclude that the First Amendment is a bar to Twist's right of publicity claim. Because all of the legally operative facts necessary to a decision on that question were present and uncontested when the motion for summary judgment was heard, we conclude that this case should never have been tried on the merits.

While a proud hallmark of our system of justice requires that we err on the side of trial on the merits, some trials that should never have taken place, while capable of serving a role in the orderly development of the law, can in fact do more damage to our system of values than others. This is especially true where First Amendment rights are at stake.

The Supreme Court has addressed this problem and concluded that for free speech rights to be real they must have "breathing space" to prevent any "chilling effect" caused by uncertain legal rules governing what

speech is protected by the First Amendment. *Caroll v. President and Commissioners of Princess Anne,* 393 U.S. 174 (1968). This breathing space is considerable when it comes to discussion about "public officials," "public figures" and even private persons involved in "matters of public interest." The Supreme Court has said:

> Fear of large verdicts in damage suits for innocent or merely negligent misstatement, even fear of the expense involved in their defense, must inevitably cause publishers to steer wider of the unlawful zone, and thus create the danger that the legitimate utterance will be penalized.

Time, Inc. v. Hill, 385 U.S. 374, 389 (1967) (internal citations and quotation omitted).

This $24.5 million verdict makes real the chilling effect the Supreme Court references in *Time v. Hill.* And so how are we to understand such a large verdict if we are still to conclude that plaintiff failed to make a submissible case?

We understand it to be a product of the jury following the verdict directing instruction as given. They were told they must compensate a public figure for the use of his name in a presumptively protected work of fiction. But they were never instructed to apply the "of and concerning" test, which would require them to determine if a reader could believe that the *Spawn* character was meant to depict the plaintiff actually carrying out the acts described in the comic book. An affirmative answer to this threshold question is essential. For if the publication is not "of and concerning" the plaintiff, it is unnecessary to inquire further into the elements of a First Amendment defense. It is equally unnecessary to treat the elements of a state tort claim.

While rights of publicity and misappropriation of name torts are important protection for real and significant property rights, they cannot, in the order of things, prevail over principles of free expression that are at the center of our system of laws. Our ruling today should not, however, be read as an approval of the ethics of McFarlane's practice of naming characters, but leaves that to the readers and viewers of the *Spawn* story.

We hold today that the First Amendment protects the defendants' comic books, animated series and the truthful identification of the plaintiff as the inspiration for the name of the fictional character. Given this, there can be no legal ground to enjoin the McFarlane defendants from these lawful activities. The judgment notwithstanding the verdict is affirmed because this comic book and the derivative mediums utilized to communicate the *Spawn* story as conceived and created are protected by the First Amendment of the United States Constitution.

s/_____
James R. Dowd, P.J.

Paul J. Simon, J., Concurs
Mary K. Hoff, J., Concurs

Appendix C

MISSOURI CIRCUIT COURT
TWENTY-SECOND CIRCUIT
(City of St. Louis)

JOHN DOE (TONY TWIST),
Plaintiff,

V.

TCI CABLEVISION, etc., et al.,
Defendants.

Oct 31 2000

Cause No. 972-09415
Div. 3

MEMORANDUM, ORDER AND JUDGMENT

Although trial lawyers and the jury system have received harsh criticism of late, it is worth noting that a plurality of the signers of the Declaration of Independence were lawyers, mostly trial lawyers, and juries have stood between oppressive government and the ordinary citizen for centuries. Withal, juries are not infallible. When trial judges fail in their task to provide proper guidance on the law, and to screen expert evidence for objective indicia of reliability, mistakes will be made, sometimes grievous mistakes. It is with great trepidation that judges set aside verdicts of jurors, ever mindful of the dictum, *vox populi, vox Dei;* nevertheless, when a mistake is made, judges shirk their duty if they fail to rectify it.

For the reasons that follow, this Court denies Tony Twist's claim for an injunction to forbid further use of his name by defendants. Further, this Court sets aside the verdict of the jury, enters judgment notwithstanding the verdict on plaintiff's damage claim, and conditionally grants defendants' alternative motions for new trial.

Procedural History

This action was commenced in 1997 with filing of a petition alleging claims of defamation and invasion of privacy by misappropriation of name and likeness, against Todd McFarlane, various companies owned or controlled by him, Time-Warner/HBO, and a host of other comic book distributors. The case was removed to federal court, but, as so often happens, was remanded in late 1998.

This Court dismissed all defamation claims and claims for emotional distress against the defendants on motions filed during 1999 and early 2000. The Court also dismissed all claims against the comic book distributors and all other parties having no obvious connection with the McFarlane defendants, except Time-Warner/HBO. Time-Warner remained in the case because plaintiff alleged that it had exercised some creative control over the use of the plaintiff's name in the "Spawn" feature films broadcast over Time-Warner's cable television network, and the evidence on the motion for summary judgment appeared to support this allegation.

The Court initially ordered that the issue of liability would be tried first, with an advisory jury empanelled to assist the Court in determining the question. However, when it became necessary to continue the trial setting in the spring of 2000, the Court decided to try all

damage claims to a jury, with the evidence being received concurrently by the Court on the claim for injunctive relief. Thus, the case went to trial before a jury from June 19 through July 5, 2000. Time-Warner settled before the close of plaintiff's case. The Court entered a directed verdict in favor of defendants on plaintiff's claim for punitive damages. Plaintiff then decided to submit only a single claim to the jury against the remaining defendants, based on the theory of misappropriation of name.

On July 5, 2000, the jury returned verdicts in favor of plaintiff and against all defendants on plaintiff's claim for damages for misappropriation of his name. Timely motions for judgment n.o.v. or for new trial were filed by the defendants. On September 15, 2000, the Court heard arguments on these motions and received some additional evidence on the claim for injunctive relief, count VI of the amended petition.

Facts

In 1992, an obscure comic book artist launched a bizarre comic book entitled "Spawn." It was a hit, bringing substantial wealth to the artist. In the course of developing the ongoing story, the artist peopled the comic book with a variety of characters, some unsavory and most decidedly not, many of them named after people personally known to the artist, others named after professional hockey players. Many of the hockey players' names were originally drawn from the roster of a mediocre professional hockey team known as the Quebec Nordiques. In the sixth "number" of the "Spawn" series, the artist introduced a brutal, swarthy, stereotypical *mafioso*, later identified as Antonio Twistelli, a/k/a "Tony Twist." At the time of the publication of the comic book introducing the Twist character, plaintiff

Anthony Rory Twist was an obscure hockey player with the also-ran Quebec Nordiques.

Over the years, the "Spawn" comic book enterprise grew and prospered, spawning, as it were, movies, "action toys" and a variety of related comic books. In addition to defendant Image Comics, which was formed by McFarlane and several other comic book artists to provide a means to print and distribute their comic books, several other corporations were formed by McFarlane to market "Spawn" films and toys.

Similarly, the career of Tony Twist the hockey player also prospered. In 1994, he became a member of the St. Louis Blues professional hockey team. As a member of the Blues, Twist earned a reputation as an "enforcer," i.e., a player known for the ability to win brawls. He achieved a measure of national celebrity, being featured in national publications such as *Sports Illustrated*. At the same time, he engaged in many charitable activities and developed a reputation as a person interested in and willing to help disadvantaged children.

The careers of McFarlane and Twist intersected in 1997 when Twist's mother called him to express her distress at his association with the "Spawn" comic book. His mother's call was prompted by a visit from an autograph-seeking little boy, who had a trading card of the fictional *mafioso* Tony Twist. Twist investigated via the Internet, and learned more about "Spawn." He obtained the six-part cartoon video version of "Spawn" that was broadcast by Time-Warner HBO, noting with distress the prominence of the *mafioso* Twist character. Later, Twist was approached at a hockey game by another boy, who proffered a copy of *Wizard Spawn Tribute*. Pl. Ex. 1A. (*Wizard* is a sort of trade publication, being in substance a comic book review publica-

tion, not affiliated with McFarlane or his companies.) In the edition of *Spawn Tribute* proffered to him, Twist saw his own photograph juxtaposed with the fictional *mafioso* in an article in which the writer (a reporter not affiliated with McFarlane) reported that the *mafioso* character was "modeled" on the National Hockey League "enforcer," Tony Twist. Thus was spawned[1] this litigation, in which Tony Twist seeks injunctive relief and damages from Todd McFarlane and his companies. After trial of the damage claims, the jury awarded Twist $24,500,000, on the premise that the use of Twist's name was worth that much to McFarlane or has done that much damage to the marketability of Twist's name.

The evidence at trial established that the defendants have realized an aggregate revenue of approximately $124,000,000, during the entire time that the "Spawn" series has been published and marketed. Over objection, plaintiff presented the testimony of Dr. Brian Till, a marketing professor, and Rocky Arceneaux, a business agent for various professional sports players, to the effect that the use of plaintiff's name in the "Spawn" series had value to defendants. Dr. Till estimated the value of the use of plaintiff's name as high 15% of gross revenues of products in which plaintiff's "name or persona" was actually used, and as high as 9% of gross revenues for products in which Twist's "name or persona" was not used. Till testimony. Arceneaux was even more generous, asserting that the use of plaintiff's name in the context of the "Spawn" storyline carried an additional premium, and placing the value of the use of plaintiff's name at 20% of the defendants' gross revenues.

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[1]The Court promises not to employ this pun again.

Plaintiff also presented evidence that he had obtained endorsement income during his professional career, to a maximum of about $20,000 in any one year, and that, after the commencement of the litigation, he entered into negotiations with one Sean Phillips, a consultant and sometime officer of a nutrition supplement maker known as EAS. According to plaintiff's evidence, EAS and plaintiff had a tentative agreement that plaintiff would be retained to endorse EAS products at an annual compensation of $100,000. During the negotiations, Phillips inquired of Twist if there was anything that would detract from the value of his name, and Twist informed Phillips of the "Spawn" matter. At that point, according to Phillips, he (Phillips) terminated the negotiations.

The jury's verdict reflects that the jury computed damages based on a percentage of gross revenues of the defendant, apparently accepting the Arceneaux theory of a "bonus" or "negative impact" increasing the royalty, and arriving at an aggregate figure of $24,500,000.

Count VI - Injunction

This case is in an unusual procedural posture, as a result of the Court's decision to try the damage claims to a jury, while reserving judgment on the claim for injunctive relief. The record before the jury, supplemented by a soupçon of additional evidence at the hearing on the motions following the jury's verdict, is therefore the record on the claim for injunctive relief. Because the Court is the finder of fact on the injunction claim, the jury's verdict is merely advisory on that claim. Accordingly, the Court is not bound by the jury's view of the evidence. *Mo-Kan Teamsters Health & Welfare Fund v. Clark*, 803 S.W.2d 61 (Mo. App . W. D. 1990)

The Court agrees with the jury that defendant McFarlane intentionally used the name of the plaintiff as the name of the fictional *mafioso* character in the "Spawn" comic book. The Court is willing to believe that McFarlane cannot at this time recall his exact thought process in developing and christening the *mafioso* character, but, given McFarlane's avid interest in hockey, his penchant for giving other fictional characters the names of professional hockey players, and his own published admission that many characters in the comic book were named after members of the Quebec Nordiques hockey team, it beggars credulity to accept that McFarlane's use of the name Tony Twist was a coincidence.

What is lacking on this record, however, is credible evidence that McFarlane at any time intended to injure Twist's marketability, to capitalize on the market recognition of the name Tony Twist, or in fact derived any pecuniary benefit whatsoever from the use of that name. When McFarlane first used the name Tony Twist, the plaintiff had no market recognition and was earning precisely zero income from endorsements. Later, to be sure, plaintiff became fairly well known in sports circles, but there is no evidence that plaintiff's name had any intrinsic worth as a marketing device for comic books on a national basis.

The Court has previously enunciated its views on how the common law action for invasion of privacy by misappropriation of name or likeness is affected by the constitutional freedom of the press guaranteed by the First Amendment and Mo.Const. art. I, §8. The governing principle is and must be whether the defendant, be it a "media" defendant or a common huckster of patent medicines, took from the plaintiff something of value that the defendant ordinarily could not get without

paying. When the only thing appropriated by a defendant is the plaintiff's name, there can be no right of action, outside the purely commercial or advertising context, unless the defendant intended to use the *plaintiff's* name and concomitantly intended to injure the plaintiff's marketability of his name, or in fact intended to and did derive economic benefit from the use of the plaintiff's name. The Court adheres to its previous opinions on this score.[2]

When McFarlane christened the *mafioso*, plaintiff Tony Twist was unknown to the general public. Even at the height of his own fame, plaintiff was known at best to people in St. Louis and hockey fans elsewhere. The evidence is indisputable that, prior to this litigation, plaintiff secured at best a very modest income from endorsing products or otherwise capitalizing on his name and notoriety. Indeed, the whole record reflects that, prior to this litigation, only three members of the public ever connected plaintiff with the fictional *mafioso* in "Spawn." One of these was plaintiff's mother, and another was a boy who got the idea from a publication independent of "Spawn" itself. The third person aware of the connection was Sean Phillips, who purportedly offered plaintiff an opportunity to secure an endorsement contract with a nutrition supplement marketer, EAS. In the case of Phillips, the connection was made by plaintiff himself, who notified the marketer of the ongoing litigation over the appearance of the name "Tony Twist" in "Spawn."

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[2]It is worth noting that there is not a single reported case in which a plaintiff has been allowed to go to trial on a claim that a defendant, outside the advertising context, misappropriated the plaintiff's name. Although the Court disagrees with the superficial, knee-jerk First Amendment rationale of these cases, it is quite clear that only substantial evidence of a specific intent of the defendant can support an action such as plaintiff's here.

Plaintiff's evidence falls woefully short of anything that would justify mulcting defendants for the use of the name Tony Twist. To grant an injunction on the record before this Court would fly in the face of a long line of cases exemplified by *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46 (1988) and *New York Times v. United States*, 403 U.S. 713 (1971), and would carry the rationale of *Munden v. Harris*, 134 S.W. 1076 (Mo.App.K.C. 1911), and kindred cases to an absurd length.

The Court emphasizes that, by its reading of the law, the evidence presented that plaintiff lost a potential endorsement contract due to defendants' use of his name in "Spawn" is simply irrelevant. The question is not whether the use of plaintiff's name caused injury, the question is whether the defendants *intended* to cause such injury by using plaintiff's name. On this record, that evidence is wholly lacking.

Speaking of evidence, the Court is fain to observe that it has seldom seen less credible evidence than that presented on damages by plaintiff. The witness Sean Phillips, who purportedly aborted plaintiff's potential endorsement contract because of the "Spawn" connection, was wholly unbelievable. Prior to the proposed contract with Twist, Phillips' company, EAS, had never entered into a contract for more than $10,000 with any celebrity endorser. Phillips and plaintiff were personal friends. Phillips was not an executive officer of EAS at the time the supposed endorsement contract was bruited, and nobody else in the company hierarchy had any inkling that such a contract was in the works. See Bellamy depo. at 57. At the time this supposed contract was being negotiated, plaintiff's hockey career had been interrupted by a severe injury, probably disabling him from professional hockey in the future. Finally, the

evidence of this supposed contract first came to light on the very eve of trial.

The evidence of the witness Arceneaux was equally unworthy of belief. Arceneaux formed his opinion of the fair market value of the use of plaintiff's name on the airplane as he was flying in for his deposition. He had never represented any professional hockey players in negotiating endorsement contracts, and he could not point to one hockey player in history who commanded the royalty percentage that he attributed to the use of plaintiff's name. His own testimony concerning his experience in representing better-known football players in the matter of endorsements seriously undermined his assertion that plaintiff's name was worth a 20% royalty on gross revenues of the defendants.

In addition to the Court's finding that defendants did not intentionally use plaintiff's name for their own benefit or in fact derive any economic benefit from the use of that name, the Court concludes that injunctive relief is not available for other reasons.

First, there is the elementary issue of the adequate remedy at law. See generally *Harris v. Union Electric Co.,* 766 S.W.2d 80 (Mo.banc 1989). Albeit *Munden v. Harris* expressed the view that injunctive relief was available to suppress commercial use of a person's name or likeness, in this case the jury was instructed to award plaintiff all damages actually sustained and that the jury reasonably believed he would sustain in the future. The jury's verdict necessarily compensated plaintiff fully for the use of his name. Cf. *Pinney v. Berry*, 61 Mo. 359 (1875).

Second, there is the issue of discretion. Injunctive relief, though a familiar of our jurisprudence, is still considered to be extraordinary and granted sparingly,

and only in clear cases. Here, plaintiff would have the Court break new ground in an especially sensitive area. Defendants are not advertisers or marketers of products. "Spawn" is a work of fiction. There is no resemblance between plaintiff and the comic book Twist whatsoever, despite the specious use of the term "enforcer." The Court cannot find a single case, certainly no Missouri case, in which injunctive relief has been granted to prevent the use of a name by a writer or publisher in a work of fiction. In this case, the evidence does not clearly warrant injunctive relief, nor does it seem that such relief would not interfere with legitimate and proper action by the defendants in the future. See *Metmor Financial, Inc. v. Landoll Corp.,* 976 S.W.2d 454 (Mo.App.W.D. 1998).

Finally, there is the issue of prior restraint. While it is quite true that *Pittsburgh Press v. Human Relations Comm.,* 413 U.S. 376 (1973), holds that newspaper advertising that advances race or sex discrimination in employment can be suppressed, nothing in that case or in *Munden v. Harris* or kindred cases authorizes the sort of relief demanded by plaintiffs. Although the Court has been at pains to apply the principle of *Zacchini v. Scripps-Howard Broadcasting Co.,* 433 U.S. 562 (1977), to the case at bar, see also *Cohen v. Cowles Media Co.,* 501 U.S. 663 (1991), the Court considers that, outside the purely commercial advertising context, the Court is barred by the Constitution to enter an injunction constituting a prior restraint-absent copyright or trademark infringement. Cf. *New York Times Co. v. United States,* 403 U.S. 713 (1971).

The Jury's Verdict

As intimated above, the Court's view of the evidence is wholly at odds with the view of the jury. Ordinarily, this difference would be of no moment, as the Court

would be obliged to view the record in the light most favorable to the jury's verdict and deny judgment n.o.v. if there was any evidence in the record that would enable a rational jury to arrive at the verdict rendered. Because the Court is the trier of fact on count VI, however, this stricture is not controlling.

Assuming that the Court must review the jury's verdict on the damage claim in light of the principles governing grant of motions n.o.v., the Court is nonetheless convinced that the critical evidence needed to support the jury's verdict is absent.

As the Court has adumbrated above, because the defendants used plaintiff's name only, in the context of a work of fiction outside the purely commercial medium, plaintiff could prevail only by adducing substantial evidence of a specific intent by defendants to use his name for their benefit or to his detriment, coupled with evidence that some economic benefit was n fact derived from the use of the name or some specific economic injury was intentionally inflicted on plaintiff. The evidence supports no such findings. Indeed, plaintiff's own witness, Dr. Till, summarized the plaintiff's failure of proof rather neatly:

> Q. I understand. And you're not giving an opinion, are you, that Mr. McFarlane, because he used the name increased his revenues by 15 percent, are you?
>
> A. No, I'm not.
>
> Q. In fact, do you have any opinion as to whether or not Mr. McFarlane sold any comic books that he wouldn't otherwise have sold by using Mr. Twist's name?

A. I can't relate sales of the Spawn products directly to the use of Mr. Twist's name.

Q. You haven't attempted to determine that, have you?

A. It's essentially undeterminable.

Q. So in your opinion, you don't know.

A. I don't know what effect the use of Tony Twist's name or persona has had on Spawn products. [Till Testimony; Draft Tr. 136-37.]

The plain fact of this case is that plaintiff's sole reliance is on the evidence of the intentional use of his name, plus speculation concerning some "value" the bare use of the name had. In light of the context in which plaintiff's name was used, i.e., a work of fiction in which no connection between the real plaintiff and the *mafioso* Twist ever appears, plaintiff must present far more in order to prevail on the misappropriation theory. Cf. *Bayer v. Ralston Purina Co.*, 484 S.W.2d 473 (Mo. 1972).

Even assuming that the jury was correctly instructed on plaintiff's theory, the jury was required to find either that defendants "derived advantage from the use or publication of plaintiff's name, or plaintiff suffered harm as a result." Instruction No. 7. Because the evidence wholly fails to support these propositions, judgment must be entered for defendants. (The Court omits discussion of the patent absurdity of holding the corporate defendants liable for damages inflicted prior to their existence, and the very real absence of evidence to support the claim against Image Comics, which served purely as a publishing conduit and exercised no editorial control over publications that it handled for the creators.)

New Trial

Rule 72.01(c) (1), Mo. R.Civ.P., prescribes that a trial court shall rule on any motion for new trial filed with a motion for judgment n.o.v. that is granted. Rules 72.01(c) (1) and 78.03 require the Court to specify grounds on which a new trial is granted. Rule 78.08 allows consideration of plain error, though defectively raised.

Defendants have raised several errors warranting a new trial. The principal error asserted is instructional: the Court misdirected the jury on the law governing defendants' liability. As the discussion above foreordains, the Court agrees that it did so err.

The verdict-directing instructions in this case omitted any requirement that the jury find that defendants specifically intended to use plaintiff's name for their economic benefit or specifically intended to injury plaintiff's marketability of his name. The instructions also omitted any direction to the jury to find that defendants in fact had appropriated the commercial value in the use of plaintiff's name. In instructing the jury in accordance with the verdict directing instructions ultimately submitted by plaintiff, the Court departed from the principles laid down in its Order of April 10, 2000, denying summary judgment. Attempting to harmonize *Zacchini* and *Falwell,* this Court concluded that the Constitution demanded evidence of a very specific intent--much as the Constitution commands very specific intent in order to sustain claims for defamation in the context of publications concerning public figures or events. The Court simply did not give such instructions to the jury. Rather, the Court allowed the jury to attach almost any meaning to "value" and, worse, allowed the jury to impose liability solely for intentional use of a name, without the concomitant intent to obtain benefit or to injure. Defendant's pro-

posed verdict directing instructions were more nearly correct. In any event, plaintiff's verdict directing instructions were hopelessly broad and inaccurate. Moreover, in instructing the jury to find for plaintiff if defendants either derived advantage or inflicted harm, the Court erred, since the evidence that defendants derived any advantage from the use of plaintiff's name is absent. Even accepting the patently false testimony of Phillips, as the jury evidently did, the disjunctive submission warrants a new trial. *M.C. v. Yeargin,* 11 S.W.3d 604 (Mo.App.E.D. 1999).

The Court also misdirected the jury in the matter of damages. Although *Munden v. Harris, 134 S.W.* 1076 (Mo.App.K.C. 1911), contemplates the award of general and special damages, the Court is conscious that the essence of a claim of invasion of privacy by misappropriation of name is the appropriation of commercial advantage in the use of another's name, i.e., the unfairness of allowing a defendant to derive economic advantage, or to inflict economic harm, from the use of a property right of the plaintiff. By allowing the jury to consider all defendants as equally liable for purposes of computing damages, the Court permitted the jury to award damages for conduct occurring before several of the corporate defendants came into existence, and also for conduct that had nothing to do with the use of plaintiff's name, i.e., the marketing of action figures, none of which were derived from the comic book Twist character. In keeping with the limitations on this cause of action delineated above, the Court should have instructed the jury to award damages based specifically on the benefit derived by each defendant from that defendant's own conduct, or on the specific injury that each defendant inflicted on plaintiff's marketability.

The Court likewise erred in admitting the testimony of Dr. Till and Rocky Arceneaux. Although they qualified as experts, their opinions lacked foundation sufficient to justify admission under §490.065, RSMo 1994. There was no evidence of any recognized market for product endorsements by hockey players, no evidence of any royalty previously attributed to the use of plaintiff's name in product endorsements, no evidence that the use of any hockey player's name in a work of fiction would have discernible effect on the market, and no evidence of any empirical studies showing that a hockey player's endorsement would have any effect on the marketing of any product, much less the marketing of a comic book and action figures that bear no resemblance whatever to hockey players. The opinions and methods of Till and Arceneaux are at best "junk economics": they certianly are not science (the same could be said of the testimony of the defendants' experts, but that is not the issue). They are exercises in speculation. The Court should have sustained defendants' motions in limine to exclude the evidence of Till and Arceneaux, and should have sustained defendants' timely renewed objections at trial. §490.065, RSM0 1994; *M.C. v. Yeargin*, supra.

There can be no doubt that the admission of the testimony of Till and Arceneaux prejudiced defendants, since the jury's verdict on its face shows calculations in keeping with the testimony about the percentage of gross revenues attributable to the value of plaintiff's name. Because of this error, the verdict cannot stand.

Finally, the Court must in good conscience hold that the verdicts in this case are against the manifest weight of the evidence. No rational person could believe that the use of plaintiff's name as the *nom de guerre* of a swarthy *mafioso* in a comic book series, having abso-

lutely nothing to do with hockey, either benefited defendants or injured plaintiff in any way, except perhaps in plaintiff's imagination.

The fatal flaw in plaintiff's case is the belief that the mere intentional use of the plaintiff's name, coupled with the bare "advantage" of using one combination of syllables versus another, is sufficient to fasten liability on the creator of a work of fiction. In this case, given the fictional context, the complete absence of demonstrable pecuniary value to the defendants, and absence of any demonstrable intent to inflict economic harm on the plaintiff, plaintiff's case must fail.

ORDER AND JUDGMENT

For the foregoing reasons, it is

ORDERED, ADJUDGED AND DECREED that defendants Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc., Todd McFarlane Entertainment, Inc., and Image Comics, Inc., have judgment against plaintiff on count VI of the plaintiff's amended petition, which count VI is dismissed with prejudice; and it is

FURTHER ORDERED, ADJUDGED AND DECREED that the verdict of the jury herein in favor of plaintiff on plaintiff's claim for damages be and the same is hereby set aside and judgment notwithstanding the verdict is entered in favor of defendants Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc., Todd McFarlane Entertainment, Inc., and Image Comics, Inc., on all claims for misappropriation of name, and all remaining counts of the amended petition are dismissed with prejudice; and it is

FURTHER ORDERED that, in the event the judgment notwithstanding the verdict herein be reversed, vacated or set aside, the alternative motions for new trial of defendants Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc., Todd McFarlane Entertainment, Inc., and Image Comics, Inc., are granted, and a new trial is ordered on plaintiff's claim for misappropriation of name as alleged in the amended petition for the following reasons: (a) the verdict of the jury was against the manifest weight of the evidence; (b) the Court erred in instructing the jury in accordance with verdict-directing instructions 6, 8, 10 and 12 and in refusing defendants' proffered instructions D, E, F and G; (c) the Court erred in instructing the jury to return a verdict assessing damages against the defendants jointly and severally and in permitting the jury to consider in its damages computation sums realized by defendants prior to the use of plaintiff's name in any manner; and (d) the Court erred in admitting the testimony of Brian Till and Rocky Arceneaux on the issue of damages; and it is

FURTHER ORDERED that defendants' alternative motions for new trial or for remittitur are otherwise denied; and it is

FURTHER ORDERED, ADJUDGED AND DECREED that all claims and parties having been disposed of, final judgment is hereby entered in favor of each and every defendant and against plaintiff on all claims alleged in the amended petition, which is dismissed in its entirety with prejudice; costs taxed against plaintiff.

SO ORDERED:
s/_____
Robert H. Dierker
Circuit Judge

Dated: 31 Oct., 2000
cc: All counsel

Supreme Court, U.S.
FILED
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No. 03-615

IN THE

Supreme Court of the United States

TODD MCFARLANE, ET AL.
Petitioners,

v.

ANTHONY R. "TONY" TWIST,
Respondent.

On Petition for Writ of Certiorari
To the Supreme Court of Missouri

RESPONDENT'S BRIEF IN OPPOSITION

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COUNTER-STATEMENT OF QUESTION PRESENTED

Is the use without permission of another person's name and identity in a published work, and collateral promotional material, protected by the First Amendment right of free speech when that use is for the purpose of marketing the work and the use of the name and identity is not a parody of or "of and concerning" the person whose name is appropriated?

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STATEMENT OF THE CASE

The Missouri Supreme Court correctly recognized that this case involves the manner in which the U.S. Constitution balances conflicting constitutionally recognized and protected interests – property rights *versus* speech rights – when one person pirates a celebrity's name and identity with the intent to obtain a commercial advantage and uses it as a ploy to sell its own work and related products. (A-14)[1] As it pointed out, its approach effected a true balance between the two, as opposed to the deceptive "balances" obtained through an inflexible application of the two tests that Petitioners propose. (A-18.) Its discussion of the weakness of the relatedness and transformative use tests, however, is not a rejection of those tests. Instead it is a recognition that those approaches are better applied under circumstances in which the use of another's identity is either wholly expressive or wholly commercial, a circumstance not before the court.

Thus, the approach applied by the Missouri Supreme Court does not conflict with the approaches adopted by the lower federal courts and state courts which have considered right of publicity cases but, rather, recognizes that different factual patterns may require different analytical methodologies. (See Point II, *infra*). More importantly, the true balancing approach adopted by the court follows the true balancing approach established by this Court in its precedent in which both constitutionally protected property interests and free speech interests are in competition. (See Point I, *infra*). Equally significant, the true balancing approach followed by the Missouri Supreme Court neither "chills

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[1] Citations to the opinion of the Missouri Supreme Court and Missouri Court of Appeals opinions below are to the case as found as an appendix to the Petition for Writ of Certiorari.

the First Amendment rights of speakers everywhere," (Petition for Writ of Certiorari at 2), nor forces individuals possessing a recognized property right in their name and identity to surrender that right to another wishing to pirate that identity for their own private commercial benefit. The Missouri Supreme Court does not require judgments to be made concerning the artistic value of the celebrity's name to the work but looks to the purpose behind the use of the celebrity's name. (See Point III, *supra*).

Tony Twist sued Petitioners for infringement of his right of publicity when Petitioners named a character in their *Spawn* comic book and HBO animated series after Tony Twist and used his name and professional identity as a hockey player in separate promotional publications. Petitioners sought to defend the claim on First Amendment grounds but, in doing so, never contended that their use of Tony Twist's name was a parody, (contrary to Petitioners' assertion). (Petition for Writ of Certiorari at 13, n.4). In addition, they got the defamation claim dismissed on the basis that the contents, character, story lines and description in *Spawn* is not identifiable with Tony Twist the hockey player and are not "of and concerning" him. (Mo. App. Opinion, App. A 28.)

At trial, the jury found that Petitioners had appropriated Tony Twist's name in violation of his right of publicity and awarded him actual damages of $24.5 million. (The size of the verdict is irrelevant to any issue before this Court since that part of the judgment ordering a new trial was affirmed.) The trial court granted Petitioners' post-trial motion, issuing a judgment notwithstanding the verdict ("JNOV") or, in the alternative, granting a new trial.

On appeal, the Missouri Supreme Court reversed the

trial court's JNOV and affirmed the grant of a new trial. In reversing the JNOV, the Missouri Supreme Court held that Tony Twist made a submissible case on his right of publicity claim and that the claim was not barred by the First Amendment. In ruling that a submissible case had been made, the court based its determination on evidence which showed that Petitioners intentionally used Tony Twist's name for one of the characters in *Spawn*; that Todd McFarlane the creator of *Spawn,* made certain that *Spawn* readers were informed in material collateral to the comic itself ("Spawning Ground" and *Wizard* magazine) that Tony Twist the hockey player was the namesake for Tony Twist the comic character; that McFarlane promised *Spawn* readers that they would continue to see characters in the comic named after current and past hockey players; that Petitioners marketed *Spawn* and its related products directly to hockey fans at hockey games; and that there were instances of *Spawn* and hockey fans making the connection between Tony Twist the hockey player and Tony Twist the comic book character. (A-11-13 and Resp. A. 1-3.)[2]

With respect to the First Amendment defense, the court concluded that the use of Tony Twist's name and identity was predominantly a ploy to sell Petitioners' products. (A-19.) While the casting of the Tony Twist character in *Spawn* comics as a mafia "enforcer" might be considered a "metaphorical reference" to Tony Twist the hockey player, the court noted that Petitioners themselves agreed that the Tony Twist character in *Spawn* was neither parody, expressive comment on or fictionalized account of Tony Twist the hockey player. (A-19.) Central to the Missouri Supreme Court's decision was the evidence that *Spawn* was not about Tony

---

[2] "Resp. A.___" refers to Respondent's Appendix.

Twist the hockey player or hockey in general; and that neither the overall story line nor the story line relating to Tony Twist the comic character attempted to track the real Tony Twist's life. (A-10-11 & A-19.)

The facts relevant to the Missouri Supreme Court's decision on both the submissibility of the claim and the First Amendment issue are as follows:

Tony Twist, the person. Tony Twist was a hockey player with the St. Louis Blues and the Quebec Nordiques from 1988 until 1999. Twist was particularly popular with hockey fans and, as a result, endorsed products, appeared on radio and television shows, hosted his own television talk show (the "Tony Twist Show" on the St. Louis Fox affiliate) and became actively involved with several children's charities. Throughout his playing career, Twist received local and national notoriety in television, radio, and newspapers and was featured in numerous national and local magazines, including *Sports Illustrated*. His product endorsements included Met-RX, a sports nutrition supplement company, (Tr. 349)[3] as well as other nationally-marketed products. (Tr. 348-349.) In September of 1999, Twist was offered a contract to endorse the sports nutrition products of Experimental Applied Sciences ("EAS") at $100,000.00 per year, (Tr. 388), but EAS withdrew that offer after learning of the Tony Twist character in *Spawn*. His product endorsements, television and radio appearances, and his involvement with charities were intended to foster a positive image of himself and to further his career after hockey as a sports commentator and product endorser. (A-2.)

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[3] "Tr." refers to the official transcript of the record on appeal in the Missouri Supreme Court. Exhibits referenced are exhibits admitted into evidence at trial.

Tony Twist, the comic character. *Spawn*, a comic book created in 1992, centered on a CIA assassin named Al Simmons who had been killed by the mafia but returned to earth as the creature "Spawn" after making a deal with the devil. In 1993, a new character was added to the storyline, "Anthony 'Tony Twist' Twistelli," a character openly referred to as "Tony Twist" in the comic book, with McFarlane conceding in his testimony that the key name for the character was "Tony Twist". (Tr. 655). In addition to *Spawn*, the comic book, Petitioners and Time Warner Entertainment, Inc., through its HBO division, collaborated on the production of an animated series based on the *Spawn* story line. (Exhibit 26.) Tony Twist, the character, appeared in all six episodes of the animated series which was broadcast on HBO in the first season. In each of the six episodes, the character was referred to as "Tony Twist" and never as "Antonio Twistelli." McFarlane admitted the HBO series included important characters from the *Spawn* Comic Book (Tr. 776-779), and "Tony Twist" was one of the principal characters in the HBO animated series. (Exhibit 23.) The HBO *Spawn* was converted to video, DVD and laser disc format and was sold and rented to the public. (Exhibits 23, 24 and 25.)

Marketing Spawn using Tony Twist's name. Petitioner's internal documents established the Petitioners' marketing scheme for Spawn and its products would reach no less than 14.55 million people within a four to six month period. (Exhibit 39.) While Tony Twist the comic character was not "of and concerning" Tony Twist the hockey player, Petitioners created a direct relationship between the two in their marketing scheme. Tony Twist the comic character was specifically and intentionally named for Tony Twist the hockey player. Todd McFarlane, part owner of the Edmonton Oilers, is an avowed hockey fan. In "Spawning Ground," a section

of *Spawn* comics in which McFarlane responds to fan letters, McFarlane admitted on separate occasions that characters in *Spawn* were named for professional hockey players (such as Williams, Sakic, Twist, Linden and Roeniek),(Exhibit 16, Issue 20), that the character Tony Twist was named after Tony Twist the hockey player and further promised readers that they "will continue to see current and past hockey players' names in my books." (A-13; emphasis added). Two years later in the trade magazine *Wizard*, McFarlane again admitted that he uses the names of real-life people as the names of his characters and included a description of Tony Twist the hockey player among the most notable characters in *Spawn*. (Resp. A.1-3). Contrary to Petitioners attempts to portray Tony Twist as a minor character in their story line, (*see, e.g.,* Petition for Writ of Certiorari at 3), McFarlane testified that Tony Twist was an important character in both the *Spawn* comic and HBO series. (Tr. at 779.)

Other evidence showed that McFarlane was marketing *Spawn* directly to hockey fans. To promote the comic, McFarlane produced and licensed *Spawn* logo hockey pucks, hockey jerseys, toy zambonis, and other products, some featuring the character "Tony Twist." A *Spawn* night was sponsored at a minor league hockey game, at which McFarlane appeared and distributed *Spawn* products, including products containing the Tony Twist character. Another *Spawn* night was scheduled for an NHL venue but was never held. (A-5 and 13.)

Missouri's right of publicity cause of action. Notably missing from Petitioners' petition is any in-depth discussion of the right of publicity recognized by Missouri courts. The nature of the cause of action and its elements provide the factual framework by which the First Amendment issue must be viewed and also

determines the type of First Amendment analysis which must be applied to those facts.

Under Missouri law, the right of publicity is a recognized property right in a person's name or likeness that can be protected from infringement or appropriation by others. (A-14 and 16.) The essence of the right of publicity is the exclusive right and ability of a person to control the use of his name and unique identity for his economic benefit and the concomitant right to prevent others from pirating the name and identity for their own commercial benefit and unjust enrichment. (A-6-8.) Consistent with the right, the damages awarded for an invasion of the right of publicity focuses on the pecuniary loss to the plaintiff or the unjust pecuniary gain to the defendant. (A-7.) It does not seek to compensate the plaintiff for the personal injury to his or her reputation.

There are three elements to the cause of action under Missouri law: (1) the use of the plaintiff's name by the defendant as a symbol of the plaintiff's identity; (2) the use was without consent; and (3) the use was with the intent to obtain a commercial advantage through that use. (A-9.) As the Missouri Supreme Court explained with respect to this third element, "In a right of publicity case, plaintiff must prove that defendant intended to obtain a commercial advantage, and it is not enough to show that defendant incidentally obtained a commercial advantage by using plaintiff's name or that defendant had some other purpose in using plaintiff's name other than to obtain a commercial advantage." (A-9.) In short, for there to be an infringement of the right of publicity, the defendant must have intended to use the plaintiff's name in a commercial sense.

REASONS FOR DENYING THE WRIT

I.... THE MISSOURI SUPREME COURT'S OPINION IS CONSISTENT WITH THIS COURT'S APPLICATION OF THE FIRST AMENDMENT IN PRIOR DECISIONS.

It is helpful to first note precisely what Petitioners are urging here. Petitioners take exception to the balancing approach utilized by the Missouri Supreme Court. They do not challenge, however, the balance ultimately struck by the court in deciding the case. In addition, it matters not to the Petitioners whether the result they desire is arrived at through the relatedness or the transformative use test. They have no position on which of these tests should be applied.

Petitioners seek a determination that the First Amendment will protect a defendant's use of a celebrity's name as the name of a fictional character in a work unrelated to that celebrity and to promote the sale of the work by further use of the celebrity's name. Under such a ruling, a defendant could use the name or identity of a celebrity with impunity, creating characters in story lines that have nothing to do with the celebrity and then promoting the sale of the defendant's product to fans of the celebrity by merely slapping the celebrity names on characters throughout the work, and identifying the celebrity by name and professional identity in collateral publications. In addition to being inconsistent with the First Amendment principles explained below, such a ruling on its face would extinguish the cause of action for right of publicity.

As the Court recognized in *Lloyd Corporation, Ltd. v. Tanner*, 407 U.S. 551, 569 (1972), there are times when property rights will come into conflict with free speech rights. In such circumstances, the Court noted "that the

Fifth and Fourteenth Amendment rights of private property owners, as well as the First Amendment rights of all citizens, must be respected and protected. The Framers of the Constitution certainly did not think these fundamental rights of a free society are incompatible with each other." *Id.* Particularly *appropos* to this case is the Court's recognition that a simplistic enforcement of the free speech right at the expense of the private property right without some form of accommodation is effectively a dedication of private property for public use. 407 U.S. at 569.

In *Lloyd*, the Court made clear that when a conflict exists between the two constitutionally protected interests a balance must be struck which accommodates the protection of both. 407 U.S. at 567-68. Again particularly *appropos* to the issue in this case is the language used by the Court in rejecting the notion that property rights must be surrendered to free speech rights, language which presages the approach used by the Missouri Supreme Court in this case: "Such an accommodation [of the property interest strictly yielding to the free speech interest] would diminish property rights without significantly enhancing the asserted right of free speech." 407 U.S. at 567. In essence, what the Court requires is that consideration be given to how the purposes behind both constitutional interests are enhanced or diminished and an accommodation made between the two without one being unduly surrendered to the other.

The Court reiterated the need to balance the constitutionally protected interests in *Zacchini v. Scripps-Howard Broadcasting Company*, 433 U.S. 562 (1977). Significant for this case, the Court recognized that a celebrity's right of publicity is a state created property interest. 433 U.S. at 577. Again the Court made clear

that the property interest does not automatically surrender to the free speech interest when there is a conflict: "Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent." 433 U.S. at 574-75. In short, while the Court was presented with an easy fact situation for drawing the balance, it balanced the interests nonetheless.

Zacchini is also important for its discussion of the purposes behind the creation of the right of publicity. As the Court stated, "The rationale (for protecting the right of publicity) is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay." 433 U.S. at 576 (internal quotations and citation omitted). In addition, protecting the right of publicity encourages individual effort by personal gain by providing an incentive to the celebrity to make the investment required to produce and continue his or her performance. 433 U.S. at 576-77, 97 S.Ct. at 2858. The Missouri Supreme Court likewise noted the importance of these purposes as part of the larger lessons that are to be considered in the balance of the constitutionally-protected interests. (A-15.)

Finally, the right of publicity promotes free speech from the standpoint of the celebrity's free speech interests. 433 U.S. at 578. The evidence in this case contains this same aspect. The right of Tony Twist to choose how his identity will be portrayed among the wide array of potential commercial and charitable ventures is itself a

form of expression. In protecting his identity and choosing what that identity will be used to promote, Tony Twist is publicly expressing who he is and what he stands for.

San Francisco Arts & Athletics, Inc. v. United States Olympic Committee, 483 U.S. 522 (1987) is the case most applicable to the instant one. Like the instant case, *San Francisco Arts & Athletics, Inc.* involved the property right of USOC to control the use of its name, specifically the word "Olympic." In determining that the protection of USOC's name was a significant governmental interest, the Court noted that the protection was justified "to ensure that the USOC receives the benefit of its own efforts so that the USOC will have an incentive to continue to produce a 'quality product' that, in turn, benefits the public." 483 U.S. at 537.

For the third time, the Court made clear that when there is a conflict between constitutionally protected property interests and constitutionally protected speech interests there must be a true balance of the interests. 483 U.S. at 536-37. One thing the Court considered in determining how the balance was to be achieved was that, like the right to publicity recognized under Missouri law, the legislation granting USOC a property interest in the word "Olympic" was directed at protection against appropriation of the word for commercial/promotional purposes, thus giving the limitation on speech embodied in the grant of the property right a commercial speech aura. 483 U.S. at 535. The Court looked to the predominant purpose behind the use of the word "Olympic" by San Francisco Arts & Atheltics, Inc., noting that it was clear that the organization sought to exploit the commercial magnetism of the word given value by USOC. 483 U.S. at 539.

Significantly, the Court recognized that the San

Francisco Arts & Athletics, Inc.'s use of the word "Olympic" in the promotion of its event was expressive in part, but then refused to conclude that the expressive use of the word automatically required the protection of that use under the First Amendment: "The mere fact that the SFAA claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to 'appropriat[e] to itself the harvest of those who have sown.' The USOC's right to prohibit the use of the word 'Olympic' is at the core of its legitimate property right." 483 U.S. at 541.

Taken together, the Court's precedent in this area makes clear that the Missouri Supreme Court is true to the guidelines established by this Court. It applied a true balancing test that seeks to accommodate both the constitutionally protected property interests and the constitutionally protected speech interests that are involved. The Missouri Supreme Court's approach rejects the notion, also rejected by this Court, that the right of free speech is always exalted over property rights when the two come in conflict.

II. .... THERE IS NO CONFLICT BETWEEN THE DECISION OF THE MISSOURI SUPREME COURT BELOW AND OTHER COURTS.

Contrary to Petitioners' assertions, there is no conflict between the Missouri Supreme Court's opinion below and decisions of at least three Circuit Courts and the California and Kentucky courts. The Missouri Supreme Court did not condemn the transformative use test, relatedness test or malice test that Petitioners cite as other approaches used in this area. The Missouri Supreme Court did not outright reject these tests. It did hold that those tests were not useful to achieve the necessary constitutional balance between the competing constitutionally protected interests in what the

court described as "the unusual circumstances of the case at hand." (A-19). In other words, the Missouri Supreme Court recognized that application of the First Amendment in right of publicity cases is fact intensive.

Perhaps more importantly, the Missouri Supreme Court recognized that the transformative use test and relatedness test are merely means to an end. In contrast to those two tests, the court's approach focuses on the end – the fact that the competing constitutional interests are to be balanced. This becomes clear from the court's citation to Mark S. Lee, "Agents of Chaos: Judicial Confusion in Defining the Right of Publicity–Free Speech Interface," 23 LOY. L.A. ENT. L. REV. 471 (2003). (A-14.) As Lee points out, the transformative use and relatedness tests are useful "substantive analytic methodologies" that are available to achieve the ultimate balance that this Court requires:

> Such an approach [the approach applied by the Missouri Supreme Court below] would not be meaningful absent substantive analytic methodologies to help evaluate a particular use, but such methodologies are presently available, and have already been used by many courts. . . . The Restatement's "unrelatedness" test can also help evaluate whether use of an individual's identity in a work of expression is appropriate by helping to assess whether the use was intended to make a genuine comment about or merely to exploit the goodwill of the celebrity. Even the California Supreme Court's "transformativeness" test can help to determine whether the use is primarily exploitative or communicative by encouraging judicial focus on the nature of the use.

23 LOY. L.A. ENT. L. REV. at 500-501. In short, the transformative use test and the relatedness test are

devices for analyzing evidence that will have varying application depending on the fact pattern presented in a particular case.

With respect to this part of Petitioners' argument, it is also worth noting that, while Petitioners claim there is a conflict between Missouri Supreme Court's approach and the relatedness or transformative use tests, Petitioners have no opinion as to which of the methodologies should be applied. All they care is that the Missouri Supreme Court's opinion be reversed since its approach of balancing the competing constitutional interests involved was adverse to Petitioners. Before asking this Court to utilize its precious judicial resources, Petitioners should have, at least, articulated which alleged "conflicting" test they are championing.

The Transformative Use Test

The transformative use test was adopted in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001), *cert. denied* 534 U.S. 1078 (2002). The test was then subsequently applied in *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003). The California court has described the transformative use test in the following words: "Another way of stating the inquiry is whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question." 21 P.3d at 809.

Since the transformative use test and the approach applied by the Missouri Supreme Court are not in conflict, it should come as no surprise that there is language in *Comedy III* which parallels the language of the Missouri Supreme Court: "The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements pre

dominate in the work." *Id.* (emphasis added). Indeed, there is nothing in the description of the test developed by the California court which indicates that once even the smallest expressive element is discovered it is to be accorded First Amendment protection. The court's reference to such phrases as "so transformed," "become primarily," "predominate in the work," and "derive primarily," 21 P.3d at 809-10, does not describe a test which is so absolute in its application.

It is worth noting that the two cases in which the transformative use test has been applied share a common factual situation. Both involved challenges to visual depictions. *Comedy III* (lithographic reproductions of the Three Stooges printed on T-shirts); *Winter* (comic book illustration of worm-like creatures allegedly based on Johnny and Edgar Winter). The transformative use test serves well as an analytic methodology when a visual medium is at issue. A simple side-by-side comparison of the challenged work to the original will answer whether the challenged work is merely a literal depiction or imitation of a celebrity or whether it adds significant expressive content to the original. *See, especially, Winter*, 69 P.3d at 480 ("courts can often resolve the question as a matter of law simply by viewing the work in question and, if necessary, comparing it to an actual likeness of the person or persons portrayed"). Similar to *Zacchini*, the two visual medium cases in which the transformative use test has been applied are easy cases to resolve from a balancing standpoint. They involved facts which made it readily apparent how the constitutional balance should be drawn without any real need to analyze the factors that might tip the scales one way or the other. *Zacchini*, 433 U.S. at 574-75, 97 S.Ct. at 2857 ("Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that

the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent"); *Comedy III*, 21 P.3d 797 (obvious from reviewing the image printed on the T-shirts that they were no more than a literal depiction of the Three Stooges); *Winter*, 69 P.3d 473 (obvious from reviewing the illustration of the half-worm, half-human character in the comic that significant creative content was added and that the image was not a literal depiction or imitation of the Winters).

The Missouri Supreme Court was not dealing with visual images. There has been no contention by anyone that the comic character Tony Twist is meant to portray the real Tony Twist. Indeed, Petitioners go to great pains to drive this point home in their petition. (Petition for Writ of Certiorari at 3.) The Missouri Supreme Court was dealing with the very different factual situation of Todd McFarlane's admitted appropriation of the real Tony Twist's name for a character in *Spawn* and other clear identifications of Tony Twist the hockey player as the namesake of the comic's character in related promotional material. The Missouri Supreme Court's determination could not be resolved so easily as comparing the challenged work to a picture of the real Tony Twist. While the transformative use test might be a valid tool in the context of a case dealing with visual images, the Missouri Supreme Court's approach was neither a rejection of the transformative use test or in conflict with any decision purporting to apply it.

Relatedness Test

The Missouri Supreme Court would have been justified in not applying the relatedness test simply because the relatedness test has not typically been utilized as a test for applying First Amendment standards. Instead, the test defines the parameters of the right of publicity.

See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46 & 47 (1995); *Rogers v. Grimaldi*, 875 F.2d 994, 1004-05 (2d Cir. 1989); *Montgomery v. Montgomery*, 60 S.W.3d 524, 528-29 (Ky. 2001). While these authorities often pay lip service to the First Amendment in their discussion of the underlying elements of the tort, *see, e.g.*, RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47, *comment* c (1995), the fact remains that this test does not purport to be a definitive standard for application of constitutional principles.

The Missouri Supreme Court would also be justified in not applying the relatedness test to the extent those tests are premised on *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Petitioners admit such is the case and the fact is also borne out by the other two relatedness test cases cited by Petitioners. Both of them cite *Rogers* as the principal support for their decisions. *Montgomery v. Montgomery*, 60 S.W.3d 524, 528-29 (Ky. 2001); *Parks v. LaFace Records*, 329 F.3d 437, 461 (6th Cir. 2003). In its discussion of the relatedness test as it applied to the right of publicity, the *Roger's* court stated that is was defining the tort in accordance with state law free speech protections that were broader than those mandated by the federal constitution. 875 F.2d at 1004 (interpretation based on Oregon free speech clause "providing broader protection for free expression than that mandated by the federal Constitution"). *See, also, Id.* at 1005, n.13. The relatedness test fashioned by the *Rogers* court and adopted by the other courts on which Petitioners rely were clearly not fashioning a test based on federal First Amendment protections. Instead, they were fashioning a test that adopted a broader, more protective standard allowed by state law, but not mandated by federal law. Having eschewed such a broad definition of the right of publicity recognized by Missouri law, the Missouri Supreme Court's failure to

apply *Rogers* and its progeny cannot be said to create a conflict with the *Rogers* relatedness test.

Even absent these distinctions, the Missouri Supreme Court's decision is not in conflict with the cases cited by Petitioners. The relatedness test has utility as a substantive analytic methodology for particular fact patterns. It is worth noting that two of the cases deal with the names of celebrities in titles to expressive works. *Rogers, supra*; *Parks, supra*. It is clear from *Rogers* that is was creating a rule for titles: "In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work." 875 F.2d at 999 (emphasis added). Petitioners go too far in attempting to describe this quoted excerpt as stating a rule for expressive works in general. (Petition for Writ of Certiorari at 15.) *Parks* similarly was concerned solely with whether the title of the song related to the underlying work. 329 F.3d at 461. From the standpoint of these two cases and their unique formulation of the relatedness test to titles, there is no conflict between the Missouri Supreme Court's opinion, which does not deal with the relationship of the title to the underlying work, and *Rogers* and *Parks*, which do.

The *Montgomery* case cited by Petitioners was not concerned with whether the use of an assumed celebrity's voice and image in a music video was protected by the First Amendment but with the definition of the right of publicity, the court saying in the ultimate, "We need not determine the correct definition of 'public figure,' because, as a matter of law, neither Harold's voice nor image was appropriated for 'commercial profit' within

the meaning of [the applicable] statute in the music video of John Michael's song 'I Miss You a Little.'" 60 S.W.3d at 528.

The process the Kentucky court used in deriving its statutory construction has significant implications for determining whether the Missouri Supreme Court's opinion on application of the First Amendment to the facts before it is inconsistent with the Kentucky court's definition of its statutory cause of action. The Kentucky statute begins with a simple proposition. If the medium in which the celebrity's name is used is of the type which would normally enjoy First Amendment protection, the use does not come within the statute and there is no right of publicity. 60 S.W.3d at 529 ("Therefore, we have little difficulty in concluding that the music video in question is protected free expression under the U.S. and Kentucky Constitutions. Thus, under the general rule, Barbara's right of publicity claim is not actionable"). However, "[l]ike all rules, an exception exists[.]" *Id.* That exception to the general rule applies if "the use is not sufficiently related to the underlying work, or, if the otherwise constitutionally-protected work is 'simply disguised commercial advertisement for the sale of goods or services.'" *Id.* In defining its cause of action, the Kentucky court narrows the broad general rule of non-inclusion for constitutionally protected mediums when the conditions of the relatedness test are satisfied. *Montgomery* does not purport to lay down a rule or even a methodology for analyzing the breadth or scope of the First Amendment in right of publicity cases.

Malice Standard

In *Zacchini*, the Court flatly rejected any contention Petitioners make that the malice standard of *New York Times v. Sullivan*, 376 U.S. 254 (1964) applies to right of publicity cases or that it is being applied by other

courts in such cases as *Zacchini*. 433 U.S. at 574 & 579. It reiterated that position in *Hustler Magazine v. Falwell*, 485 U.S. 46, 52 (1988). The other cases cited by Petitioners as malice standard cases do not stand for the proposition that the malice standard applies in right of publicity cases, *Hoffman v. Capital Cities*, 255 F.3d 1180 (9th Cir. 2001); *Flipside v. Chicago Tribune*, 564 N.E.2d 1244 (Ill. App. 1991) and *Food Lion v. Capital Cities*, 194 F.3d 505 (4th Cir. 1999), and it is impossible to see how they could do so consistent with *Zacchini* and *Falwell*.

III. ..... THE TEST APPLIED BY THE MISSOURI SUPREME COURT DOES NOT INVOLVE CONSIDERATION OF THE ARTISTIC VALUE OF THE CELEBRITY'S NAME TO THE WORK.

Petitioners misstate the essence of the decision below as permitting a judge to make a determination that "the artistic value of an isolated excerpt from the work is outweighed by its commercial value." (Petition for Writ of Certiorari at 21.) *See, also, Id.* at 7-8, 10, 20, 22. However, nowhere does the Missouri Supreme Court either state that such is the standard or engage in such an exercise in applying the standard to the facts of the case.

The Missouri Supreme Court's approach looks not to artistic merit but to the purpose in using the name and identity of the celebrity. Indeed, as the court's discussion of the weakness of the transformative and relatedness tests shows, the court was concerned that those tests were blind to the purpose of the author in using the celebrity's name in both a work and in related material designed to promote the work. (A-18.) With respect to the transformative use test, the court's criticism of that test was that "[u]nder the transformative test, the transformation or fictionalized characteriza

tion of a person's celebrity status is not actionable even if its sole purpose is the commercial use of that person's name and identity." (A-18; emphasis added.) In its discussion, the Missouri Supreme Court makes clear that it is concerned with the purpose in using another's name – if the work uses a celebrity's name predominantly for the purpose of exploiting the commercial value of that person's name, there should be both a violation of the right of publicity and a lack of First Amendment protection. *Id.* If on the other hand, the predominant purpose of the use of the celebrity's name is to make an expressive comment on or about that celebrity, the work is protected. *Id.*

In its application of the standard to the facts, the Missouri Supreme Court also made clear that it was concerned with purpose in use and not with the artistic contribution of that language. In finding that the purpose behind the use of Tony Twist's name was predominantly commercial, the court did not dwell on esoteric factors of literary or artistic style. It was concerned with the concrete evidentiary facts which showed Todd McFarlane's purpose for using the name in the first place – McFarlane's agreement that the use of Tony Twist's name was not for parody, other expressive comment or as a fictionalized account of Tony Twist; McFarlane's intentional identification of Tony Twist the famous hockey player as the source of Tony Twist the comic book character to the purchasers of his comic books; his promise to his readers that they would continue to see names of hockey players in future issues of *Spawn*; and his direct efforts to market his comic books to hockey fans at hockey games.

In stark contrast to this fact-intensive, purpose based inquiry is the subjective formulation of opinion on artistic contribution which the Petitioners propose be

made. Petitioners would have Missouri courts inquire as to whether allusions to "twist" endings and the use of "goon" and "enforcer" metaphors were artistic in nature and made an artistic contribution to the work. Pet. for Writ of Cert. at 16.

Finally, even if the Missouri Supreme Court's approach is as Petitioners mischaracterize it, the language of the cases applying either the transformative use test or relatedness test show that they themselves require the formulation of subjective opinions about the value or contribution of the celebrity's name in the work. *See, e.g., Comedy III*, 21 P.3d at 809-10 ("Another way of stating the inquiry is whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized")("asking whether the literal and imitative or creative elements predominate in the work")(transformative use test); *Rogers*, 875 F.2d at 999 ("unless the title has no artistic relevance to the work whatsoever, or, if it has some artistic relevance")(relatedness test). One cannot make judgments about the degree of synthesis of raw materials in a work, or about whether an element of the work is creative or imitative, or about whether an aspect of the work has artistic relevance without forming an opinion about the value or contribution of a celebrity's name in the material being considered. Neither of the alternatives proferred by Petitioners puts them or First Amendment analysis in any different or better position than application of what they argue is the flawed approach applied by the Missouri Supreme Court.

IV. ..... THE DECISION BELOW DOES NOT SATISFY THE "FINALITY" REQUIREMENTS OF 28 U.S.C. § 1257.

Petitioners affirmatively raise the question of the Court's jurisdiction under 28 U.S.C. § 1257, on the basis

of *Nike, Inc. v. Kasky*, 123 S.Ct. 2554 (2003)(*per curiam)*. As Petitioners concede, the Court's jurisdiction is limited to final judgments or decrees. 28 U.S.C. § 1257. Petitioners argue that this case comes within the fourth category of non-final judgments as identified in *Cox Broadcasting Corp. v. Cohn*, 420 U.S. 469 (1975). (Petition for Writ of Certiorari at 24.)

In *Cox*, the trial court had granted summary judgment to the plaintiff on the issue of liability, with the question of damages remaining to be tried. *Id.* at 474. As part of that summary judgment, the trial court rejected the defendant's constitutional challenge to the Georgia statute making it unlawful to publicize the name of rape victims in news reports. *Id.* On appeal, the Georgia Supreme Court reached the issue of the statute's constitutionality on rehearing, and determined that the statute passed constitutional muster. *Id.* at 475. Important to the Court's decision that it had jurisdiction under 28 U.S.C. § 1257 was its determination that "[t]he Georgia Supreme Court's judgment is plainly final on the federal issue and is not subject to further review in the state courts." *Id.* at 485 (emphasis added). As the Court realized, the constitutionality of the statute would not be a substantive issue that would be factually litigated in the subsequent proceedings. The two other cases on which the Court relied in *Cox* also possessed this same attribute: the federal issue was not going to be addressed anew in the continued proceedings. *Id.* at 483, *citing Construction Laborers v. Curry*, 371 U.S. 542 (1963), and *Mercantile National Bank v. Langdeau*, 371 U.S. 555 (1963). *See, also, Miami Herald Publishing Co. v. Tornillo*, 418 U.S. 241 (1974).

Petitioners ignore that in this case the Missouri Supreme Court was reviewing two separate actions of the trial court – the issuance of the JNOV and the

contingent grant of a new trial. The JNOV issue involved both the question of submissibility of the right of publicity claim and whether the First Amendment barred that claim under the facts as found at trial. (A-11-19.) In reviewing the submissibility issue, the Missouri Supreme Court considered the evidence in the light most favorable to the plaintiff , giving him all reasonable beneficial inferences. (A-10.) Having found that Tony Twist made a submissible case and that his claim was not barred under the particular facts as found at trial, the Missouri Supreme Court then turned to the contingent grant of a new trial and affirmed the trial court's action in that regard. (A-19-21.) Important for the "finality" issue under 28 U.S.C. § 1257, the reversal of the JNOV does not in any way preclude the litigation of Petitioners' affirmative defenses in the continued proceeding. The First Amendment federal issue that Petitioners ask this Court to review will be subject to further review in the new trial on the matter. Unlike *Cox*, *supra*, but like *Nike*, *supra*, the federal issue is subject to consideration *de novo* in the continued proceedings and to development of a set of facts applicable to the federal issue unique to those new proceedings. To paraphrase *Nike*, 123 S.Ct. at 2556 (Stevens, J, concurring), the resolution of the federal issue will be affected by the further proceedings because the federal issue must be analyzed in light of the facts developed during those proceedings. The case is not final under 28 U.S.C. § 1257.

CONCLUSION

Petitioners raise the specter of a number of dire consequences which will occur if the Court does not grant certiorari. The Petitioners argue that the exercise of protected speech will be chilled by the Missouri Supreme Court's opinion because that decision allows

judges to make subjective opinions about the literary value that a celebrity's name adds to a work. However, the Missouri Supreme Court does not require such an analysis. Petitioners predict that musicians, authors and movie producers will have to scrub their products of celebrity names when marketing their products in Missouri because of the restrictive view given First Amendment protections by the court below. However, the Missouri Supreme Court's opinion is not inconsistent with the transformative and relatedness tests applied to totally different factual patterns and, more importantly, it is consistent with this Court's precedent in the area. Stephen King does not have to fear Tom Gordon; Simon and Garfunkel do not have to fear Joe Dimaggio; Kim Carnes does not have to fear Bette Davis; and the makers of the film "Searching for Bobby Fischer" do not have to fear Bobby Fischer, in Missouri. Finally, Petitioners foresee that celebrities will flock to Missouri courts to press their right of publicity claims, again because of what Petitioners characterize as a less First Amendment-friendly attitude here than elsewhere. However, Missouri is not more tolerant of the right of publicity in light of First Amendment protections than any other jurisdiction considering the issue. There is no reason to believe that Missouri will become a safe haven for celebrities wanting to protect their names and identities from appropriation by others. When stripped of all of its hyperbole, Petitioners' *in terrorem* argument states no cause for review by the Court.

The petition for writ of certiorari should be denied.

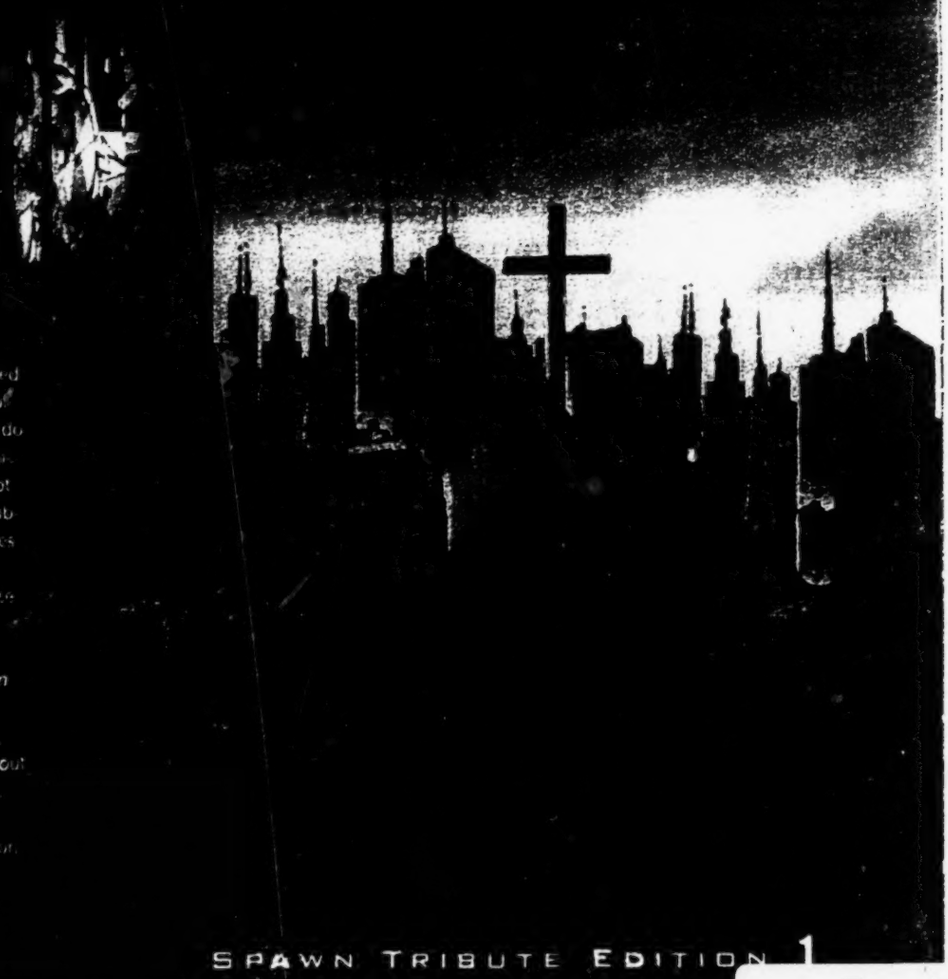
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WIZARD SPAWN TRIBUTE



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SPAWN TRIBUTE EDITION 1

SPAWNING GROUND

BY SCOTT BEATTY

A look at the real-life people Spawn characters are based upon

Having trouble coming up with character names? Use the Todd McFarlane Method.

McFarlane uses the names of his family and friends when it comes to the character identities inside his comic book *Spawn*.

"It's easier to come up with the names of people sitting next to you," the writer/artist explains. "And for the most part, if I don't put my friends and family in my books, I guarantee that nobody at Marvel is going to do it for me. I do it just because I can. I've got that freedom. It's one of the great things about controlling your own book."

Named for loved ones, friends, colleagues and employees at Todd McFarlane Productions, a few of the characters appearing in *Spawn* feature similarities to their real-life counterparts. Many others appropriate only the name, sometimes being introduced and dispatched in the same issue. The following is a collection of the most notable players, as well as some interesting cameos:



AL SIMMONS/SPAWN

First Appearance: *Spawn* #1
Real-Life Persona: Al Simmons
Relation: Todd McFarlane's old roomie

The real Al Simmons played PAC 10 baseball and roomed with McFarlane while the pair attended college at Eastern Washington University. After his namesake gained fame in the pages of *Spawn*, Al quit his day job and went to work full time for Todd McFarlane Productions. As McFarlane recalls, Simmons approached him and said, "I'd like to go around the country dressed as Al Simmons...and be Spawn." Who could portray Spawn better than the real Al Simmons? Now a regular feature on the comic convention circuit, Simmons attends 15 to 20 shows a year dressed in Spawn's trademarked togs, signing autographs and appearing with the souped-up Spawnmobile dragster. Between public appearances, Simmons takes the costume off and spends his time as head of productions and marketing for TMP.



WANDA BLAKE

First Appearance: *Spawn* #1 (First Named: *Spawn* #3)
Real-Life Persona: Wanda Kolomyjec
Relation: McFarlane's wife

Todd McFarlane's junior-high sweetheart Wanda Kolomyjec became his wife in 1985 and helped launch *Spawn* as the title's first editor. Together for 18 years now, McFarlane reveals that the caring, charitable nature of Wanda Blake is very much apparent in his own significant other and soulmate. "He loves his Wanda and I love my Wanda," says McFarlane of Spawn. "Wanda is really the sole reason for Spawn's existence. He didn't make the deal with the Malebolgia for revenge. He came back because he wanted to see his wife. The similarity is drawn to my wife. I'd trade anything to save my wife's life or to prolong being together."

Resp. A.2

TERRY FITZGERALD

First Appearance: *Spawn* #3
Real-Life Persona: Terry Fitzgerald
Relation: TMP's Director of Creative Development

"The real Terry is some little white guy who could stand to lose a few pounds, so he's not as svelte and good-looking as the fake Terry Fitzgerald," McFarlane jokes. Spawn's former best friend in the comic takes his appellation from the person McFarlane considers his "right-hand man" at TMP. Director of Creative Development Terry Fitzgerald has been with McFarlane since his days on Marvel's *Spider-Man*. From a humble beginning doing comics' grunt work with McFarlane in Vancouver, British Columbia, Fitzgerald has risen the ladder of success, becoming an invaluable asset to TMP and handling much of the major licensing for Spawn. "If I don't have the answer, Terry does. And in many cases," McFarlane admits, "Terry has more answers."



CYAN FITZGERALD

First Appearance: *Spawn* #3 (First Named: *Spawn* #6)
Real-Life Persona: Cyan McFarlane
Relation: McFarlane's daughter

The uniquely named daughter of Terry Fitzgerald and Wanda Blake is the comic book counterpart of Cyan McFarlane, the daughter of Todd McFarlane and Wanda Kolomyjec. And as McFarlane reveals, despite some people's difficulty in pronouncing "Cyan" (si-an), the name has special meaning. "It's a primary color of blue in printing," he says. "Given that my dad has been in the printing business his entire career, and that's what I was going to go into if I didn't break into comics, we thought it was a cool name. That people have trouble even saying the word is really perplexing to me."







DETECTIVE SAM BURKE

First Appearance: *Spawn* #1
Real-Life Persona: Paul Burke
Relation: President of McFarlane Toys

McFarlane admits that the Oliver Hardy of police detectives is a hybrid in terms of naming, borrowing the surname only. Paul Burke, whose last name McFarlane used for the jelly doughnut-noshing detective, is actually the president of McFarlane Toys. "They don't have any similarities other than liking to do a little bit of smoking," reveals McFarlane.

"TWITCH" WILLIAMS

First Appearance: *Spawn* #1
Real-Life Persona: Pam Williams
Relation: Wanda Kolomyjec's best friend

As with Sam Burke, "Twitch" Williams takes only his last name from a real person, although the first name of Burke's sharpshooting partner has yet to be divulged. The surname comes from Pam Williams, a friend of Wanda Kolomyjec. McFarlane is quick to point out that Pam Williams' entire name appears in *Spawn* #42, where her more-apparent counterpart is the young girl with the crush on comic book collector Pat Shaunessy. (Shaunessy just happens to be named for the owner of Golden Age Collectibles, McFarlane's old comic shop haunt in Vancouver.)





ANTHONY "TONY TWIST" TWISTELLI

First Appearance: *Spawn* #6
Real-Life Persona: Tony Twist
Relation: NHL St. Louis Blues right winger

The Motley Crue that has made life exceedingly rough for Al Simmons and his loved ones, in addition to putting out an ill-advised contract on Tim Vickers, is named for former Quebec Nordiques hockey player Tony Twist, now a renowned enforcer (i.e., "goon") for the St. Louis Blues of the National Hockey League.





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v.

ANTHONY R. "TONY" TWIST,
Respondent.

On Petition for a Writ of Certiorari
To The Supreme Court of Missouri

REPLY BRIEF FOR THE PETITIONERS

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REPLY BRIEF FOR THE PETITIONERS

I. Respondent Distorts First Amendment Principles And This Court's Precedents In His Attempt To Defend The Decision Below.

This Court has consistently fashioned comprehensible doctrines to insure a measure of certainty and predictability for all parties when it formulates standards to accommodate interests pressing on First Amendment freedoms. For example, when this Court recognized the important First Amendment concerns implicated by the common law of defamation, it did not respond with a vague invitation to engage in unrestrained balancing of competing interests. Instead, *New York Times v. Sullivan*, 376 U.S. 254 (1964), and its progeny fashioned a set of rules that confines such varying judgments and thereby enables publishers and litigants to limit the range of their uncertainty.

Here, however, the Missouri court rejected the two prevailing standards for reconciling the tension between the right of publicity and First Amendment principles and instead announced an inherently vague and unpredictable balancing approach that leaves the First Amendment—and the authors and publishers who rely upon its protection—subject to the individual artistic tastes of judges and juries. As the *Amici* cogently explain in their brief, the "predominant use" test jeopardizes artistic freedom throughout the country.

In response, Respondent parades *Zacchini* throughout his brief as if that case had any meaningful relevance here. In fact, the property at issue in *Zacchini* was plaintiff's livelihood—a human cannonball act—broadcast by the defendant in its entirety, without the plaintiff's consent. The broadcaster's action was more akin to a copyright violation in which the copier pub-

lished the owner's work in its entirety. Here, Petitioners used only Respondent's name, and only in a fictionalized setting that, as the court below confirmed, did not defame him. As the *Amici* illustrate with a wealth of examples, such fictionalized use of well-known persons' names has been a common practice for as long as there has been fiction.[1]

Respondent urges on this Court the same misconstruction of the expressive-commercial balance that misled the court below. As for the expressive part of the balance, Respondent fails to grasp that a work and its elements are "expressive" regardless of whether the work is deemed to be high art. Any writing designed to delight, amuse, titillate, distract, instruct, or inspire is expressive—whether written for groundlings or box seats, whether as a comic book or a grand opera. If a name chosen by the author has a certain "music" and a certain resonance with ideas, names, and persons with

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[1] Respondent's invocations of *San Francisco Arts and Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522 (1987), and *Lloyd Corp. v. Tanner*, 407 U.S. 551 (1972), are even more unavailing. The *Olympic Committee* case involved the misappropriation of the Committee's *trademarked* name for its product as the product name for an unlicensed, unaffiliated entity's own product. Neither product was an expressive work. More to the point would be a film or a story about the defendant's athletic contest, which used in the text of the story the phrase "gay Olympics." Surely there could have been no injunction against such terminology in an expressive work. Indeed it is doubtful that the United States Olympic Committee could have complained if a book about the defendant's event had been titled "San Francisco's Gay 'Olympics.'" The reference to *Lloyd v. Tanner* is even more farfetched. In that case, the Court said that speakers had no more right to speak and leaflet on private property than they did in a person's living room. To be sure, both cases present conflicts between property rights and First Amendment liberties, but to take the conflict at such a high level of abstraction sheds no light on this specific issue—or any other.

which the audience may be familiar, that is enough to make that use expressive. One need only look to *Amici*'s example of Yogi Bear to grasp that point.

As for the "commercial" side of the balance, this Court's precedents reject a rule of law that would make an expressive work "commercial" if one or more of its elements have been chosen to help it sell. *E.g., Harte-Hanks Communications, Inc. v. Connaughton*, 491 U.S. 657, 667 (1989). As Dr. Samuel Johnson famously remarked, "No man but a blockhead ever wrote, except for money." James Boswell, LIFE OF JOHNSON 641 (Everyman's Library 1993). So long as the expressive use of a public figure's name carries no implication of endorsement, the fact that its use in a work of fiction may make the work sell better does not convert that work into a commercial one.

Respondent creates additional confusion through his failure to distinguish between (a) the use of a public figure's name in an expressive work that may sell more issues because of the resonance that the use gives to that work, and (b) the use of a public figure's name to advertise a product, *e.g.*, a celebrity endorsement. Is the fictional mobster Tony Twist to be understood as depicting the real life of Respondent? Of course not, and neither Respondent nor the court below contends otherwise. But is there nevertheless a correlation between the fictional character and Respondent? As the court below stated, the "unmistakable correlation between Twist the hockey player and Twist the Mafia don that, when coupled with Twist's fame as a NHL star, conclusively establishes that [Petitioners] used his name and identity." (Pet. App 10-11.) But precisely the same might be said about the cartoon character Yogi Bear and the baseball celebrity Yogi Berra, or any of the myriad other examples offered by *Amici*. The mere fact

of that correlation—even when it is "unmistakable"—does not transform a protected work of expression into an unprotected advertisement.

II. Respondent Attempts To Deny What Even the Court Below Readily Admitted, Namely, That Its Decision Creates A Deep Conflict Among the Nation's Courts.

Respondent tries to explain away the conflict among the lower courts by contending that the two extant rules—namely, the "relatedness" test enunciated by the Restatement (Third) of Unfair Competition (and most recently adopted by the Sixth Circuit in *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir.), *petition for cert. filed*, 72 U.S.L.W. 3269 (U.S. Sept. 30, 2003) (No. 03-504)), and the "transformative" test adopted by the California Supreme Court (most recently in *Winter v. DC Comics*, 69 P.3d 473, 477-78 (Cal. 2003))—are but two particular iterations of the Missouri court's more general balancing approach. (Brief in Opp. at 12-13.) We understand that it is a staple of Briefs in Opposition to deny the existence of any conflicts, just as it is of Petitions for Certiorari to claim them. If there would be any doubt as to the existence of the conflict, we suggest that the Supreme Court of Missouri should be heard on the issue:

> The weakness of the Restatement's "relatedness" test and California's "transformative" test is that they give too little consideration to the fact that many uses of a person's name and identity have both expressive and commercial components.... Though these tests purport to balance the prospective interests involved, there is no balancing at all—once the use is determined to be expressive, it is protected.

(Pet. App. A-18)

Indeed, the very court decisions Respondent seeks to harmonize expose the hollowness of his argument. Even the Missouri Supreme Court acknowledged that the *Winter* case was "a case with a remarkably similar fact situation." (Pet. App. at A-17.) Yet application of the "transformative" test produced a result opposite to that reached by the Missouri court. *Winter v. DC Comics*, 69 P.3d. at 477-78. As for the "relatedness" test—first adopted by the Second Circuit and most recently adopted by the Sixth Circuit—the Missouri court rejected it because under that test "use of a person's name and identity is actionable only when the use is solely commercial and is otherwise unrelated to that person." (Pet. App. at A-18.)[2]

III. This Case Is Ripe For Review Under The *Cox Broadcasting* Test.

Petitioners' federal defense throughout these proceedings has been that their use of the name "Tony Twist" is protected expression under the First Amendment. The court below applied its anomalous new balancing test to the trial record and rejected that defense, holding that "free speech must give way to the right of publicity." (Pet. App. A-19.) Respondent's attempt to argue around the finality rule in *Cox Broadcasting Corp. v. Cohn*, 420 U.S. 469 (1975), appears to be premised on a misunderstanding of the "intent" issue on which the court below relied in granting a new trial. As the Missouri court held:

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[2] Respondent makes the irrelevant point that Petitioners do not here embrace one or the other of the extant conflicting standards. Brief in Opp. at 14. That choice, however, is a question for the briefing on the merits and ultimately for this Court. At this stage it is sufficient to demonstrate the manifest conflict between those extant standards and the one proposed by the court below.

> Because the verdict director allowed the jury to render a verdict for plaintiff without a finding that [Petitioners] *intended* to obtain a commercial advantage, and because the jury may well have determined that [Petitioners] obtained a commercial advantage even though they did not intend to do so, the verdict must be set aside.

(Pet. App. A-21.)

Accordingly, the intent at issue in that holding was *not* a constitutional "actual malice" intent of the *New York Times v. Sullivan* variety but a garden-variety common law intent under the third element of the tort, namely, use of the name "with the intent to obtain a commercial advantage." (Pet. App. at A-20.) Indeed, the opinion below does not even address the intent element until *after* applying its "predominant use" test and concluding that "free speech must give way to the right of publicity."

Quite simply, Petitioners' First Amendment defense is premised upon the principle that they have a right to use the name "Tony Twist" in a non-defamatory, expressive manner even if they obtain a "commercial advantage" from that use *and* even if they *intended* to obtain it. The Missouri court has rejected that defense under a new First Amendment test that conflicts with the established ones. There is thus no reason to force Petitioners to endure the time and expense of another multi-week trial—plus the crippling prospect of another $24.5 million verdict—when the dispositive federal rule has already been finally and erroneously determined against them. As the Supreme Court of California ruled in the context of California law in the almost identical *Winter* case, *supra*, because "unnecessarily protracted litigation would have a chilling effect upon the exercise of First Amendment rights, speedy resolution of cases involving

free speech is desirable." 69 P.3d. at 480 (internal quotes and quoted case omitted).

CONCLUSION

The petition for certiorari should be granted.

Respectfully submitted,

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Petitioners,

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Respondent.

On Petition for Writ of Certiorari to the Missouri Supreme Court

BRIEF OF *AMICI CURIAE* WRITERS MICHAEL CRICHTON, LARRY DAVID, JEREMIAH HEALY, ELMORE LEONARD, HARRY SHEARER, RON SHELTON, SCOTT TUROW, PAUL WEITZ, AND THE AUTHORS GUILD, INC. IN SUPPORT OF PETITIONERS

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INTEREST OF *AMICI CURIAE*[1]

The *amici* joining in this brief are individual writers and a guild representing professional writers, all of whom have a direct interest in the legal rules governing literary and artistic expression.

Michael Crichton is the author of over a dozen novels, including *Jurassic Park*, *The Andromeda Strain*, and *Timeline*, as well as the screenplays for *Westworld* and *Twister*. His novel *A Case of Need*, published under the pseudonym Jeffrey Hudson, won the Edgar Award from the Mystery Writers of America in 1968. He is also the creator, executive producer, and sometime writer of *E.R.*; he received the Writers Guild of America award for that show's pilot. Crichton is likely one of

[1] No counsel for a party authored this brief in whole or in part, nor did any person or entity, other than *amici* or their counsel, make a monetary contribution to the preparation or submission of this brief.

the very few *amici* to appear before this Court who has had a dinosaur named after him, *Bienosaurus crichtoni* (2000).

Larry David is the co-creator and co-writer of *Seinfeld*, and the creator and writer of *Curb Your Enthusiasm*.

Jeremiah Healy, who also writes under the name Terry Devane, is the author of over 15 detective novels, including *Staked Goat*, which won the 1987 Shamus Award from the Private Eye Writers of America.

Elmore Leonard is the author of over 35 novels, including *Be Cool*, *Get Shorty*, *Rum Punch*, and *Out of Sight*. He was awarded the Grand Master award by the Mystery Writers of America in 1992; his novel *LaBrava* received the Edgar Award in 1984.

Harry Shearer co-wrote and starred in *This Is Spinal Tap*, and is the creator of *Le Show*, a nationally syndicated public radio political satire program that is now in its 19th year. He was a writer and performer on *Saturday Night Live*, and is the voice of Mr. Burns, Flanders, Principal Skinner, Reverend Lovejoy, and others on *The Simpsons*.

Ron Shelton has written a dozen movies, including *Bull Durham*, *Blaze*, and *White Men Can't Jump*, all three of which he also directed. His *Bull Durham* screenplay was nominated for an Academy Award, and won awards from the Writers Guild of America and the National Society of Film Critics.

Scott Turow is the author of the novels *Presumed Innocent*, *Burden of Proof*, *Pleading Guilty*, *The Laws of Our Fathers*, *Personal Injuries*, and *Reversible Errors*, as well as the non-fiction books *One L* and *Ultimate Punishment: A Lawyer's Reflections on Dealing with the Death Penalty*. *Reversible Errors* was just awarded this year's Heartland Prize in Fiction by the *Chicago Tribune*. He is also a partner at Sonnenschein Nath & Rosenthal.

Paul Weitz is the co-writer of various movies, including *About a Boy* and *Antz*, and the co-director of several movies, including *American Pie*.

The Authors Guild, Inc., founded in 1912, is the nation's oldest and largest organization of professional authors. The Guild is a nonprofit membership association of more than 8,400 published book and periodical writers of all genres.[2]

The *amici* hope that they can help provide a perspective on why the decision below harms writers and readers.

STATEMENT

Petitioner Todd McFarlane was sued for allegedly violating respondent's right of publicity because petitioner had used respondent's name—Tony Twist—as the name of a fictional character in a comic book. The Missouri Supreme Court rejected petitioner's First Amendment defense, holding that because the use of respondent's name "was not a parody or other expressive comment or a fictionalized account of the real Twist,"

> the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value. On the record here, the use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.

Doe v. *TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003). (reproduced at Pet. App. 19a).

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[2] The Authors Guild, Inc. has no parent corporation and no publicly held company owns 10% or more of the Guild's stock.

SUMMARY OF ARGUMENT

The First Amendment fully protects writers' choices to name characters after famous figures. Authors such as Aldous Huxley, Robert A. Heinlein, Paul Simon, and Steve Martin have all done this, for many reasons: historical or literary allusion, absurdist humor, homage, and more. These are eminently legitimate literary decisions, as other court decisions (with which this decision creates a split) have recognized. So long as the use is clearly fictional, and thus conveys no false statements of fact, it must remain constitutionally protected.

The Missouri Supreme Court reasoned otherwise, concluding that in this case "the metaphorical reference to [plaintiff], though a literary device, has very little literary value compared to its commercial value." Pet. App. 19a. But First Amendment law does not allow judges and juries to compare the relative weight of the literary and commercial value of a discrete passage or reference in a work. Such a subjective and indeterminate test leaves writers with little guidance about when they may use a particular literary device—which is one reason why First Amendment law generally protects speech, including entertainment, with no regard for a judge's or jury's assessment of its "literary value."

The one narrow, carefully bounded field where judges and juries do inquire into the literary value of works is obscenity law. But even there, this Court has repeatedly stressed that a work is protected so long as it has value when *taken as a whole*. And once such value is found in the work as a whole, there is no subsequent balancing of the value of discrete snippets of the work against the presumed commercial value of those snippets. The Missouri Supreme Court would allow damage awards based on a judge's or jury's decision that a *single literary device* within an otherwise valuable work lacks literary value—the very approach that has been rejected even for obscenity.

Finally, the Missouri Supreme Court tried to distinguish speech made "with the intent to obtain a commercial advantage"—speech that is "predominantly a ploy to sell comic books"—from "artistic or literary expression." Pet. App. 19a. That, though, is inconsistent with this Court's precedents, which hold that speech is protected even if it is motivated by profit. It is also inconsistent with the premises of our copyright law, which tries to foster "artistic or literary expression" precisely by harnessing the human impulse to try to "obtain a commercial advantage."

And it is inconsistent with the nature of our economic system generally, and of the book and movie business specifically. In America, writers make money by creating artistic or literary expression; and their making money makes it possible for them to create still more such expression. The motivations cannot be disentangled, and courts cannot decide which of them "predomina[tes]."

ARGUMENT

I. The Missouri Supreme Court's Decision Violates Authors' Free Speech Rights.

Authors routinely use the names of famous figures—politicians, athletes, scientists, and others—in their fiction. Sometimes writers include those people as characters, as in the movies *Forrest Gump* (Paramount 1994) and *Zelig* (Orion 1983), or in Steve Martin's play *Picasso at the Lapin Agile* (1996) (which has as its lead characters Pablo Picasso and Albert Einstein). Sometimes writers just refer to those people in passing, or name characters after them. *See, e.g.*, the cartoon character Yogi Bear; Aldous Huxley, *Brave New World* (1932) (featuring the characters Bernard Marx, Lenina Crowne, and Benito Hoover, which allude to Karl Marx, Vladimir Lenin, Benito Mussolini, and Herbert Hoover); Federico Fellini's film *Ginger & Fred* (MGM/UA 1986) (fea-

turing characters who were nicknamed after Ginger Rogers and Fred Astaire, discussed in *Rogers* v. *Grimaldi*, 875 F.2d 994 (CA2 1989)); Paul Simon, *Mrs. Robinson* (1968) (referring to Joe DiMaggio); Maria Testa, *Becoming Joe DiMaggio* (2002) (a poem collection in which a recurring theme is a child's dream of becoming Joe DiMaggio).

This is a widespread and perfectly legitimate practice, and part of an author's constitutionally protected freedom of speech. Authors' works, even fantastic ones, are based on the real world. Famous people, not just events and ideas, are part of that world—and important events and ideas are often defined or exemplified by famous people. The names and personalities of famous people are a proper part of the author's palette.

The decision below jeopardizes that artistic freedom. Under the Missouri Supreme Court's reasoning, authors are no longer free to include a famous person's name in a novel, screenplay, or other work, if a jury finds that the name was used "with the intent to obtain a commercial advantage." Pet. App. 20a. If authors do write their works as they wish, they might be subjected to a $24.5 million verdict. (Though the Missouri Supreme Court upheld the reversal of the verdict, the court made clear that if the comic book author used the name with the intention of commercial advantage, he would be liable.) And because expressive works are distributed throughout the country, the Missouri Supreme Court's decision potentially affects any work created by authors in any State.

The only sure way of avoiding liability is to obtain the famous person's permission, or the permission of a dead person's heirs or assignees, if they can be identified and tracked down.[3] That permission, though, may not be given, or the

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[3] The right of publicity in some states endures for 50, 70, 75, or 100 years past the death of the celebrity. *See, e.g.*, Cal. Civ. Code § 3344.1 (2003) (70 years); Ky. Rev. Stat. § 391.170 (2002) (50 years); Nev. Rev. Stat.

famous person may insist that the author change the work to be more flattering. Freedom of speech that requires another's permission is not freedom.

Other courts that have faced the same issue have correctly held that authors *do* have the constitutional right to use others' names in their commercially distributed works (so long as they do not commit defamation or false light invasion of privacy by making constitutionally unprotected false statements of fact, something that is not an issue in this case). *Winter* v. *D.C. Comics*, 69 P.3d 473 (Cal. 2003); *Rogers* v. *Grimaldi,* 875 F.2d 994 (CA2 1989).

But the court below specifically stated that it was disagreeing with *Winter* and with the *Restatement (Third) of Unfair Competition* approach, with which *Winter* and *Rogers* are consistent. Pet. App. 17a-19a. Only a prompt decision from this Court can resolve the split of authority, and, we hope, restore authors' First Amendment rights to their traditionally recognized breadth.

II. The Decision's Purported Limiting Principles Rest on a Misunderstanding of the Writing Process.

The Missouri Supreme Court offered two possible boundaries for its ruling rejecting the writer's First Amendment defense: (A) The ruling applies only to "reference[s]" that have "very little value compared to [their] commercial value," because the reference is "not a parody or other expressive comment or a fictionalized account." (B) The ruling applies only when the use of a name "has become predominantly a ploy to sell" works, as opposed to "an artistic or literary expression." Pet. App. 19a.

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§ 597.790 (2003) (50 years); 12 Okla. Stat. Ann. § 1448 (2003) (100 years); Tex. Prop. Code Ann. § 26.012(d) (2003) (50 years); Rev. Code Wash. Ann. § 63.60.040 (2003) (75 years).

Those limiting principles, though, are inadequate: Even with them, the Missouri Supreme Court's decision unconstitutionally restricts authors' artistic freedom, and conflicts with the decisions of the California Supreme Court and the Second Circuit.

A. The Unsoundness of Comparing "Literary Value" to Commercial Value.

To begin with, the court below erred in concluding that references to famous people "have very little literary value" when the references are not "parody," "expressive comment," or "a fictionalized account" of the person's real life. *Id.* The court's view rests on a misunderstanding of the value that character names and other allusions bring to a literary work.

Sometimes, references to real people in a work are parodies or expressive comments. But sometimes the work includes a real person as a minor character, without any intention of parodying him, commenting on him, or providing an account of his life, as when Forrest Gump is shown meeting Bob Hope, John Lennon, Lyndon Johnson, and others.

Sometimes the work does not include a person as a character, but rather names a character after a real person, as an element of absurdist humor—consider the cartoon character Yogi Bear, or Placido Flamingo, the opera-singing bird on *Sesame Street.* Sometimes the name ties a character to an era, for instance when a character born in the Philippines during World War II is given "Douglas McArthur" as his first and middle names, or a character born in the U.S. during the 1916 election is likewise named "Woodrow Wilson." *See* Neal Stephenson, *Cryptonomicon* (1999) (the Douglas McArthur Shaftoe character); Robert A. Heinlein, *Time Enough for Love* (1973) (the Woodrow Wilson Smith character, better known as Lazarus Long).

Sometimes the reference to a famous person's name expresses another character's personality, for instance when the cartoon boy genius Jimmy Neutron (whose full name is James

Isaac Neutron) names his dog Goddard, alluding to the rocketry pioneer. *The Adventures of Jimmy Neutron, Boy Genius* (Nickelodeon 1999). Sometimes such a reference reflects an author's conjecture about which current figures will be remembered in the future, as when Robert A. Heinlein's *Starship Troopers* (1959) is largely set on the spaceship *Rodger Young*; the novel makes clear that the spaceship was named after a World War II hero of the same name.

Sometimes the naming of a character affects people's reactions to the character, as in the movie *Office Space* (Twentieth Century Fox 1999), where one of the recurring jokes is a character's annoyance at the effect his name—Michael Bolton—has on people. Sometimes the use of a famous person's name links a fictional story to real events or real people, whether humorously or otherwise. *See, e.g.*, Aldous Huxley, *Brave New World* (1932) (featuring Bernard Marx, Lenina Crowne, and Benito Hoover); the movie *Major League* (Paramount 1989) (featuring a baseball-playing character, played by Wesley Snipes, named Willie Mays Hayes); Larry Niven & David Gerrold, *The Flying Sorcerers* (1971) (featuring alien bicycle inventors named Wilville and Orbur, references to Wilbur and Orville Wright, who were bicycle-makers before they became airplane inventors).

Sometimes the use of a name is an homage to a famous person, though an homage that might not have been cleared with the person (or his heirs). *See, e.g.*, Larry Niven & Jerry Pournelle, *Footfall* (1987) (featuring a science fiction writer named Robert Anson and his wife Virginia, an allusion to science fiction great Robert Anson Heinlein and his wife Virginia); Goddard the dog in *Jimmy Neutron*; the spaceship Rodger Young in *Starship Troopers*.

And sometimes it gives listeners the pleasure of recognizing the allusion. For instance, the character Nute Gunray in *Star Wars*: *The Phantom Menace* (Twentieth Century Fox 1999), the monster Ebersisk in the movie *Willow* (MGM/UA 1988), the characters Mayor Ebert and his assistant Gene in

Godzilla (Columbia TriStar 1998), and the character Samuel Beckett on the TV show *Quantum Leap* are not really criticisms, parodies, or fictionalized accounts of Newt Gingrich, Ronald Reagan, Gene Siskel, Roger Ebert, or Samuel Beckett. They are just amusing references, though ones that contribute to the overall literary value of a work. Yet all these uses are just as much a traditional part of a writer's legitimate expression as are parodies, commentary, and fictionalized accounts.

The Missouri Supreme Court would presumably leave it to jurors to decide whether each of these references nonetheless has "very little literary value" as compared to the supposed commercial value of the references, and thus loses First Amendment protection. But that approach is fundamentally misguided. Different people have different views of which literary devices have literary value and how such literary value might compare to the devices' commercial value. How is an author to know whether jurors will find a metaphor, allusion, or character trait to have "very little literary value" (leading, perhaps, to a $24.5 million judgment)? And how will authors know which aspects of a work will capture the public's interest in a way that translates into commercial value in excess of the literary value of author's choice? The risk of liability may pressure authors and publishers to avoid any references—even supposedly "valuable" and nondefamatory ones—to real people.

Moreover, hard as it is to determine the literary value of a *work*, determining the literary value of a particular item within the work is even harder. We can all agree that, for instance, Charles Dickens's *The Christmas Carol* has substantial literary value; but how can one decide whether the character names (Ebenezer Scrooge, Tiny Tim, Jacob Marley) and the "literary devices" they embody (such as the alliteration in Tiny Tim, the forbidding-sounding Ebenezer, and so on) have "very little literary value" or "quite a bit of literary value"? Such devices are not intended to be valuable themselves, in the abstract, and readers, judges, and jurors are not used to

evaluating them in the abstract. Rather, the devices are intended to be contributions that help create part of a valuable whole.

That is why the one First Amendment doctrine that does rely on "literary value"—obscenity law, which has been upheld partly because of a historical pedigree that the right of publicity (especially as applied to characters in a literary work) does not share—instructs judges and juries to focus not on "isolated excerpt[s]," but on the work "taken as a whole." This Court has repeatedly stressed that requirement. *See, e.g., Miller* v. *California*, 413 U.S. 15, 24 (1973); *Manuel Enters.* v. *Day*, 370 U.S. 478, 487 (1962) (stating that the Court has "rejected the 'isolated excerpt'" test of obscenity); *Brockett* v. *Spokane Arcades, Inc.*, 472 U.S. 491, 501 n. 11 (1985) (likewise). And yet the Missouri Supreme Court's decision flouts even that basic principle, by focusing not on the value of a work or even an individual scene in a work, but rather of individual "literary devices."

Even words, images, and sounds that are not supposed to have any "particularized message"—such as Lewis Carroll's *Jabberwocky*, Jackson Pollock's paintings, and Arnold Schoenberg's music—are "unquestionably shielded" by the First Amendment. *Hurley* v. *Irish-American Gay, Lesbian & Bisexual Group of Boston*, 515 U.S. 557, 569 (1995). Even profanity is constitutionally protected, because of the Court's recognition that "forbid[ding] particular words" "also run[s] a substantial risk of suppressing ideas in the process." *Cohen* v. *California*, 403 U.S. 15, 26 (1971). Surely the "literary devices" that the Missouri Supreme Court dismisses in its opinion are at least as entitled to protection.

B. The Unsoundness of the Supposed Distinction Between Speech Said with an "Intent To Obtain a Commercial Advantage" and "Artistic or Literary Expression."

The Missouri Supreme Court's approach also relies on a fundamentally unsound distinction between (a) speech that is said "with the intent to obtain a commercial advantage"—speech that is "predominantly a ploy to sell comic books"—and (b) "artistic or literary expression." Pet. App. 19a.

Most successful creators intend *both* to obtain a commercial advantage *and* to express themselves. By expressing yourself in a way that readers want to read, you make money. By making money, you get the free time needed to express yourself. The prospect of making more money gives you an incentive to produce more works, and to make your works better.

That is a basic aspect of the free market, where, in Adam Smith's words, a producer "promotes the public interest" even while "intend[ing] only his own gain"; "by pursuing his own interest he frequently promotes that of the society more effectually than when he really intends to promote [the societal interest]."[4] And it is also the view embodied in the Constitution's Copyright and Patent Clause. "'[T]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas.'" *Eldred* v. *Ashcroft*, 537 U.S. 186, 219 (2003) (quoting *Harper & Row* v. *Nation Enterps.*, 471 U.S. 539, 558 (1985)). Just as, in Abraham Lincoln's words, "the patent system add[s] the fuel of interest to the fire of gen-

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[4] Adam Smith, *An Inquiry into the Nature and Causes of the Wealth of Nations* 456 (Roy Hutcheson Campbell, *et al.*, eds., Liberty Fund Glasgow 1981) (1776).

ius,"[5] so does copyright law. Those two intentions, commercial advantage and literary expression, thus cannot be separated, and one cannot tell which of them "predomina[tes]."

But even if it were possible to decide which works are motivated more by "commercial advantage" and which more by a desire to "express[]" oneself, a work should be protected regardless of its profit motive. *See, e.g.*, *Time, Inc.* v. *Hill*, 385 U.S. 374, 396-97 (1967) ("The requirement that the jury [in a false light invasion of privacy case] also find that the article was published 'for trade purposes,' as defined in the charge, cannot save the charge from constitutional infirmity. 'That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment.'") (citing *Joseph Burstyn, Inc.* v. *Wilson*, 343 U.S. 495, 501-02 (1952)). Analogously, as this Court held in *Garrison* v. *Louisiana*, the value of speech is not diminished by the speaker's motivation, even if the motivation is one of hatred: Even those who "speak out of hatred * * * contribute to the free interchange of ideas." 379 U.S. 64, 73 (1964). Moreover, this Court pointed out, allowing speech to lose its protection because of the speaker's hateful motivation may unduly deter speakers, because "it may be almost impossible [for the speakers] to show freedom from ill-will or selfish political motives." *Id.*

The same is true here. Speech that is motivated by commercial advantage contributes to the marketplace of ideas. A biography is valuable whether the biographer is motivated predominantly by "commercial advantage," by a desire for "literary expression," or by both. Likewise for a comedy routine that mentions a famous person, or a story or novel (whether purely textual or graphic) that does the same.

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[5] *Abraham Lincoln: Speeches and Writings* 1859-1865, at 11 (Don E. Fehrenbacher ed., 1989).

And it may be almost impossible for a writer—who, after all, is making a living as a writer—"to show freedom from * * * selfish [commercial] motives." If even speech motivated by hatred (which is usually a reprehensible motive) retains its constitutional protection, the same should be true for speech motivated by commercial advantage, a motive that the Framers themselves wanted to stimulate.

CONCLUSION

The Missouri Supreme Court frankly acknowledged that under its decision in this case, "free speech must give way to the right of publicity"; and it frankly acknowledged that its decision creates a split with the rule adopted by the California Supreme Court, and with the dominant view expressed in the *Restatement (Third) of Unfair Competition*. The result is a serious infringement of the free speech rights of writers who live and work throughout the country. That makes it important for this Court to resolve the issue, and, we hope, to make clear that writers are free (within the limits imposed by defamation law) to draw on real people's lives and names, just as they can draw on real people's ideas and actions.

For the foregoing reasons, the petition for writ of certiorari should be granted.

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